

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

VOLUME I

IN THE
United States Court of Appeals

256

FOR THE DISTRICT OF COLUMBIA

Appeal No. 21527

FILMON PROCESS CORPORATION,
Appellant,

v.

SPELLRIGHT CORPORATION, *et al.,*
Appellee.

JOINT APPENDIX

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA

United States Court of Appeals
for the District of Columbia Circuit

FILED FEB 19 1968

Nathan J. Paulson
CLERK

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Attorney for Appellee,
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Washington, D. C. 20036.

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Volume One

- 1 Docket Entries
- 2 Complaint filed June 13, 1963
- 3 Amendment to Complaint filed July 26, 1963
- 4 Answer and Counterclaim filed June 26, 1963
- 5 Reply filed July 31, 1963
- 6 Order dated June 22, 1964 Granting
Defendant Spellright's Motion to Dismiss,
Without Prejudice, Counts Two, Three, Four,
Five of the Counterclaim
- 7 Motion To Dismiss Count II of Complaint
dated January 6, 1967
- 8 Order dated February 23, 1967 Denying
Motion To Dismiss Count II Of Complaint
- 9 Pretrial Order Dated December 19, 1966
- 10 Amendment To Pretrial Order dated December 19,
1966
- 11 Deposition of Walter Ploeger, Sr., pages 2,
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- 12 Defendants' interrogatories 36, 52, 53, 54
and 62(a) and the answers thereto
- 13 Deposition of John Nagy pages 5, 6, 18, 21-33,
taken on May 29, 1964
- 14 Trial Transcript pages 13, 14, 83, 84, 104-262

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14 cont. Trial Transcript pages 263-510

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14 cont. Trial Transcript pages 511-708, 716, 719,
721-723, 729, 730, 743, 744, 756, 761, 762,
765, 766, 780, 782, 786-793

15 File wrapper of Letters Patent 3,010,559;
pages 7, 8, 13, 27, 40, 41, 47-55 (plaintiff's
exhibit one)

16 Defendant's Exhibits

1 - Kaufman invoice to Spellright dated
March 31, 1962

2 - Kaufman invoice to Spellright dated
September 30, 1961

3 - Publicity release published November, 1962

12 - Letter from Mr. Ploeger to Mr. Wolowitz
dated December 18, 1961

14 - Letter from Mr. Hall to Mr. Lavine dated
June 27, 1963

17 United States Patents

Stark	1,953,316	April 3, 1934
Phelps	2,044,630	June 16, 1936
Francis	2,657,157	October 27, 1953
Murphy	2,728,439	December 27, 1955
Ploeger	3,010,559	November 28, 1961
Ploeger	3,274,039	September 20, 1966
Markes	2,699,244	January 11, 1955

18 Foreign Patents

German - Gruendel 966,174 June 27, 1957

(with translation - Def. Exh. 9)

British - Wolowitz 961,108 June 17, 1964

19 Opinion of Judge Holtzoff dated October 9, 1967

20 Final Judgment dated October 20, 1967

21 Notice of Appeal

22 Order dated November 29, 1967 extending time
to file transcript

TESTIMONY OF WITNESSES

Walter Ploeger, Jr.	108-244;
	252-386;
	686-698
Henry J. Kauffman	244-261
Estelle Jacobs	387-413
Arthur H. Seidel	413-460;
	698-700
Edward C. Gonda	464-469
Joseph A. Geiger	477-493
Robert A. Norton	495-578
Harry H. Farrell	578-623
Homer R. Montague	624-627
William H. Wolowitz	627-679

United States District Court for the District of Columbia

DATE	PROCEEDINGS
1963	Deposit for cost by
Jun. 13	Complaint, appearance filed
Jun. 13	Summons, copies (2) and copies (2) of Complaint issued #1 ser 6/19/63. #2 ser 6/25/63
Jun 24	Motion of deft #1 for order requiring officers of pltf to appear in Washington, D.C. for purpose of having their depositions taken; affidavit; P&A; appearance of William D. Hall. filed
Jun 24	Interrogatories by deft #1 to pltf; c/m 6/22/63. filed
Jun 26	Answer of defts to complaint and counterclaim; c/m 6/26/63. Jury demand filed
Jul 2	Interrogatories of deft #1 to pltf; c/s 6/28/63; appearance of Moore, Hall & Pollack. filed
Jul 2	Stipulation extending time to answer interrogatories for 30 days. (M/N)
Jul 9	Motion of defts to require pltf to post a cost bond; affidavit; exhibits A, B & C; P&A; c/s 7/9/63. MC 7/17/63 filed
Jul 11	Order granting motion of deft Spellright for an order requiring officers of pltf to appear in Washington DC for purpose of having their depositions taken by deft Spellright. (N) Curran, J.
Jul 12	Stipulation extending time for pltf to answer counterclaim to and including 8/17/63. filed
Jul 12	Stipulation extending time for pltf to answer interrogatories to and including 8/12/63. filed
Jul 15	Motion of pltf for attorney fees; affidavit; Exhibits A - G; P & A in support and in opposition to defts' motion to require pltf to furnish cost bond; c/m 7/15/63; M.C. 7/15/63. filed
Jul 17	Points and authorities in opposition to pltf's motion for atty fees; c/m 7/17/63. filed
Jul 26	Amendment to complaint; c/m. (Consent) filed
Jul 31	Answer of pltf to counterclaim: c/m 7/29/63. filed
Jul 31	Request of pltf for admissions under Rule 36; c/m 7/29/63. filed
Aug 7	Answer of defts to amended complaint; c/m 8/3/63. filed
Aug 7	Calendared (AC/N) (K)
Aug 7	Objections by deft #2 to pltf's request for admissions; P&A; c/m 8/3/63. filed

C /IL DOCKET

United States District Court for the District of Columbia

FILMON PROCESS CORP. vs. SPELL-RIGHT et al C. A. No. 1514-63 Supplemental F

DATE	PROCEEDINGS
1963 Aug 7	Answer of pltf to defts' interrogatories 1 thru 61; exhibit; c/m 8/7/63. file
Aug 7	Objections of pltf to defts' interrogatories; brief; c/m 8/7/63; MC 8/7/63. file
Aug 10	Points and authorities of pltf in reply to defts objections to pltf's request for admissions; c/m 8/9/63. file
Aug 12	Points and authorities of deft in opposition to pltf's objections to defts' interrogatories; c/m 8/10/63. file
Aug 19	Motion of pltf to accept deposition of Walter Ploeger, Jr., in sealed form; P&A; c/m 8/16/63. (Consent) file
Aug 29	Order directing Clerk of Court to accept deposition of Walter Ploeger, Jr. taken on July 22 and 23, 1963 in sealed form and to keep said deposition sealed. (M) Walsh, file
Aug 30	Deposition of Walter Ploeger, Jr. (Sealed). (2) filed
Sep 3	Notice by deft to take depositions of William H. Wolowitz, Allen Mesirov, et al. file
Sep 6	Deposition of Walter Ploeger, Sr., 8/26/63. file
Sep 11	Motion of defts. to quash two subpoenas & to suspend taking depositions of Mesirov & Wolowitz until motion has been ruled on, P&A, c/ser 9-11-63, Exhibit MC 9-11-63 file
Sep 13	Points and authorities by pltf in opposition to motion to quash and suspend taking depositions; c/m; exhibit. file
Sep 16	Transcript of proceedings dated 9/13/63. (Rep. Sanche) file
Sep 20	Withdrawal of motions for atty fee by counsel for pltf. file
Sep 20	Letter from counsel for pltf to the Court dated 9/5/63 with exhibits. file
Oct 2	Request of pltf to deft #1 for admissions; c/m 10/1/63. file
Oct 11	Answers of deft #1 to request for admissions; c/m 10/10/63. file
Oct 28	Motion of deft #1 for leave to file amended and supplemental counterclaim; P&A; affidavit; exhibit; c/m 10/26/63; MC 10/26/63. file
Oct 29	Motion of pltf to produce; P&A; c/m 10/29/63; MC 10/29/63. file
Nov 1	Transcript of proceedings 9/20/63, pp 72. (Rep Davis) (Court's copy) file

United States District Court for the District of Columbia

FILMON PROCESS

vs. PHIL-FIGHT et al

C. A. No.

1514-63

Supplemental Pa

DATE	PROCEEDINGS
Nov 1	Points and authorities of pltf in opposition to motion of deft #1 for leave to file an amended and supplemental counterclaim; affidavits (2); c/m 11/1/63. filed
Nov 5	Memorandum of defts in support of motion for leave to file an amended and supplemental counterclaim; affidavits (4); c/m 11/6/63. filed
Nov 6	Opposition of defts to motion to produce documents and other material; c/m 11/6/63. filed
Nov 7	Request of pltf for clarification on order to post bond; c/m 11/6/63; 11/7/63. filed
Nov 9	Amendment by pltf to motion to produce; c/m 11/8/63. filed
Nov 14	Response by defts to pltf's request for clarification of order to post bond; c/m 11/7/63. filed
Nov 14	Interrogatories by deft #1 to pltf; c/m 11/14/63. filed
Nov 14	Order sustaining objections of defts to requests for admission, without prejudice. (N) Holtzoff, J.
Nov 15	Order quashing subpoenas duces tecum, without prejudice. (N) Tamm, J.
Nov 21	Order denying motion for clarification of order to post bond. (N) Holtzoff, J.
Nov 22	Transcript of proceedings 11/20/63, pp 85. (Rep. Maher). (Court's copy). filed
Nov 27	Objections by plaintiff to defendants' interrogatories, c/m 11-26-63. EC 1/2/64 filed
Nov 27	Points and Authorities by plaintiff in support of objections to interrogatories, c/m 11-26-63. filed
Nov 30	Answer of pltf to interrogatories; c/m. filed
Dec 2	Order substituting amended and supplemental counterclaim for Violation of Antitrust Laws in place of Fifth Count of original counterclaim and adding Eaton Allen Corporation as a deft. (N) Jackson, J.
Dec 2	Amended and supplemental counterclaim vs pltf and deft Eaton Allen Corporation. filed
Dec 2	Amended reply of pltf to amended and supplemental counterclaim; c/m 11/27/63. filed

VIL DOCKET

United States District Court for the District of Columbia

FILMON PROCESS

vs. SPELL-RIGHT et al

C. A. No. 1514-63

Supplemental Page

DATE	PROCEEDINGS
1963 Dec 3	Order directing pltf to file bond in sum of \$2,500.00 for costs and counsel fees within 10 days. (N) Holtzoff, J.
Dec 5	Opposition of defts to pltf's objections to interrogatories; c/m 12/3/63. filed
Dec 5	Summons, copy and copy of ^{amended and supplemental} counterclaim issued deft #3. Ser-12/9/63 (N)
Dec 6	Undertaking of pltf for security for costs in sum of \$2,500.00 with Fidelity & Deposit Co. of Md.; approved. filed
Dec 12	Order sustaining pltf's objections to interrogatories #14, 15, 16, 32, 33, 38 and 39; objections to interrogatories #27 and 51 considered moot. (N) Holtzoff, J.
Dec 20	Interrogatories of pltf to defts: c/m 12/19/63. filed
Dec 27	Notice by plaintiff to take deposition of William H. Wolowitz and Mr. Meserow. filed
Dec 27	Motion of defendants #1 & #3 for extension to time to answer or object to plaintiffs interrogatories, P&A, c/m 12-27-63, MC 12-27-63 filed
1964 Jan 2	Points and authorities of pltf in opposition to motion of defts 1 & 2 for extension of time to answer and/or object to interrogatories 1-93; c/m 12/31/63. filed
Jan 2	Memorandum of defts 1 & 2 in support of motion for extension of time. filed
Jan 2	Stipulation of counsel extending time in which deft Eaton Allen Corp. may answer or otherwise plead to amended and supplemental counterclaim to and including 2/24/64. (fiat) (N) Jackson, J.
Jan 6	Appearance of John Potts Barnes & John S. Walker as attys. for deft. #3 (AC/N) filed
Jan 10	Order granting in part and denying in part pltf's motion to produce. (See order for details) (N) Jackson, J.
Jan 10	Order extending time within which defts may object and/or answer interrogatories 1 to 93 to and including 2/5/64; depositions of William H. Wolowitz and Allen M. Meserow scheduled for 1/20/64 are postponed pending Court's action upon any objections to said interrogatories. (N) Jackson, J.
Jan 20	Motion of deft #1 for production of documents; affidavit: P&A: c/ser. 1/20/64: MC 12-27-63. filed

CIVIL DOCKET

United States District Court for the District of Columbia

FILMON PROCESS

vs. SPELL-RIGHT et al

C. A. No. 1514-63

Supplemental P.

DATE	PROCEEDINGS	
1964 Jan 29	Motion of defts 1 & 2 to increase pltf's bond; P&A: affidavit; c/s 1/29/64;	filed
Jan 29	Request of deft #1 for admissions; c/s 1/29/64.	filed
Feb 6	Stipulation extending time for pltf to file opposition to motion to produce and increase cost bond to 2/13/64.	filed
Feb 12	Answers of pltf to request of deft #1 for admissions; c/m 2/11/64.	filed
Feb 13	Opposition of pltf to motion for production; c/m 2/12/64.	filed
Feb 13	Opposition of pltf to motion to increase cost bond; c/m 2/12/64.	filed
Feb 13	Answer of deft #1 to pltf's interrogatories; c/m 2/13/64.	filed
Feb 13	Objections of deft #1 to pltf's interrogatories; c/m 2/13/64; MC 2/13/64.	filed
Feb 14	Points and authorities of defts 1 & 2 in support of their objections to pltf's interrogatories; c/m 2/13/64.	filed
Feb 20	Reply of pltf to defts' objections to interrogatories; c/m 2/19/64.	filed
Feb 24	Stipulation extending time for Eaton Allen Corp. to answer to and including 3/23/64. (fiat)	Keech, J.
Feb 28	Stipulation re: answering of certain interrogatories and withdrawing motion for production of documents. (fiat) (N)	Jackson, J.
Mar 18	Transcript of proceedings 1/10/64; pp 1-12. (Rep. Maher) (Court's copy)	filed
Mar 18	Transcript of proceedings 1/10/64; pp 1-18. (Rep. Maher) (Court's copy)	filed
Mar 18	Transcript of proceedings 2/28/64; pp 1-60. (Rep. Maher) (Court's copy)	filed
Mar 18	Order increasing cost bond to \$7,500.00 as to both defts within 10 days and sustaining objections to interrogatories. (N)	Jackson, J.
Mar 23	Stipulation extending time for deft Eaton Allen Corp. to answer amended and supplemental counterclaim to and including 4/22/64. (fiat)	Keech, J.
Mar 27	Undertaking of pltf for security for costs in sum of \$5,000.00 with Fidelity and Deposit Co. of Md., approved.	filed

CIVIL DOCKET

United States District Court for the District of Columbia

FILMON PROCESS

vs. SPELL-RIGHT et al

C. A. No. 1514-63

Supplemental P

DATE	PROCEEDINGS
Apr 1	Stipulation correcting error in caption of bond by adding name of William Wolowitz as a deft. (fiat) Hart, J.
Apr 3	Interrogatories of pltf to deft #1; c/m 4/2/64. filed
Apr 3	Request of pltf for admissions by deft #1; c/m 4/2/64. filed
Apr 10	Called Pretrial Examiner
Apr 16	Depositions of Allan M. Mesircw and William H. Wolowitz 3/11/64. filed
Apr 16	Deposition of William H. Wolowitz (cont'd) 3/13/64. filed
Apr 24	Stipulation of defts. #1 & 3 extending time for deft. #3 to answer amended & supplemental counter claim to and including May 22, 1964 filed
Apr 27	Interrogatories by defendants to plaintiff, c/m 4-25-64. filed
May 2	Amended reply of pltf to amended and supplemental answers and counterclaim of defts: c/m 5/1/64. filed
May 6	Stipulation of counsel terminating the deposition of Walter Piceger, Jr. (fiat) (Signed 5-5-64) Jackson, J.
May 6	Stipulation of counsel re: filing of supplemental answer and counterclaim of defendants, Spellright Corporation and William H. Wolowitz; c/m 4-14-64. (fiat) Jackson, J.
May 6	Supplemental answer and counterclaim of defendants, Spellright Corporation and William H. Wolowitz; c/m 4-14-64. filed
May 7	Answer of plaintiff to interrogatory #63 of defendant #2, c/m 5-6-64. filed
May 15	Notice by pltf to take deposition of Mr. Robert Glenn and Mr. John Nagy; c/m 5/14/64. filed
May 15	Objections of deft #1 to interrogatories 94 to 97 and pltf's request for admissions 5 thru 27 inclusive; P&A; affidavit; c/m 5/14/64; MC 5/15/64. filed
May 15	Answer of deft #2 to interrogatories; c/m 5/14/64. filed
May 21	Reply of pltf to objections of deft #1 to interrogatories #94 thru 97 and pltf's request for admissions 5-27; affidavit; c/m 5/20/64. filed
May 23	Notice by pltf to take depositions of Homer Montague, Esq., and Mr. Jack Orndorff; c/m 5/22/64. filed
May 25	Stipulation extending time for deft Eaton Allen Corp. to answer amended and supplemental counterclaim to and including 6/22/64. (N) (fiat)

CIVIL DOCKET

United States District Court for the District of Columbia

FILMON PROCESS vs. SPELL RIGHT C. A. No. 1514-63 Supplemental Page

DATE	PROCEEDINGS
1964	
Jun 4	Stipulation regarding depositions of Homer Montague & Jack Orndorff. filed
-	-
Jun 8	Motion of deft #1 to dismiss counts 2 - 5 inclusive, of complaint without prejudice; P&A; c/m 6/6/64. filed
Jun 12	Points and authorities of pltf in answer to motion to dismiss counter 2 to 5 inclusive. filed
Jun 22	Order sustaining defendant's objections to plaintiff's interrogatories (N) Jackson, J.
Jun 22	Order granting defendant, Spellright's motion to dismiss without prejudice counts 2,3,4 & 5 of counterclaim (N) Jackson, J.
Jun 29	Motion of pltf to reduce cost bond; P&A; c/m 6/29/64. filed
Jul 6	Memorandum of P&A of defendants in opposition to plaintiff's motion to reduce cost bond; Affidavits (2) c/m 7-2-64. filed
Jul 9	Order denying defendants motion for reduction of cost bond etc. (N) Jackson, J.
Jul 22	Interrogatories by pltf to defts; c/m 7-21-63. filed
Aug 4	Transcript of proceedings, June 5 and 12, 1964, Pages 26, Courts copy (Rep: Jack Maher) filed
Aug 4	Transcript of proceedings, January 3, 1964, pages 25, Court's copy (Rep: Maher) filed
Aug 6	Deposition of John Nagy, May 29, 1964. filed
Aug 6	Deposition of Robert Glenn, May 29, 1964. filed
Aug 6	Deposition of Arthur H. Seidel, May 29, 1964. filed
Aug 17	Answers of defendants #2 & #3 to interrogatories: c/m 8-15-64. filed
-	-
Aug 24	Interrogatory #64 by defendants to plaintiff, c/m 8-22-64. filed
Sep 5	Interrogatories by plaintiff to defendants, c/m 9-4-64. filed
Sep 10	Stipulation allowing plaintiff to and including September 19, 1964 to object to interrogatories 64-69 and to and including September 23, 1964 to answer. (fiat) Holtzoff, J.
Sep. 14	Notice by defts to take depositions of Lawrence G. Hommel; c/m 9-12. filed
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Sep. 21	Answer of defts to interrogatories #108 & 109; c/m 9-22-64. filed
Sep. 23	Notice by defts #1 & #2 of taking depositions of Lawrence G. Hommel; c/m 9-22-64. filed
Sep 23	Answer of pltf to defts' interrogatories #64-69; c/m 9-22-64. filed

United States District Court for the District of Columbia

FILMON PROCESS

vs.

SPELL RIGHT

C. A. No. 1514-62

Supplemental Pa

DATE	PROCEEDINGS
1964	
Oct 7	Stipulation re: termination of deposition. filed
Oct 7	Certificate of _____ of defendants; c/m 10-6-64. filed
Oct 9	Objection of plaintiff to certificate of Readiness; _____ filed
Oct 9	Motion of plaintiff to dismiss complaint and counterclaim, or in the alternative, to transfer venue, or, in the alternative, to stay trial; P&A; Affidavit: c/m _____ filed
Oct. 19	Stipulation of counsel extending time within which defts may file memorandum of P & A in opposition to plttf's motion to dismiss complaint & counterclaim to & including October 26, 1964. filed
Oct. 26	Opposition of defts to plttf's motion to dismiss or to transfer or to stay trial; c/m 10-26-64; affidavits (2). filed
Nov. 4	Reply memorandum of plttf; affidavit; c/m 11-3-64. filed
Nov. 20	Order denying motion of plttf to dismiss complaint & counter-claim or in the alternative to transfer the venue of the action, or in the alternative, to stay the trial. (H) Jackson, J.
1965	
June 4	Withdrawal by plaintiff of objections to certificate of readiness. filed
Sept. 14	Notice of prior art; c/m 9/13/65. filed
1966	
Oct. 3	Appearance of Marshall, Bratter, Greene, Allison & Tucker and Morton Robson as attorneys for plttf.; c/m 10-3-66. filed
Oct. 3	Notice of withdrawal of Arthur H. Seidell as attorney for plttf.; c/m 10-3-66. filed
Nov. 3	Transcript of proceedings 10-6-64, 17 pages (Court's copy); Jack Maher, rep. filed
Dec. 15	Notice by defts of additional witnesses; c/m 12/14/66. filed
Dec. 10	Pretrial Proceedings (12/9/66) Assistant Pretrial Examiner
Dec. 19	Oral motions by plaintiff for jury demand and for leave to introduce certain exhibits at trial which were omitted at pretrial to substantiate claims set forth in Count 2 (False Marking) of the Pretrial Order, argued and denied; and oral motion by plaintiff to require defendants to produce all invoices pertaining to typewriter ribbon sales at time of trial, argued and granted. (Rep: Patrine Brockmeyer) Sirica, J.

United States District Court for the District of Columbia

FILMON PROCESS

vs. SPELL RIGHT

C. A. No. 1514-62

Supplemental Pa

DATE	PROCEEDINGS
1964	
Oct 7	Stipulation re: termination of deposition. filed
Oct 7	Certificate of _____ of defendants; c/r 10-6-64. filed
Oct 9	Objection of plaintiff to certificate of Readiness; _____ filed
Oct 9	Motion of plaintiff to dismiss complaint and counterclaim, or in the alternative, to transfer venue, or, in the alternative, to stay trial; P&A; Affidavit: c/m _____ filed
Oct. 19	Stipulation of counsel extending time within which defts may file memorandum of P & A in opposition to plttf's motion to dismiss complaint & counterclaim to & including October 26, 1964. filed
Oct. 26	Opposition of defts to plttf's motion to dismiss or to transfer or to stay trial; c/m 10-26-64; affidavits (2). filed
Nov. 4	Reply memorandum of plttf; affidavit; c/m 11-3-64. filed
Nov. 20	Order denying motion of plttf to dismiss complaint & counter-claim or in the alternative to transfer the venue of the action, or in the alternative, to stay the trial. (H) Jackson, J.
1965	
June 4	Withdrawal by plaintiff of objections to certificate of readiness. filed
Sept. 14	Notice of prior art; c/m 9/13/65. filed
1966	
Oct. 3	Appearance of Marshall, Bratter, Greene, Allison & Tucker and Morton Robson as attorneys for plttf.; c/m 10-3-66. filed
Oct. 3	Notice of withdrawal of Arthur H. Seidell as attorney for plttf.; c/m 10-3-66. filed
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Dec. 15	Notice by defts of additional witnesses; c/m 12/14/66. filed
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United States District Court for the District of Columbia

Filmon Process Corp. vs. Spell-Right Corp., et al C. A. No. 1514-63 Supplemental Page:

DATE	PROCEEDINGS
Sep 26	Affidavit of Morton S. Robson to continue trial (fiat)(N)Curran, C.J. filed
Sep 27	Transcript of Proceedings, Sept. 26, 1967, Pages 1-5; (Rep. Katherine Byrholdt) Court's copy. filed
Sep 27	Transcript of Proceedings, Sept. 26, 1967, pages 1-5. (Rep. Katherine Byrholdt) Attorney's copy filed
Oct. 2	Jury demand waived, hearing begun; respited until October 3, 1967. (Rep: G. Nevitt) Holtzoff, J.
Oct. 3	Hearing resumed; respited until October 4, 1967. (Rep: G. Nevitt) Holtzoff, J.
Oct. 4	Hearing resumed, respited until October 5, 1967. (Rep: G. Nevitt) Holtzoff, J.
Oct. 5	Hearing resumed; respited until October 6, 1967. (Rep: G. Nevitt)
Oct. 6	Hearing resumed; respited until October 9, 1967. (Rep: K. Byrholdt)
Oct. 9	Hearing resumed and concluded: finding for defendants vs plaintiff: oral opinion to constitute findings of fact and conclusions of law; motion of defendant for attorney's fee argued and denied. (Judgment to be presented) (Rep: K. Byrholdt) Holtzoff, J.
Oct. 20	Corrected copy of oral opinion announced from bench on October 9, 1967. (filed October 20, 1967) filed
Oct. 20	Judgment declaring Claims 1 & 2 of U.S. Patent 3,010,559 to be invalid; complaint dismissed with prejudice, plaintiff to pay taxable costs. (N) Holtzoff, J.
Nov. 16	Notice of appeal by pltf from order of 10/20/67; copies mailed to John S. Walker and William D. Hall, deposit \$5.00 by Lavine. filed
Nov. 16	Cost bond on appeal by pltf in sum of \$250.00 with Fidelity and deposit Co., of Maryland, approved. filed
Nov. 29	Consent order granting plaintiff to and including Dec. 21, 1967 to file the transcript of the testimony. (N) 371/N Holtzoff,
Dec. 13	Transcript of proceedings, 10/2/67, Vol. 1, pp. 1-158; Rptr. Gerald Nevitt. (Court's Copy) filed
Dec. 13	Transcript of proceedings, 10/3/67; Vol. 2, pgs 159-316; Rptr. Gerald Nevitt. (Court's Copy) filed
Dec. 13	Transcript of proceedings, 10/4/67; Vol. 3, pgs 317-461; Rptr. Gerald Nevitt. (Court's Copy) file

CIVIL DOCKET

United States District Court for the District of Columbia

Filmson Process Corp.

Spellright Corp.

C. A. No. 1514-63

Supplemental Page

DATE	PROCEEDINGS	
1967		
Dec. 13	Transcript of proceedings, 10/5/67; Vol. 4, pgs. 147-601. Reptr: Gefald Nevitt. (Court's copy)	filed
Dec. 13	Transcript of proceedings, 10/6/67; Vol. 5, pgs. 602-793: Reptr: K. Byrholdt. (Court's copy)	filed
Dec. 13	Transcript of opinion of the Court, 10/9/67, pgs. 1-18; Reptr: Katherine K. Byrholdt. (Court's copy)	filed
Dec. 13	Transcript of testimony of Walter Ploeger, Jr., 10/6/67, pgs. 1-13; Reptr: Katherine K. Byrholdt. (Court's copy)	filed
Dec. 15	Defendant's exhibits 1 thru 14.	filed
Dec. 21	Appellant's statement of points; c/m 12/21/67	filed
Dec. 21	Transcript of proceedings 10/2/67; Vol. 1, pages 1-158; Gerald Nevitt, reporter; (Attorney's Copy)	file
Dec. 21	Transcript of proceedings 10-3-67; Vol. 2 pages 159-316 Gerald Nevitt, Reporter (Attorney's copy)	filed
Dec. 21	Transcript of proceedings 10-4-67 Vol. 3 pages 317-461; Gerald Nevitt, Reporter (Attorney's copy)	filed
Dec. 21	Transcript of proceedings 10-5-67 Vol. 4 pages 462-601; Gerald Nevitt, Reporter: (Attorney's copy)	filed
Dec. 21	Transcript of proceedings 10-6-67; & 9-19-67; Vol. 5 10-6-67 & 9-19-67; Katherine K. Byrholdt, Reporter (Atty's copy)	filed
Dec. 21	Transcript of proceedings- 10-9-67 (opinion of the Court) pages 1-18; Katherine K. Byrholdt, reporter. (Atty's copy)	filed
Dec. 21	Exhibits 1,2,3,4,6,7, 7-a; 8,9,10,11,12,13,14,16,18,19,20, & 21. by plfff.	filed

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,
653-659 11th Avenue
New York 36, New York

Plaintiff :

Civil Action

No.

v. :

SPELL-RIGHT CORPORATION
WILLIAM H. WOLOWITZ,

Defendants:

COMPLAINT

For Damages and Injunction for
Patent Infringement and Unfair
Competition.

1. This Court has jurisdiction by virtue of the Patent Laws of the United States, Title 35 of the United States Code. There is also diversity jurisdiction, with the parties being citizens of different states, and the amount in controversy exclusive of interest and costs being in excess of Ten Thousand Dollars (\$10,000.00). This Court has jurisdiction pursuant to the provisions of 28 U.S.C.1338(b) relating to the claim of unfair competition.

2. The plaintiff, Filmon Process Corp., is a New York corporation having a principal place of business at 653-659 11th Avenue, New York 36, New York.

3. The defendant, Spell-Right Corporation, is a District of Columbia corporation, having a place of business at 335 Cedar Street N.W., Washington 12, D. C.

4. The defendant, William H. Wolowitz, is president of defendant Spell-Right Corporation, and has an office at 335 Cedar Street N. W., Washington, 12, D. C.

5. On November 28, 1961, United States Letters Patent No. 3,010,559 were duly and legally issued to plaintiff's

predecessor The Edgecraft Company, 653-659 11th Avenue, New York 36, New York. Patent 3,010,559 was duly and legally assigned to the plaintiff by an assignment recorded in the Patent Office at Reel 1203, Frames 297 et seq. Since the date of such assignment, the defendants, jointly and severally have been and still are infringing said patent 3,010,559 by making, selling, and using a printing ribbon embodying the patented invention, and will continue to do so unless enjoined by this Court.

6. The plaintiff has notified the defendants regarding their said infringement, and notwithstanding this notice the defendants persist in their infringement.

SECOND CAUSE OF ACTION

7. The plaintiff, and/or its related company The Edgecraft Company, formerly sold a typewriter ribbon to the defendant Spell-Right Corporation. The defendant Spell-Right Corporation realizing that such ribbon was patented, namely realizing that such ribbon came within the scope of aforesaid patent 3,010,559, inserted into the boxes in which it packaged its self-correcting typewriter ribbon an insert bearing the legend "Patented Construction backing keeps type clean". This legend referred to patent 3,010,559.

8. When the defendant Spell-Right Corporation ceased to purchase the printing ribbon formerly sold to it by the plaintiff and/or The Edgecraft Company, it still continued to and still does insert the aforesaid legend into its package.

9. By using the aforesaid legend on the aforesaid insert in its package, the defendant Spell-Right Corporation seeks to and does mislead and deceive its customers regarding the nature of its merchandise. Thus, defendant Spell-Right Corporation misleads and deceives its customers into believing that the defendant

Spell-Right Corporation owns the patent on the backing which keeps the type clean, when in fact the plaintiff owns such patent, namely 3,010,559.

THIRD CAUSE OF ACTION

10. The plaintiff Filmon Process Corp. is a manufacturer of precision cut ribbons. Its personnel have had many years experience in the design and development of equipment for the manufacture of precision cut ribbons of all types, and in particular ribbons used for printing and typewriting.

11. Plaintiff's personnel have developed through the years many processes for manufacturing precision cut ribbons, and one of the principal assets possessed by the plaintiff is its know-how in the field of manufacturing precision cut ribbons.

12. Defendant Wolowitz approached plaintiff's personnel and advised such personnel that he was interested in merchandising new products employing plaintiff's ribbons. He repeatedly assured plaintiff's personnel that he did not intend to compete with the plaintiff, but that he would become a large user for the plaintiff's products.

13. Upon the strength of these representations, plaintiff's personnel demonstrated to defendant Wolowitz many of plaintiff's trade secrets which plaintiff developed in connection with the manufacture of precision cut ribbons. Plaintiff's personnel gave defendant Wolowitz this information in the belief that it would assist defendant Wolowitz in exploiting the sale of merchandise manufactured from plaintiff's products.

14. Having obtained plaintiff's information and know-how on the basis of the aforementioned representations that he would not compete with the plaintiff, defendant Wolowitz and defendant Spell-Right Corporation, jointly and severally, have commenced

and are making and selling ribbons in direct competition with the plaintiff to the serious detriment and damage of the plaintiff.

15. The ribbons made and sold by defendant Wolowitz and Spell-Right Corporation are inferior in design and construction to ribbons manufactured by the plaintiff. However, prior to the manufacture of such ribbons by defendants Wolowitz and Spell-Right Corporation, there was no other manufacturer of such ribbons anywhere other than the plaintiff or firms or corporations manned by plaintiff's officers and agents.

16. The persons in the trade to whom the defendants Wolowitz and Spell-Right Corporation sell their goods believe that the ribbons used in defendants' merchandise originated with plaintiff. This belief is reinforced in many cases by the knowledge that the plaintiff previously supplied such ribbon to the defendants, and/or the use by the defendants of the legend " Patented Construction backing" in the inserts which accompany defendants' merchandise.

17. By virtue of the erroneous belief occasioned because of the facts set forth in the next preceding paragraph, and because of the inferior quality of the ribbon made and sold by the defendants, the plaintiff's reputation in the trade has been seriously damaged.

WHEREFORE plaintiff prays for:

(a) A preliminary and final injunction against further infringement by defendants and those controlled by defendants of plaintiff's patent 3,010,559.

(b) An accounting for profits and damages.

(c) Plaintiff's attorney fees.

(d) Plaintiff's award pursuant to the provisions of 35 U.S.C. 292 by virtue of the acts herein complained of in plaintiff's Second Cause of Action.

(e) A preliminary and final injunction against the acts of unfair competition committed by the defendants herein complained of.

(f) An assessment of costs against defendants.

(g) Such other and further relief as to the Court may appear just and proper.

Irvin A. Lavine
801 Washington Building
Washington 5, D. C.
District 7-8448
Attorney for Plaintiff

Of counsel:

Arthur H. Seidel
Edward C. Gonda
Land Title Building
Philadelphia, Penna. 19110

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMOR PROCESS CORP.,
Plaintiff

v.

SPILLRIGHT CORPORATION,
WILLIAM H. WOLOWITZ,
Defendants

Civil Action No. 1514-63

AMENDMENT TO COMPLAINT

Now comes the plaintiff, and moves for permission to
amend the Complaint in the above-entitled matter as follows:

1. In paragraph 7, line 2, cancel "sold" and substitute therefor -- processed --; after "to", insert -- be sold by --.
2. In paragraph 8, line 2, cancel "sold to it" and substitute therefor -- processed --.

Respectfully submitted,

Irvin A. Levine
601 Washington Building
Washington 5, D. C.
DI 7-8448
Attorney for Plaintiff

Of Counsel:

Arthur H. Seidel
Edward C. Conda
Land Title Building
Philadelphia 10, Penna.

William D. Hall, attorney for the defendants, hereby
stipulates that the above Amendment to the Complaint may be entered.

William D. Hall
904 Ring Building
Washington 6, D. C.
Attorney for Defendants

SO ORDERED.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,

Plaintiff,

v.

SPELLRIGHT CORPORATION,
WILLIAM H. WOLOWITZ,

Defendants.

Civil Action No. 1514-63

DEFENDANTS' ANSWER AND
COUNTERCLAIM

I. Defendants' Answer

Defendants answer the complaint of the Plaintiff as follows:

1. Defendants admit that this Court has jurisdiction of the First Cause of Action named in the Complaint, namely, the suit for patent infringement. The other allegations of Paragraph 1 are denied. The parties are not citizens of different states since Defendants are residents of the District of Columbia.

2. Admitted.

3. Admitted.

4. Admitted.

First Cause of Action

5. Denied, except that Defendants admit that on November 28, 1961, United States Letters Patent 3,010,559 issued to Edgecraft Company. Defendants particularly deny infringement of said patent. Defendants admit that there is an assignment recorded in the Patent Office at Reel 1203, Frame 297 et seq., purporting to assign Patent 3,010,559 to the Plaintiff.

6. Denied.

Second Cause of Action

7. Denied, except that the first sentence, although inaccurate in some details, is essentially true. See paragraph 34 infra, for a more accurate statement of the facts.

8. Denied.

9. Denied.

Third Cause of Action

10. Admitted.

11. Denied.

12. Denied, except that the first sentence of this Paragraph is admitted, and also that Wolowitz indicated that SPELLright Corporation would become a large user for the Plaintiff's products.

13. Denied.

14. Denied.

15. Denied, except to the extent that Defendants admit that Plaintiff is and has been a dominant manufacturer of ribbon material.

16. Denied.

17. Denied.

Affirmative Defenses

18. Plaintiff has misused the patent in suit by maliciously sending, after this suit was on file, in bad faith and without substantial investigation, numerous notices of infringement of said patent to Defendant SPELLright's retail customers, for the purpose of driving Defendants out of business and enabling the Plaintiff to gain a limited monopoly over materials that Plaintiff freed from its alleged patent monopoly and for the further purpose of taking the law into its own hands and circumventing the judicial processes of this Court to which the controversy had been committed. Other acts of misuse are stated in detail in paragraphs 34 to 42 inclusive, infra. Moreover, Plaintiff is a dominant processor of typewriter ribbons, and is alleging in this suit that it accepted an agreement that Defendants would not compete with it (Complaint, par. 12, 14), and it has brought this suit in an attempt to enforce said alleged

agreement in restraint of trade; which was illegal at common law as well as in violation of the antitrust laws, 15 U.S.C. 1, 3; wherefore Plaintiff is in this court with unclean hands and may not recover.

19. Plaintiff is charging as an infringement the very materials which it processed for Defendant Spellright as more fully explained in paragraph 34, infra, wherefore Defendants assert a license.

20. Defendants aver that United States Letters Patent No. 3,010,559 is invalid and void for the following reasons:

(a) The alleged invention purported to be patented thereby was known or used by others in this country, or patented and described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, due notice as to which will be given;

(b) The alleged invention purported to be patented thereby was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, due notice as to which will be given;

(c) The alleged invention purported to be patented thereby was described in a patent granted on an application for patent by another filed in the United States before the alleged invention thereof by the applicant for patent, due notice as to which will be given;

(d) The applicant did not himself invent the subject matter sought to be patented;

e) Before the applicant's invention thereof the alleged invention was made in this country by another who had not abandoned, suppressed, or concealed it, due notice as to which will be given;

f) In view of the state of the art prior to the alleged improvements purported to be patented thereby, as shown by prior patents and publications, due notice as to which will be given, no exercise of invention was involved in said alleged improvements, but the same, or all material or substantial parts thereof, was obvious at the time the alleged invention was made to a person having ordinary skill in the art to which the subject matter pertains;

g) The specification does not contain a written description of the alleged invention purported to be patented thereby, and of the manner and process of making and using it, in such full, clear and concise terms as to enable any person skilled in the art to which it pertains or with which it is most clearly connected, to make and use the same;

h) The specification does not conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regarded as his alleged invention.

21. Plaintiff filed this suit, knowing it to be groundless, for the purpose of harassing Defendants and forcing them out of business.

22. For the reasons set forth in this Answer and Counterclaim herein, Plaintiff has brought this suit in bad faith, and Defendants are therefore entitled to a reasonable attorney's fee as provided in 35 U.S.C. 285.

WHEREFORE, Defendants pray that the complaint be dismissed and that Defendants be awarded costs and reasonable attorneys' fees together with such other relief as the Court deems just and proper in the circumstances.

II. Counterclaim

Defendants (Counter-Plaintiffs) as a counterclaim to the complaint allege as follows:

23. This Court has jurisdiction over the counterclaim since the Defendants (Counter-Plaintiffs) are residents of the District of Columbia, and the Plaintiff (Counter-Defendant) is a corporation of New York, and the amount in controversy in the counterclaim, exclusive of interest and costs, exceeds \$10,000.00.

24. Defendant (Counter-Plaintiff) SPELLright Corporation is a District of Columbia corporation, having a place of business at 335 Cedar Street, N. W., Washington 12, D. C.

25. Defendant (Counter-Plaintiff) William H. Wolowitz has an office at 335 Cedar Street, N. W., Washington 12, D. C., and is a resident of the District of Columbia.

26. Plaintiff (Counter-Defendant) Filmon Process Corp. is a New York corporation, having a principal place of business at 653-59 11th Avenue, New York 36, N. Y.

First Count (Counterclaim)

27. The First Cause of Action of this counterclaim arises under the Declaratory Judgments Act, 28 U.S.C. 2201, and prays for a declaratory judgment upon all of the issues raised in the First and Third Causes of Action of the complaint and the answer thereto. An actual controveray exists as to each and every one of these issues.

28. Defendants (Counter-Plaintiffs) deny that the patent in suit is valid, and further deny infringement thereof, all for the reasons set forth in the Defendants' Answer to the Complaint; and pray for a declaratory judgment holding the patent invalid and not infringed.

29. Defendants (Counter-Plaintiffs) were licensed to use the material furnished to them indirectly by Plaintiff (Counter-Defendant) and pray for a declaratory judgment declaring this license.

30. Defendants (Counter-Plaintiffs) aver that Plaintiff (Counter-Defendant) misused its patent, and also is in this court with unclean hands, and pray for a declaratory judgment as to such misuse and unclean hands.

31. Defendants (Counter-Plaintiffs) allege that Plaintiff (Counter-Defendant) has no, and indeed never had any trade secrets and pray for a declaratory judgment to that effect.

32. Defendants (Counter-Plaintiffs) having denied the essential allegations as to the Third Cause of Action set forth in the Complaint, and pray for a declaratory judgment on the issues set forth in said Third Cause of Action.

Second Count (Counterclaim)

33. Defendant (Counter-Plaintiff) SPELLright Corporation brings this Second Cause of Action against Plaintiff (Counter-Defendant) Filmon Process Corp.

34. Defendant (Counter-Plaintiff) SPELLright Corporation approached Plaintiff (Counter-Defendant) Filmon Process Corp. for the purpose of arranging the purchase of a quantity of ribbon material for use in a new self-correcting typewriter ribbon. Plaintiff (Counter-Defendant) Filmon Process Corp. stated to Defendant (Counter-Plaintiff) SPELLright Corporation that it (Filmon) had in stock a large quantity of material belonging to Schwartzenbach Huber Co. which Plaintiff (Counter-Defendant) stated it could process to meet Defendant (Counter-Plaintiff) SPELLright's requirements. Plaintiff (Counter-Defendant) Filmon Process Corp. and Defendant (Counter-Plaintiff) SPELLright Corporation then mutually agreed that if Defendant

(Counter-Plaintiff) SPELLright purchased its ribbon material pursuant to the arrangement then worked out, that Defendant (Counter-Plaintiff) SPELLright Corp. would have the exclusive right (limited to self-correcting ribbons) to purchase ribbon material processed by Plaintiff (Counter-Defendant) Filmon Process Corp. According to the above "arrangement" Defendant (Counter-Plaintiff) SPELLright Corp. was to place its order with Schwartzenbach Huber Co., and pay that company, whereupon Plaintiff (Counter-Defendant) Filmon Process Corp. would process the material to meet Defendant (Counter-Plaintiff) SPELLright's requirements. SPELLright did so place its order and pay for the goods. The goods thus purchased is the transaction described somewhat inaccurately in the Complaint (par. 14), as follows:

"The plaintiff, and/or its related company The Edgecraft Company, formerly sold a typewriter ribbon to the defendant Spell-Right Corporation."

Defendant (Counter-Plaintiff) SPELLright Corporation began the manufacture and sale of self-correcting ribbons using said ribbon material furnished by Plaintiff (Counter-Defendant) Filmon Process Corp., whereupon Plaintiff (Counter-Defendant) Filmon Process Corp. breached the agreement with Defendant (Counter-Plaintiff) SPELLright Corporation and arranged for the supply of the material in large quantity to Eaton Allen Corporation so that it could compete on a large scale with Defendant (Counter-Plaintiff) SPELLright Corporation; and moreover, Plaintiff (Counter-Defendant) then sent notices of patent infringement to Defendant

(Counter-Plaintiff) SPELLright Corporation's customers alleging that the latter's self-correcting ribbons constituted an infringement of Plaintiff's patent, even though the customers to whom these letters were sent purchased from Defendant (Counter-Plaintiff) SPELLright Corporation nothing other than the self-correcting ribbons made with the material which Plaintiff (Counter-Defendant) Filmon Process Corp. processed for Defendant (Counter-Plaintiff) SPELLright Corp. pursuant to the above arrangement.

35. As a result of the foregoing acts, Defendants' (Counter-Plaintiffs') sales have been impaired, and Defendants (Counter-Plaintiffs) have lost sales and reputation, and have been seriously injured in the eyes of their customers, the damage exceeding \$10,000.00 exclusive of interest and costs. Moreover, Defendants (Counter-Plaintiffs) claim damages in an amount equal to the profits made by Plaintiff (Counter-Defendant) Filmon Process Corp. and Eaton Allen Corp. as a result of the aforesaid unwarranted competition. This latter amount is not known to Defendant (Counter-Plaintiff) SPELLright Corp., but will be added by amendment hereto when determined.

Third Count (Counterclaim)

36. Plaintiff (Counter-Defendant) maliciously and in bad faith circulated Defendant (Counter-Plaintiff) SPELLright Corporation's customers with notices of patent infringement, when

there was absolutely no basis for the charge of patent infringement, for the purpose of injuring Defendant (Counter-Plaintiff) SPELLright Corporation's business. This was done for the purpose of harassing and annoying Defendant (Counter-Plaintiff) SPELLright Corporation and destroying its business. Had Plaintiff (Counter-Defendant) Filmon Process Corporation made even the slightest investigation of the products being sold by the companies to whom the said notices of infringement were being sent, Plaintiff (Counter-Defendant) Filmon Process Corporation would have seen at once that the self-correcting typewriter ribbons being sold were those manufactured with the material processed by Plaintiff (Counter-Defendant) Filmon Process Corporation itself and which, of course, Defendant (Counter-Plaintiff) SPELLright Corporation had a clear right to use.

37. Typical of the notices of infringement sent maliciously and in bad faith by Plaintiff (Counter-Defendant) is one sent to S. Kann Sons Company Department Store, 8th Street and Market Place, Washington, D. C., and reads as follows:

"ARTHUR H. SEIDEL
Land Title Building
Philadelphia 10, Pennsylvania

S. Kann Sons
Washington, D. C.

Re: Filmon Process Corporation vs.
Spell-Right Corporation and William
H. Wolowitz - C. A. 1514-63
U. S. District Court for the
District of Columbia

Gentlemen:

I am counsel for Filmon Process Corporation,
the plaintiff in the above identified law suit.
My client, Filmon

of the material processed by Plaintiff (Counter-Defendant) Filmon Process Corp., and that Defendant (Counter-Plaintiff) SPELLright Corp. was licensed to use it. The notice of infringement to S. Kann Sons Company was sent in bad faith, and for the malicious purpose of injuring Defendant (Counter-Plaintiff) SPELLright Corp. in its business; wherefore, Defendant (Counter-Plaintiff) SPELLright Corp. demands a preliminary and final injunction against the sending of letters of this kind and prays for an order by the Court directing Plaintiff (Counter-Defendant) to retract said notice.

40. As a result of the foregoing notice, S. Kann Sons Company has refused to deal further with the SPELLright Corp. and said notice as well as notices circulated to others have or will injure Defendant (Counter-Plaintiff) SPELLright Corp. in its business to an extent in excess of \$10,000.00, exclusive of interest and costs, unless Plaintiff (Counter-Defendant) is enjoined by this Court, and Defendants (Counter-Plaintiffs) pray for damages to be awarded therefor. Defendants (Counter-Plaintiffs) are not able at this time to assess the exact amount of damages, but will pray for leave to amend this Counterclaim and to state the quantity of damages specifically.

Fourth Count (Counterclaim)

41. When Defendant (Counter-Plaintiff) SPELLright Corp. approached Plaintiff (Counter-Defendant) Filmon Process Corp. as aforesaid, it disclosed, in confidence, to Plaintiff

(Counter-Defendant) trade secrets and confidential information in connection with self-correcting ribbons, a business in which Plaintiff (Counter-Defendant) had not theretofore engaged. Plaintiff (Counter-Defendant), upon information and belief, seeing the merit in Defendant (Counter-Plaintiff) SPELLright's trade secrets and information, disclosed the same to a larger manufacturer (Eaton Allen Co.) of ribbons, and aided and abetted it to compete with Defendant (Counter-Plaintiff) SPELLright so that Plaintiff (Counter-Defendant) would have a larger market for the material it was processing. Upon information and belief, the information and trade secrets thus communicated to Eaton Allen Co. were of great value to the latter in competing with the Defendant (Counter-Plaintiff) SPELLright. Wherefore Defendant (Counter-Plaintiff) claims the profits of Plaintiff (Counter-Defendant) and of Eaton Allen Co. gained from the use of said trade secrets. Defendant (Counter-Plaintiff) SPELLright will use the judicial processes of this court to determine the amount due and will then amend its pleadings to advise the Court as to the amount claimed.

Fifth Count (Counterclaim)

42. Plaintiff (Counter-Defendant) dominates the business known as a "converter" for typewriter ribbons. Eaton Allen Co. is a dominant producer of one of the component materials used in self-correcting ribbons of the type in question.

Plaintiff and Eaton Allen Co., on information and belief, conspired to drive Defendant (Counter-Plaintiff) out of business, in violation of 15 U.S.C. 1, and 15 U.S.C. 3, and thus give those two concerns a complete monopoly in the business of self-correcting ribbons. Some of the acts which were the result of this conspiracy included the malicious sending of groundless notices of infringement to Defendant (Counter-Plaintiff) SPELLright's customers, the filing in bad faith of the groundless infringement suit set forth in the Complaint, the sale by Eaton Allen Co. of self-correcting ribbons at an unreasonably low price, and possibly other acts to be added after further discovery. Wherefore, Defendant (Counter-Plaintiff) SPELLright has had its growth stunted, has lost customers, has had its reputation injured, and has been damaged in the amount of \$250,000.00. It therefore claims triple damages in the amount of \$750,000.00 plus costs and a reasonable attorney fee as provided in 15 U.S.C. 15.

- WHEREFORE, Defendants (Counter-Plaintiffs) pray for the relief sought in the five counts of the counterclaim plus costs and such other and further relief as the Court finds just and proper.

Respectfully submitted,

William D. Hall
Attorney for Defendants
904 Ring Building
Washington 6, D. C.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,
Plaintiff

v.

SPELLRIGHT CORPORATION,
WILLIAM H. WOLOWITZ,
Defendants

Civil Action No. 1514-63

REPLY TO DEFENDANTS' COUNTERCLAIM

The plaintiff repeats herewith all of the allegations in the Complaint and the prayer associated therewith.

1. The allegations of paragraphs 23, 27, 30, 31, 32, 33, 40, 41 and 42 are denied.

2. The allegations of paragraphs 24, 25 and 26 are admitted.

3. As pertains to the allegations of paragraph 28, the patent in suit was lawfully issued, is valid, and is and has been infringed by the defendant. The reasons set forth in defendants' Answer are insufficient to invalidate the patent in suit or overcome the prima facie presumption of validity. Accordingly, any allegations in defendants' Answer which may be incorporated by reference into paragraph 28 are denied.

4. As pertains to the allegations of paragraph 29, defendants never had any license under the patent in suit except that which may be implied as pertains to the right to use and sell material processed by the plaintiff. If the material processed by the plaintiff was not reprocessed by the defendants, no charge of patent infringement for use or sale of the same by the defendants is being alleged by the plaintiff in this suit.

5. The allegations of paragraph 34 are so intertwined with lengthy statements, some of which could be admitted, some of which are denied, and some of which the plaintiff is without information, that accordingly, paragraph 34 is denied in its entirety. By way of example, it is specifically denied that the parties ever agreed to an arrangement whereby either defendant had any exclusive rights to purchase ribbon material processed by the plaintiff; it is denied that the plaintiff ever breached any agreement with either defendant; and it is denied that the plaintiff ever arranged to supply material in large quantity to Eaton Allen Corporation so that it could compete on a large scale with defendants. Further, it is specifically denied that the defendants have sold "nothing other" than the self-correcting ribbons made with the material which the plaintiff processed for the defendants.

6. The allegations of paragraph 35 are denied.

7. The allegations of paragraph 36 are denied. However, it is admitted that notices making reference to the present suit were forwarded to purported customers of defendant SPELLRIGHT CORPORATION.

8. The allegations of paragraph 37 are denied. However, it is admitted that the letter reproduced in this paragraph purports to be a true copy of a letter sent by counsel for the plaintiff to the addressee stated therein.

9. The allegations of paragraph 38 are denied since the plaintiff is without sufficient information to admit or deny the same. However, this paragraph does quote verbatim the first sentence of paragraph 7 of the Complaint.

10. The allegations of paragraph 39 are denied.

However, it is admitted that a notice, corresponding to the notice reproduced in paragraph 37, was sent to S. Kann Sons Company.

Further replying to the Counterclaim of the defendants,

11. The plaintiff has communicated to all persons or entities who received a communication corresponding to the subject matter of the communication in paragraph 37 of the Counterclaim by forwarding an additional communication explaining in detail the manner in which the infringing ribbons originating from the defendants may be readily ascertained with respect to the non-infringing ribbons originating from the defendants.

12. On information and belief, there is no basis whatsoever for the allegations in the Counterclaim.

WHEREFORE, the plaintiff prays that the Counterclaim be dismissed with prejudice, that the plaintiff have the relief prayed for in the Complaint, that plaintiff have attorney fees for defending against a groundless Counterclaim, and such other relief as provided for by Rule 11(F.R.C.P.) or deemed just by the Court.

Irvin A. Lavine
801 Washington Building
Washington 5, D. C.
DI 7-8448
Attorney for Plaintiff

of Counsel:

Arthur H. Seidel
Edward C. Gonda
Land Title Building
Philadelphia 10, Penna.

CERTIFICATION OF SERVICE

It is hereby certified that a true copy of the foregoing document was sent by First Class Mail, postage prepaid, to William D. Hall, 904 Ring Building, Washington 6, D. C., attorney for defendants, this _____ day of July, 1963.

Irvin A. Lavine

FILED

JUN 22 1964

HARRY H. EULL, Clerk

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,

Plaintiff,

vs.

SPELLRIGHT CORP.,
WILLIAM H. WOLOWITZ, and
EATON ALLEN CORP.,

Defendants.

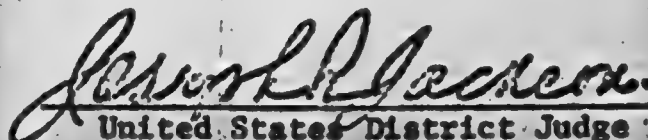
CIVIL ACTION

NO. 1514-63

ORDER

Upon consideration of defendants' objections to plaintiff's requests for admissions 5 through 27, and interrogatories 94 through 97, together with plaintiff's points and authorities on said objection, and the dismissal without prejudice of counts two, three, four, and five of defendants' counterclaim, it is this 22nd day of June, 1964,

ORDERED, that defendants' objections to plaintiff's interrogatories and requests for admission should be and hereby are sustained.


United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,

Plaintiff,

v.

Civil Action 1514 - '63

SPELLRIGHT CORP.,

WILLIAM H. WOLOWITZ,

Defendants.

MOTION TO DISMISS COUNT II OF THE
COMPLAINT

Now come Defendants and move for a judgment dismissing Count II of the Complaint, on the ground that it fails to state a claim on which relief may be granted.

Detailed Grounds For The Motion

Count II is repeated substantially verbatim in the pretrial order which incidentally further shows that Plaintiff attempted to amend its pleading to correct some of the deficiencies herein pointed out. The amendment was denied by the Assistant Pretrial Examiner and her decision was upheld by the Court.

The applicable statute is 35 U.S.C. 292. The second and third sentences of the statute are plainly inapplicable

to this case. The second sentence deals only with an "unpatented article" and Plaintiff's Complaint not only has no allegation to that effect but clearly alleges that the article in question is covered by a patent. Thus the second sentence of the statute is inapplicable.

The third sentence of the statute deals with articles marked " Patent Pending" or the like. The Complaint has no allegation along this line.

Therefore, we will compare the Complaint with the first sentence of the statute.

The first few words of the statute are:

"Whoever, without the consent of the patentee***
(Emphasis added)

The Complaint makes no allegation along this line and Plaintiff's attempted amendment to its pleading to supply this deficiency was refused.

The next words of the statute are:

"marks upon, or affixes to, or uses in advertising in connection with ***"

The Complaint mentions an "insert" in the box, which is quite a different thing than the things referred to in the statute. Plaintiff's proposed amendment saying that Defendants used the word "patented" in advertising material was refused.

The next few words of the statute are:

"made, used or sold by him ***"

There is no allegation in the Complaint that Defendants made or used the ribbons in question. The Complaint does say that Defendant Spellright formerly sold a ribbon made with Plaintiff's

material but no claim of false marking was made with respect to these ribbons. The Complaint also alleges that thereafter Defendant Spellright continued to put the insert in the box but it does not say that the ribbons were sold.

It is obvious that the Complaint does not allege anything similar to the next few words of the statute which are:

"the name or any imitation of the name of the patentee, the patent number ***"

The next few words of the statute read:

"or the words 'patent', 'patentee', or the like ***"

This part of the statute does not extend to the word "patented" for the words "patent" or "patentee" here refer to a particular patent or person, not to the general issue of whether the device is patented. The difference between "patent" and "patented" is made clear in the second sentence of the statute. The mere use of the words "Patented" or "Patented Construction" does not necessarily import that the maker or seller of the merchandise owns the patent.

The next few words of the statute are:

"with the intent of counterfeiting or imitating the mark of the patentee" ***

There is no allegation that the patentee ever marked anything under its alleged patent, much less that Defendant had an intent to imitate that mark.

The final few words of the statute read:

"with the intent *** of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee."

The Complaint alleges something quite different from the above,

namely, that Defendant seeks to misrepresent that nature of its merchandise. The Complaint also alleges that the marking did deceive Spellright's customers as to the ownership of the patent. As for the latter point, it is noted that the Complaint alleges that Spellright did deceive, but it does not allege an intent to deceive as to ownership of the patent. Moreover, ownership of the patent is quite a different thing from that forbidden by the statute which is "inducing them to believe that the thing was made or sold by or with the consent of the patentee".

The last few words of the statute refer to the case where Plaintiff owns the patent and Defendant intends to deceive the public by inducing them to believe that Plaintiff made the article or gave consent to Defendant to make the article. In contrast, the pleadings in this case say that Defendant represents that Plaintiff does not own the patent but that Defendant owns it.

Earlier in the statute it is made clear that in the case where Defendant misrepresents himself as the "patentee" (that is that he owns the patent), he must in order to be guilty do so "with the intent of counterfeiting or imitating the mark of the patentee." Since there is no such allegation in the Complaint, the alleged misrepresentation of ownership is not actionable.

It is noted that Plaintiff moved to amend its pleadings to conform with the last few words of the first sentence of the statute and the amendment was denied.

In view of the foregoing, Count II fails to state a claim on which relief may be granted.

Moreover, the Complaint should be dismissed since
a corporation may not bring an informer action of this type.

Respectfully submitted,

William D. Hall

William D. Hall
Attorney for Defendants

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMCON PROCESS CORP.,)	
Plaintiff,)	
v.)	Civil Action
SPELLRIGHT CORP.,)	No. 1514-'63
WILLIAM H. WOLOWITZ,)	
Defendants.)	

ORDER ON MOTION TO DISMISS
COUNT II OF THE COMPLAINT

Upon consideration of Defendants' "Motion To Dismiss Count II of the Complaint", the Memorandum of Points and Authorities in support of and in opposition to the Motion, and the arguments of counsel on February 10, 1967, it is

ORDERED, that the Motion is denied.

ENTERED this day of February, 1967.

Judge

Approved as to form:

Attorney for Plaintiff

Attorney for Defendants

FILMON PROCESS CORP.

SPELL-RIGHT CORP., et al.

1514-60

Complaint for patent infringement, false marking,
and unfair competition.

UNDISPUTED FACTS:

Plaintiff, Filmon Process Corp., is a New York corporation, having a place of business in New York City.

Walter Pleezer, Sr. and Walter Pleezer, Jr. have at all times owned sufficient stock to control plaintiff, Filmon Process Corp.

Defendant, Spell-Right Corp., is a District of Columbia corporation having a place of business in the District of Columbia.

Defendant Wolowitz is President of defendant corporation, and owns more than 50 percent of the stock in defendant corporation.

Patent No. 3,020,359 was issued on November 26, 1961, to "The Hagecraft Company, New York, N.Y., a partnership".

Under date of December 23, 1961, an assignment of said patent from The Hagecraft Company of New York, N.Y., to plaintiff, Filmon Process Corp., was signed by Walter Pleezer, as

Prior to November, 1952, plaintiff Wilson Process Corp. sold to defendant Spell-Night Corp. certain materials used in the manufacture of typewriter ribbons. Said materials were used in the manufacture of typewriter ribbons, which were sold under the name Spell-Night.

Subsequent to November 1952, defendant Spell-Night did not purchase further material from plaintiff.

Prior to the institution of this suit, plaintiff did not give any notice to defendant of the alleged patent infringement here claimed.

PLAINTIFF asserts:

On November 23, 1951, the U.S. Patent Office issued to McCauley Company, a partnership, Letters Patent No. 2,510,550, for an invention entitled "Printing Ribbon". Said patent was assigned by the McCauley Company under a valid assignment dated December 20, 1951 to the plaintiff, and the assignment was recorded in the United States Patent Office on November 13, 1952.

The patent in suit discloses and claims a printing ribbon comprising an elongated strip of flexible, pliable, absorbent woven nylon, an elongated strip of a flexible, pliable, impervious ink, impervious nylon film, said strips being in juxtaposed surface-to-surface relation along their entire length, and fused together only along their extreme elongated edges,

and within the absorbent woven nylon strip being impregnated with ink.

Count 3 - Patent Infringement

The plaintiff processed hundreds of thousands of tape units of ribbon as per the ribbon disclosed in the patent in suit for the defendants from January 1962 to about November 1962. After about November 1962 no further orders to process ribbons for the defendants were received.

At various times, defendant Wolowitz requested an exclusive license under the patent in suit, and offered to purchase the patent in suit outright. These offers were refused. In about September or October 1962, defendant Wolowitz stated that if he could not have an exclusive license or purchase the patent in suit, he would infringe the same.

During December 1962 - May 1963 the defendants made and sold ribbons according to the patent in suit. These ribbons constituted the writing portion of a composite writing and marking ribbon sold under the trademark "SPELLRIGHT" latest model or improved model. Bowed Spellright ribbons bearing the latest model designation were purchased in the New York area and contain ribbons which were not processed by the plaintiff nor made with their consent. (35 U.S.C. 271.)

Spellright ribbons sold during 1962 which included a writing portion processed by plaintiff were promoted as being of "Patented Construction". The only patent these words could have referred to is the patent in suit. By using this same language in association with the ribbons charged to infringe, the

Defendant Watson is the principal officer, principal stockholder, and guiding spirit of the defendant corporation and therefore is personally liable for infringement.

Count 2 - False Marking

Plaintiff asserts that it, and/or its related company, the Ejectcraft Company, formerly sold a typewriter ribbon to D Spellright Corporation; that D Spellright Corporation, realizing that such ribbon was patented and came within the scope of Patent No. 3,010,533, inserted into the boxes in which it packaged its self-correcting typewriter ribbon an insert bearing the legend "Patented Construction backing keeps type clean"; that this legend referred to Patent No. 3,010,533;

That when D Spellright Corporation ceased to purchase the printing ribbon formerly sold to it by plaintiff and/or Ejectcraft Company, it still continued to and still does insert the aforesaid insert bearing said legend into its package.

P contends that by using the aforesaid legend on said insert in its package, D Spellright seeks to and does mislead and deceive its customers regarding the nature of its merchandise, and deceives its customers into believing that D Spellright Corporation owns the patent on the backing which keeps the type clean, when in fact P owns said patent, namely Patent No. 3,010,533.

NOTE: At pretrial, counsel for P sought to assert its false marking claim as follows:

Without the consent of the patentee of the patent in suit, the defendants between about December 1962 and May 1963 and thereafter affixed the words "Patented", "Patented Construction", and words of similar import to brochures and other advertisements. These words were utilized in association with infringing ribbons thereby inducing the public to believe that the infringing ribbons were made by or with the consent of or with the participation of the patentee, which was false.

...asked for plaintiff to then asked leave to amend to make such allegation as to the false marking count (if it be held an amendment), and defendant objected to any such amendment at this time.

The statute (35 U.S.C. 292) provides a penalty of not more than \$500.00 for every offense and anyone may sue for the penalty.

Count 3 - Trade Secret

In December 1961, Walter Slegger, Jr., of the plaintiffs, made an oral confidential disclosure and demonstration to defendant Wolowitz of a method of making a printing ribbon having a weld seam down the middle of the ribbon. This involved making two ribbons as per the patent in suit, placing them one over one another with the film layers contacting each other, then cutting all the layers with a hot knife.

The defendant Wolowitz filed patent applications in the United States and Britain on the then secret method, claiming he was the inventor. The U.S. application was filed by Wolowitz on February 8, 1962, and it is not known if any patent ultimately issued. The British application was filed by Wolowitz on February 7, 1963 and was published on June 17, 1964.

The Spellright ribbons charged to infringe the patent in suit were made by this secret process disclosed to Wolowitz

by Mr. Walter Ploeger, Jr. in December 1961.

Plaintiff asserts that the method disclosed was conceived by Walter Ploeger, Jr. Plaintiff admits that at the time of the disclosure plaintiff corporation was not in existence, but asserts that upon its incorporation in December 1961 the method conceived by Walter Ploeger, Jr. became the property of plaintiff corporation.

On April 16, 1963, Walter Ploeger, Jr. filed a U.S. patent application on this secret process. This application issued as Patent No. 3,274,039 on September 20, 1966, and is owned by the plaintiff.

Plaintiff asks judgment for:

(1) A permanent injunction against further infringement of plaintiff's Patent No. 3,010,559 by defendants and those controlled by defendants;

(2) An accounting for profits received by defendants from sale of the infringing ribbons and consequent damages to plaintiff (plaintiff claims no other special damages);

(3) Reasonable attorneys fees and costs;

(4) Statutory damages under 35 U.S.C. 292 of \$500 for each and every offense of false marking, as alleged in Count 2;

(5) A permanent injunction against the acts of unfair competition by defendants alleged in Count 3.

Defendants deny that plaintiff is entitled to any of the relief prayed.

Count 1 - Patent Infringement

Defendants deny all allegations of patent infringement.

Defendants assert:

1. Plaintiff has accused only one ribbon allegedly made or sold by defendants as an infringement. Defendants deny sale of a ribbon such as that charged. Other than ribbons made of film material (admitted not to infringe) less than 1,000 ribbons were sold by said defendant Spallright. These were experimental ribbons, and substantially all were disposed of before the filing of this suit. The only notice of infringement was the filing of this suit. The damages recoverable even if plaintiff had a case (which is all denied) would, if anything at all, be de minimis and too small to justify invocation of the equity powers of this Court. This is true in view of 35 U.S.C. 207 which provides that no damages are recoverable prior to giving notice of infringement, where (as here) there was no compliance with the patent marking statute. Moreover, the sale of such a small quantity of 'experimental' ribbons is not actionable, even if they did infringe, which they do not.

2. There is no infringement for the reason that the claims of Ploeger U.S. Patent No. 3,010,559 do not read on the accused ribbons and the accused ribbons are not the equivalent of the thing shown in the patent.

3. By virtue of the doctrine of file wrapper estoppel there is no infringement. During the prosecution of his application, Ploeger repeatedly narrowed his claims and amended his

of the ribbon were attached to the extreme edges of the film only. Plesger's attorney argued that his client was entitled to a patent by virtue of this amendment, especially use of the ambiguous and indefinite word "extreme". The claim relied upon by plaintiff says that the ribbon is attached to the extreme edge of the film backing, ~~backing~~ while the accused structure has the ribbon attached in the middle of the film backing just as far from the extreme edge as it is possible to get. Therefore there is no infringement.

4. There is no infringement because in view of the state of the prior art the claims of the patent, if valid at all, must be so narrowly construed that there is no infringement.

(c) The patent is invalid since its subject matter was obvious to persons skilled in the art at the time the alleged invention was made (35 U.S.C. 103). In support of this defence, defendant relies on the following patents and publications taken singly or in combination with each other.

Encyclopedia Britannica, 1944 Edition, Volume 19, page 207A.			
U.S. patent	305,391	July 3, 1933	to J.T. Underwood
U.S. patent	1,984,623	April 16, 1933	to Pelton
U.S. patent	1,953,316	April 3, 1934	to R.A. Stark
U.S. patent	2,044,630	June 16, 1936	to Phelps
U.S. patent	2,163,661	June 27, 1939	to Hines
U.S. patent	2,235,099	June 2, 1942	to H.H. Bradaker
U.S. patent	2,437,295	March 9, 1949	to D.R. Eastwood
U.S. patent	2,526,630	Oct. 24, 1950	to H. Gabel
U.S. patent	2,623,536	Dec. 30, 1952	to J.M. Volpi
U.S. patent	2,657,157	Oct. 27, 1953	to Francis
U.S. patent	2,639,244	Jan. 11, 1955	to O.W. Markes
U.S. patent	2,726,706	Dec. 13, 1955	to R.I. Kakenaki
U.S. patent	2,730,439	Dec. 27, 1955	to Murphy, et al.
U.S. patent	2,733,819	July 31, 1956	to D.W. Gaddison
U.S. patent	2,771,534	Nov. 26, 1956	to J.L. Schuchman
U.S. patent	2,731,839	Feb. 19, 1957	to P.U. Seckrath, et al.
U.S. patent	2,739,742	Apr. 30, 1957	to Whorton
U.S. patent	2,232,640	Feb. 16, 1941	to Schwartzman
U.S. patent	2,736,913	June 25, 1957	to Fisher, et al.
U.S. patent	2,759,586	Aug. 21, 1956	to Juengerkes
U.S. patent	2,226,545	Nov. 5, 1940	to Reinhardt

502,000
25,000
520,800

Great Britain
Great Britain
Great Britain

Nov. 25, 1946
1913

5. The patent in suit is invalid for the reason that in securing the same the applicant for patent and the affiants who gave affidavits for use in the case misrepresented the facts relating to commercial success.

6. If it be concluded that the subject matter of the patent was not obvious to those skilled in the art at the time the alleged invention was made, then the disclosure of the patent is insufficient and inadequate as a matter of law to disclose to those skilled in art how to make the devices according to the alleged invention.

7. Plaintiff is not the owner of the patent in suit for the reason that there was no valid assignment from The Edgocraft Company to plaintiff, in that the partnership for whom Walter Ploeger purported to sign had been dissolved prior to the assignment, if such partnership ever existed.

Count 2 - False Marking

Plaintiff is barred from bringing this cause of action for the reason that only an individual and not a corporation may bring an action under 35 U.S.C. 292.

The charge of false marking apparently is not made with reference to defendants regular line of ribbons but only for the experimental ones, and the de minimis defense applies here.

Defendants deny the charge of false marking. Defendants literature was written by an independent advertising agency and which proceeded in good faith. That agency never heard, directly

or indirectly, of plaintiff's patent.

Moreover, defendants have issued any advertisements or other papers that referred to any particular patents, hence before plaintiff can prove false marking it must, among other things, show that there was no patent on the materials involved in defendant Spellright's ribbon. If plaintiff wishes to prove that there was no such patent, strict proof is demanded.

NOTE: If plaintiff be permitted to amend his charge of false marking under Count 2, as requested at page 4 heretofore, then insofar as there is a difference from the original complaint, defendants plead the three-year statute of limitations.

Count 3 - Trade Secret

Apparently, this cause of action relates to the experimental ribbons referred to above, so the de minimus defense applies here.

Defendants deny that plaintiff or Ploeger, Jr., had any novel ideas, much less trade secrets. To the extent that there were novel ideas they were the conception of defendant Wolowitz. Moreover, there was never any understanding, express or implied, that defendants were obliged to maintain in confidence anything submitted to them by plaintiff or Ploeger, Jr.

Moreover, according to plaintiff's own statement, plaintiff took out a patent on its alleged trade secret, and it therefore relinquished any rights to the alleged trade secrets thereafter.

Further, if Picoe, Jr. had any trade secrets, they did not belong to and never belonged to plaintiff corporation.

Further, if there were any trade secrets of Picoe or plaintiff corporation, defendants did not use them.

As to all three causes of action:

Defendants assert that plaintiff has misused its patent in suit and is barred from recovery under any of the three alleged causes of action because it is in this Court with unclean hands, in that:

(1) Without previously consulting defendants, plaintiff, through its attorney, sent letters, on or about June 21, 1963, to over 100 retail stores that had been selling products manufactured by defendants. Defendants assert over 80 of these letters went to stores that never sold the ribbon charged to infringe; that at least one letter was sent to a store that did not sell defendants' ribbon; that before sending said letters, plaintiff did not make any investigation to see what these stores were selling, but wrote the threatening letters without any justification or substantial reason to believe the stores were infringing; that at least one threatening letter was sent to a store in Canada, which was obviously outside the jurisdiction of the United States and obviously could not be

infringing a United States patent.

Defendants assert that the letters were sent not for the purpose of protecting any legal right, but for the purpose of harassing the defendants and said stores.

Defendants assert that after the letters were criticized by two judges of this Court and notwithstanding repeated requests by defendants that plaintiff correct the matter, plaintiff has not done so, and as a result defendants have lost practically all of the business which they had with the stores which received said letters.

Defendants further assert that the letters contained numerous inaccuracies and improprieties, as set forth in defendants' answers to plaintiff's Interrogatory No. 55, filed on February 13, 1964.

(2) Plaintiff has misused the patent in suit in an effort to restrain trade in unpatented material. Defendants assert that the claims of the patent in suit are limited to a ribbon that has been inked; that the ribbons that plaintiff sells are not inked and therefore not patented; that plaintiff has used the patent, and by this suit is attempting to control the market in plaintiff's unpatented ribbons which are not inked; that plaintiff has not offered licenses to its customers when it sells them its un-inked, and therefore unpatented, ribbons; that the only way that has been made available to plaintiff's customers to secure a license to practice the alleged patented invention is to purchase the un-inked (and therefore unpatented) ribbons from plaintiff and to ink them. Thus plaintiff has been misusing the patent to control the sale of unpatented ribbons.

As a part of the above misuse, as well as a misuse in and of itself, plaintiff and/or its alleged predecessor in title, Edgecraft Co. (or perhaps Edgecraft Process Co.) has sold some un-linked ribbons falsely marked with the number of the patent in suit.

(3) Plaintiff is in this Court with unclean hands since it is not pressing this suit for any proper purpose; but it is pursuing this suit in an effort to hurt the defendants financially and in an effort to use the judicial processes of this Court to find out how defendants make their self-correcting ribbons. Defendants assert plaintiff wants this in latter information to help itself, one of its affiliated companies of common ownership, or one of its customers, get into the business of making self-correcting ribbons. In this respect the owners of the plaintiff company are dominant in the business of slitting typewriter ribbons.

COUNTERCLAIM:

Defendants counterclaim for judgment:

1. Declaring the patent in suit is invalid and not infringed;
2. Declaring defendants were licensed by plaintiff to use the material furnished to them declaring that plaintiff has misused its patent and is in this Court with unclean hands;
3. Declaring that plaintiff had no trade secrets as alleged by plaintiff;
4. Declaring that there was no false marking by defendants as alleged by plaintiff;
5. For attorneys' fees as provided for in 35 U.S.C. 235.

[The remaining counts of the counterclaim were dismissed, without prejudice, by order of June 22, 1964.]

ANSWER TO COUNTERCLAIM:

Plaintiff denies that defendants are entitled to any of the relief prayed, on the basis of the facts alleged in respect to the principal action.

Facts under "UNDISPUTED FACTS".

It is stipulated the following may be admitted in evidence without formal proof of authenticity, subject to all other objections.

All plaintiff's pretrial exhibits as described in List of Plaintiff's Exhibits, numbered 1 through 35 EXCEPT:

57	67
58	32
59	34
63	35

defendant

As to Exhibit numbered 46, ~~plaintiff~~ will stipulate as to documents only identified at deposition

As to such documents, it is stipulated that those signed were signed by the persons they purport to be signed by, without any stipulation, however, as to their validity, and particularly as to Mr. Ploeger, it is not stipulated he was a partner in Edgcraft Company at the time he purported as a partner.

*Soft copies of U.S. and foreign patents.
Any other documents initiated by both
counsel prior to trial.*

(No. 1 thro 112)

All documents on Defendants Pretrial Exhibit List/EXCEPT:

No. 49
52
54
112

(Plaintiff's and defendant's lists of pretrial exhibits are attached hereto and made a part hereof.)

Plaintiff's and defendant's witness lists are attached hereto and made a part hereof.

If either counsel should learn of any additional witnesses, exclusive of impeachment witnesses, prior to trial, he will file a supplemental witness list with the Clerk of the Court.

The Examiner has requested counsel to come to the trial with the maximum authority to settle the case which will be allowed them by their principals.

Trial attorneys: For plaintiff - Morton S. Robson

For defendant - William D. Hall

ASSISTANT PRETRIAL EXAMINER

Attorney for Plaintiff

Attorney for Defendant

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FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,)

Plaintiff,)

v.)

Civil Action No. 1514-63

SPELLRIGHT CORPORATION,)

WILLIAM H. WOLOWITZ,)

Defendants.)

FILED

DEC 19 1966

ROBERT H. STEARNS, Clerk

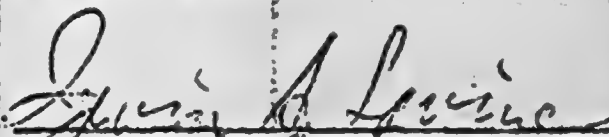
AMENDMENT TO PRETRIAL ORDER

The pretrial order is hereby amended to add to the Defendants' Contentions the following:

The patent is invalid on the ground that the claims thereof are indefinite and ambiguous.


Judge

No objection:


Attorney for Plaintiff

Defendants consent:


Attorney for Defendants

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

STENOGRAPHIC TRANSCRIPT

FILMON PROCESSING CORPORATION

vs.

C. A. No. 1514-63

SPELL-RIGHT CORPORATION, and
WILLIAM H. WOLOWITZ

DEPOSITION OF WALTER PLOEGER, SR.

Place: Washington, D. C.

Date: August 26, 1963

REPORTED BY:

Eileen King

WALTER H. LEE REPORTING SERVICE
GENERAL SHORTHAND REPORTING
518 SOUTHERN BUILDING
WASHINGTON 5, D. C.

REPRESENTATIVES IN PRINCIPAL CITIES

U. S. COURT OF CLAIMS

NATIONAL 8-6969

NOTARY PUBLIC

IN THE UNITED STATES DISTRICT COURT
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VS.

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WILLIAM H. WOLOWITZ.

Civil Action
No. 1514-63

Washington, D. C.,
Monday, August 26, 1963

Deposition of WALTER FLOEGER, SR., called for examination by counsel for the Defendant, pursuant to agreement in the offices of Moore, Hall & Pollock, Ring Building, Washington, D. C., beginning at 10:00 o'clock a.m., before Eileen King, a Notary Public in and for the District of Columbia, when were present on behalf of the respective parties:

For the Plaintiff:

Mr. Edward C. Gonda, and
Mr. Irvin A. Lavine

For the Defendant:

MOORE, HALL & POLLOCK
By: Mr. William Hall

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

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Mr. Irvin A. Lavine

For the Defendant:

MOORE, HALL & POLLOCK
By: **Mr. William Hall**

WHEREUPON---

WALTER PLOEGER, SR.,

a witness called for examination by counsel for the Defendant, having been first duly sworn, was examined and testified as follows:

TESTIMONY ON BEHALF OF DEFENDANT

BY MR. HALL:

Q. Would you state your name?

A. Walter Ploeger.

Q. You are the father of Walter Ploeger, Jr., who has testified previously in this case?

A. Yes, sir.

Q. What is your occupation?

A. I am the President of the Flexene Corporation, Edge Craft and Filmon Corporation.

Q. When you speak of Edge Craft, what is the full name of that company?

A. The Edge Craft Process Company, Incorporated.

Q. Is there a concern known as the Edge Craft Company?

A. No.

Q. Has there ever been such a concern?

A. Yes, sir.

Q. What is your capacity in that firm?

A. That company?

Q. Yes.

A. I was a partner.

Q. With whom were you a partner?

A. A Mr. Possehl.

Q. Over what period of time?

A. About ten years. I am sure about the time. I didn't look that up. I didn't bring my records. For ten years, I would say.

Q. Is Mr. Possehl still living?

A. Yes, sir.

Q. When did you dissolve the partnership with him?

A. I believe in 1959 -- I believe 1959.

Q. Did Mr. Possehl have any connection with the Flexene Corporation?

A. Yes, sir.

Q. What connection did he have with that?

A. He was the President of the Flexene Corporation.

Q. Did he have any connection with Filmon Processing Corporation?

A. No, sir.

Q. Did he have any connection with Edge Craft Process Corporation?

provements to Spell-Right's product, to Mr. Wolowitz. Do you recall mentioning that?

A. No, sir.

Q. Didn't your son, from time to time, try to tell Mr. Wolowitz how to improve the SPELLRIGHT ribbon?

A. I suppose he did. They always were talking together. I don't know what they were talking about.

Q. Well as best you know, were these suggestions just something that was given out of friendship, or was there some understanding that Spell-Right would pay for them?

A. No, I think Walter was impressed with Mr. Wolowitz' friendship. He wanted to help him along, make him a good ribbon, and the end would be that we would cut more ribbon and also would gain by having Spell-Right put out a good ribbon, and they both would gain. That was his aim, aimed to help Mr. Wolowitz all he could, and all these meetings were not official, on a personal basis. They both stuck their heads together -- "I show you this" and "I show you that." What do you think of it?" I recall Mr. Wolowitz sent letters to Walter, with samples, "Walter, what do you think of these? Give me your opinion." That is how friendly they were.

Q. It was simply friendly conversations?

A. That is correct.

Q. You wouldn't know whether it was nylon or not?

A. No, sir.

Q. It had to be some type of material that would fuse to the film though, wouldn't it?

A. I assume it had to be, yes, sir.

Q. Now, when the film and the fabric were passed through this machine, how far away from the extreme edge was the fabric fused to the film?

MR. GONDA: I don't understand the question.

MR. HALL: We will try again.

BY MR. HALL:

Q. The fabric 12 is fused to the film 14, at the extreme edge, both at the extreme right edge and at the extreme left edge. Is that correct?

A. That is right.

Q. Now, in the operation that your son performed, about the time he was applying for a patent, how far in from the edge did the fusion extend?

A. I did not examine the ribbon. I don't know.

Q. Would that depend upon how hot the knives were?

A. I couldn't answer that.

Q. The hotter the knife, the more of the material would melt. Isn't that correct?

A. Yes, sir, but it would burn the material. It wouldn't fuse anymore. You would burn it up. The edge gets brittle and it wouldn't be a proper edging. You couldn't use it.

Q. But would it be a correct statement to say that the number of threads of the woven material that would be fused would depend on the temperature at which the knife was, at the time of cutting?

MR. GONDA: I object unless counsel wants to limit it to specific material or specify that it doesn't apply to any specific material.

MR. HALL: We will say that it applies to nylon.

MR. GONDA: Do you want the question read?

THE WITNESS: I understand the question. I don't know. I never checked, and I don't know. I do know if you fuse too hot, the ribbon is no good. The edge is often brittle.

BY MR. HALL:

Q. The edge is brittle, if you fuse it too hot?

A. That is right.

Q. If you don't fuse it hot enough, then what happens?

A. It does not seal properly.

Q. It comes apart?

A. Certainly.

Q. Is the temperature at which you should effect the fusion rather critical?

A. I don't know. I understand it is kept at a certain temperature all the time. I wouldn't know.

Q. Do you know at what temperature your son keeps the knives when he fuses this material?

A. No, sir.

Q. How are the knives heated?

A. Electrically.

Q. Is there any form of thermostat that holds the knives at the proper temperature?

A. Yes, sir.

Q. Was experimentation required, to determine what this temperature was?

A. Yes, sir.

Q. Was this experimentation extensive?

A. Yes, sir.

Q. Do you recall when this experimentation took place?

A. No, sir.

Q. Was it when the machine was first built?

A. I assume so.

Q. I hand you Patent 3,086,901, and I notice that it is dated April 23, 1963. That is the issue date, isn't it?

Q. Yes.

A. Now did you name Kee Lox?

Q. No, who are they?

A. A typewriter manufacturer.

Q. How do you spell it?

A. K-e-e L-o-x.

Q. Do you do slitting for them?

A. Very little. They do their own slitting, and then there is Storms.

Q. Can you name any others?

A. Well, I would have to search my mind. We have Royal. That is all right now.

Q. Do you do slitting for Royal?

A. Yes, sir.

Q. What company is the largest distributor of typewriter ribbons in the United States?

A. I wouldn't know. I couldn't tell you. Probably
IBM.

Q. Is Schwarzenbach-Huber the largest distributor of typewriter ribbons?

A. No, sir.

Q. Have they ever been?

A. No, sir.

Q. You say IBM is the largest distributor of typewriter ribbons that you know?

A. Yes, inked ribbons, I believe so.

Q. Do you do slitting for IBM?

A. Some. I think the largest is Columbia Ribbon and Carbon at Glen Cove, on the Island. They employ about 3,000 people there, I understand.

Q. What is the difference between a slitter and a converter?

A. A converter sells ribbon cloth and sends the cloth to the cutter.

Q. Your four companies, I take it, are not converters.

A. No, sir, they are slitters.

Q. They are slitters?

A. Yes.

Q. Is Schwarzenbach-Huber a converter?

A. I don't know if they call themselves converters.

Q. Do you do all the slitting for Schwarzenbach-Huber?

A. I don't know.

Q. Do you know of anybody else that does any slitting for them?

A. I know they send some to Textile Cutting. I know that

Q. So far as you know, you do the great majority of

36. Has any owner of the patent in suit made, used, or sold anything under said patent or authorized anyone else to make, use, or sell anything under the patent in suit? If so, state in complete detail the thing made, used, or sold, by whom made, used, or sold, and all steps taken to market the same with the patent number. If there are records kept with respect to the patent marking, give the name and address of the custodian of these records.

Answer: Yes. The thing sold is a ribbon corresponding identically to that disclosed and claimed in the patent in suit. In addition, services have been rendered in processing ribbon material for customers who then ink the ribbon material and sell the same. No steps, as such, were taken by the plaintiff to market the patented ribbon with the patent number. No records were kept with respect to patent marking. No one has been licensed to make, use or sell the ribbon of the patent in suit except that implied license which flows from dealings with the plaintiff.

52. Did Plaintiff, or anyone purporting to act for Plaintiff, send to S. Kann Sons Co., Washington, D. C., a letter such as has been reproduced in paragraph 37 of "Defendants' Answer and Counterclaim"?

Answer: Yes.

53. If the answer to Interrogatory 52 is in the affirmative, state whether similar or identical letters were sent to other persons or companies.

Answer: Yes.

54. If the answer to Interrogatories 52 and 53 are in affirmative,

(a) List by date, sender and addressee all such letters so sent.

(b) State whether the texts of the letters so sent were identical to one another, or whether they differed from one another in any particulars, and if so, in what particulars.

(c) State whether any physical or chemical duplication techniques were employed in the preparation of said letters, and if so, what parts of said letters were so duplicated, where, and by whom.

(d) State whether the sending of any or all of said letters was authorized; and if so, which such letters were authorized, the name and address of the person who gave the authorization, and the circumstances surrounding the seeking and giving of each such authorization.

(e) Identify all replies which have been received to said letters, by sender, addressee, date, and present location and custody.

(f) State the source of the list of addressees who were so sent letters, and the circumstances surrounding Plaintiff's acquisition of said list of addressees.

Answer: (a) Letters dated June 21, 1963 and June 28, 1963 were forwarded to the addressees on the list attached hereto and referred to in the answer to interrogatory No. 51.

(b) The text of each first letter was identical and the text of each second letter was identical.

(c) I have been advised that the text of the letters was Xeroxed by personnel in the office of Arthur H. Seidel, Land Title Building, Philadelphia, Penna.

(d) Concurrent with authorization to file suit against the defendants, Arthur H. Seidel, Esq. was authorized

by me to take whatever appropriate action he deems necessary to protect the interests of the plaintiff. I believe Mr. Seidel prepared the letters in good faith and in his opinion the sending of these letters was appropriate action under the circumstances. The letters were not reviewed by any officer of the plaintiff before they were sent out by Mr. Seidel.

(e) On June 25, 1963 a Miss Libby Cooper of May Department Stores telephoned Arthur H. Seidel, Esq. and was advised by said Arthur H. Seidel, Esq. that the plaintiff does not charge the defendants with infringement as pertains to Spellright ribbons which were processed by the plaintiff, and said Arthur H. Seidel, Esq. explained to Miss Cooper the structural differences between the infringing and non-infringing ribbons so that Miss Cooper may readily ascertain which ribbons are considered to be infringements. On June 28, 1963, a Mr. Oppenheimer of Allied Stores telephoned Arthur H. Seidel, Esq. and said Arthur H. Seidel, Esq. advised Mr. Oppenheimer as to the same information referred to above in the conversation between said Arthur H. Seidel and Miss Cooper.

A letter dated July 6, 1963 from an attorney representing Miller & Rhoades, Inc. of Richmond, Virginia; letter dated July 3, 1963 from The Halle Brothers Co. of Cleveland, Ohio; letter dated July 5, 1963 from Luckey, Platt & Co. of

Poughkeepsie, New York; letter dated June 29, 1963 from the S. Kann Sons Co. of Washington, D. C.; letter dated June 27, 1963 from Stern's, New York, N. Y.; letter dated June 27, 1963 from attorney representing Hecht & Co. of Washington, D. C.; letter dated June 26, 1963 from Fedway; letter dated June 25, 1963 from Chatlins Department Stores, Inc. of Norristown, Penna.; letter dated July 2, 1963 from attorney for Rike-Kumler Co. of Dayton, Ohio; letter dated July 19, 1963 from Gimbel's of Milwaukee, Wisconsin.

All replies were addressed to Arthur H. Seidel, Esq., Land Title Building, Philadelphia, Penna. and are presently in his possession.

(f) When suit was brought, Arthur H. Seidel, Esq., asked me if I knew the customers of the defendants. I replied that I was familiar with many stores selling the Spellright ribbons since the same had been communicated to me by the defendant Wolowitz. I also stated to Mr. Seidel that customer lists may be available in the trade and that I believe a copy of the defendants' customers may be available. Thereafter, I made inquiries in this regard during a general business meeting with Eaton Allen Corp., and was advised by Mr. Glenn of Eaton Allen Corp. that he had a list of the customers of the defendants for Spellright ribbons which Mr. Glenn had received from Allied Stores. The list I received from Mr. Glenn was given to Arthur H. Seidel, Esq.

62. With reference to Plaintiff's answers to prior interrogatories, the following additional information is sought:

(a) With reference to Plaintiff's answer to Defendant's interrogatory 4, state when the Edgecraft Co. became defunct.

(b) Was there a written agreement dissolving the Edgecraft Co., and if so, state the date of the agreement and the names of the persons signing the same.

(c) State the date and the names of the persons signing each partnership agreement of Edgecraft Co.

(d) When was Edgecraft Process Corp. formed?

(e) Was there an agreement between Edgecraft Co. and Edgecraft Process Corp. assigning assets of Edgecraft Co. to Edgecraft Process Corp.? If so, state the date of each such agreement and the names of the persons signing the same.

(f) Was there any written agreement between Edgecraft Co. and Edgecraft Process Corp. assigning assets of the former to the latter in such broad terms as to include the patent in suit? If so, state the date of such agreement and the names of the persons signing the same.

(g) State the names of all of the partners of Edgecraft Co. at the time that the patent in suit was assigned to Edgecraft Co.

(h) When did Edgecraft Co. deliver the assignment (Ploeger, Sr. Deposition Exhibit 3, Id.) to Plaintiff?

(i) Who were the partners of Edgecraft Co. at the date given in answer to the immediately preceding interrogatory?

(j) With reference to Plaintiff's answer to Defendants' interrogatory 5A, state the names and addresses of the "many sources" set forth in said answer.

(k) With reference to Plaintiff's answer to Defendants' interrogatory No. 17, does Mrs. Ellen Godikit recall any of the facts set forth in Plaintiff's answer to Defendant's Interrogatory 17? If so, state in detail what she recalls.

(l) With reference to Plaintiff's answer to

Defendants' interrogatory 19, and particularly to the statement "ribbons originating from the Plaintiff which correspond identically with the inked half of the ribbon sample of interrogatory 5." State if Plaintiff has processed and/or sold any such ribbons within the past year.

(m) With reference to the "ribbons originating from the Plaintiff which correspond identically to the inked half of the ribbon sample of interrogatory 5", has Plaintiff processed any such ribbons other than those supplied to Eaton-Allen Corp., and Defendant Spellright Corp.?

(n) With reference to Plaintiff's answer to Defendants' interrogatory 35, state whether the Canadian Patent Office has allowed any claim in the Canadian application.

(o) With reference to Plaintiff's answer to Defendants' interrogatory 37, state how much of the \$15,208.64 represented ribbons that were supplied to Defendant Spellright Corp.

(p) With reference to Plaintiff's answer to Defendants' interrogatory 37, state how much of the \$15,208.64 represented ribbons that were supplied to Eaton-Allen Corp.

(q) With reference to Plaintiff's answer to Defendants' interrogatory 26, state the names and addresses of the "responsible persons" referred to in said answer.

(r) With reference to Plaintiff's answer to Defendants' interrogatory 26, and more particularly that portion reading

"in particular, the industry is very small and no other product marked 'patented' except the product referring to the patent in suit."

state what investigation or attempt was made to find products marked "patented" prior to the signing of this statement.

(s) With reference to the statement

"In particular, the industry is very small and no other product marked 'patented' except the product referring to the patent in suit."

state what products embodying the alleged patent in suit have been marked "patented". State in each case whether or not the product was inked. Also, in each case state whether the marking was on the product itself, or on the spool on which it was wound,

or on the box, or where else the marking was located. Further, in each case state any other words or numbers that are associated with the word "patented", as for example the patent number; and whether or not it referred to "patented" when inked, or the like.

(t) If in marking its product "patented" Plaintiff used any means of reproduction such as printing or a rubber stamp, etc., state the means with which the word "patented" was applied to the product, and state when this means was made or produced. For example, if the marking was applied by means of a rubber stamp, state when the rubber stamp was made and by whom; or if it was done by printing, state when the printing was first performed, and by whom.

(u) Was the alleged partnership Edgecraft Co. ever registered or recorded on the records of the city, county or state governments? If so, when and with what office or officer?

(v) Is the Edgecraft Co. to which the patent in suit issued the same as the partnership Edgecraft Process Co. formed in 1952 by Walter Ploeger, Ella Ploeger and H. N. Possehl, and recorded in New York County, N. Y.?

Answer: (a) Objected to.

(b) Objected to.

(c) Objected to.

(d) Objected to.

(e) Objected to.

(f) Objected to.

(g) Objected to.

(h) The plaintiff believes it received the assignment on the date of execution of the same.

(i) Objected to.

(j) Abraham & Strauss, Brooklyn, New York; Abraham & Strauss, Hempstead, Long Island, New York; New Era Ribbon and

Carbon Company, Philadelphia, Pennsylvania; Gimbels, Milwaukee, Wisconsin; Schwarzenbach Huber Company, New York, New York.

(k) Mrs. Ellen Godikit recalls all of the facts as set forth in the answer to defendants' Interrogatory 17.

(l) None having the identical width.

(m) Yes.

(n) No.

(o) \$7,107.28

(p) \$4,433.04

(q) R. Glenn, Eaton Allen Company, Brooklyn, New York; H. Looker, Kee Lox Mfg. Co., Rochester, New York; R. Cole, Quest Mfg. Co., Chicago, Illinois; J. Costello, Remington Rand Company, Middletown, Connecticut; J. Nagy, New Era Ribbon and Carbon Company, Philadelphia, Pennsylvania; F. Nichols, Columbia Ribbon and Manufacturing Company, Glen Cove, New York; S. Urso, Royal McBee Corporation, Hartford, Connecticut; president of Old Town Corporation, Brooklyn, New York.

(r) From past experience in the trade and from discussions with persons in the trade, no other products marked "patented" ever came to its attention. At trade shows, such as the Business Manufacturers Supply show, no such product marked "patented" was ever observed. None of the material processed by the plaintiff for third parties, except material referring to the patent in suit, was ever marked "patented".

(s) Inked ribbons originating from the plaintiff and the defendants. The marking "patented" or similar information

was applied to an overwrap for the product or on literature shipped with the product. The plaintiff has used the terminology that uninked ribbons originating from the plaintiff are patented when inked.

(t) The plaintiff has used a rubber stamp which is part of a make-up kit which has been in its possession for many years. By nature of the make-up kit, the information printed may be varied as desired. Packaging material or labels associated therewith for the inked ribbons originating from the plaintiff have been marked in a manner to indicate that they were patented products. The plaintiff does not know when the printing was first performed and by whom.

(u) Objected to.

(v) Objected to.

ALABAMA	Birmingham	Louis Pizitz	NORTH CARO.	Greensboro	Meyers Co.
ARIZONA	Phoenix	Korrick's	OHIO	Akron	M. O'Neil Co.
	Tucson	Levy's		Cincinnati	Mabley & Carew
ARKANSAS	Little Rock	Blass Co.		Cleveland	The May Co.
CALIFORNIA	Bakersfield	Fedway			Halle Brothers
	Oakland	Capwell's		Columbus	F & R Lazarus
	Pomona	Fedway		Dayton	Rike Kunler
	Sacramento	Hale's		Springfield	Edward Wren
	San Francisco	Hale's		Youngstown	McKelvey's
COLORADO	Denver	May-D&F			Strause-Hirschberg
		Denver Dry Goods	OREGON	Portland	Rhode's
CONNECTICUT	Bridgeport	D. M. Read's	PENNSYLVANIA	Allentown	H. Leh & Co.
	Hartford	Sage-Allen			Hess
	New Haven	Edw. Ma-ley Co.		Erie	Halle Brothers
	Waterbury	Howland-Hughes		Greensburg	Halle Troutman
IST. of COL.	Washington	Hecht Co.		Harrisburg	Pomeroy's
		S. Kann Sons		Levittown	Pomeroy's
		Lansburgh's		Morristown	Chatlin's
FLORIDA	Ft. Lauderdale	Jordan-March		Philadelphia	Gimbel's
	Miami	Jordan-March			Strautger Klotter
		Burdine's		Pittsburgh	Kaufmann's
		Richard's			Joseph Horne
GEORGIA	Atlanta	Rich's		Reading	Pomeroy's
ILLINOIS	Chicago	The Fair		Scranton	The Globe
INDIANA	Indianapolis	Wm. H. Block Co.		Wilkes Barre	Pomeroy's
IOWA	Dubuque	Roshek's		York	Son Ton
LOUISIANA	Baton Rouge	Rosenfield's	RHODE ISLAND	Providence	Shepard Co.
	Lake Charles	Muller Co.	TENNESSEE	Cleveland	Miller's
NEW ENGLAND	Baltimore	Hecht & Co.		Memphis	Goldsmith's
		Hochschild-Kohn	TEXAS	Amarillo	Fedway
MASS.	Boston	Jordan-March		Corpus Christie	Fedway
	Pittsfield	England Bros.		Dallas	Titcher-Gottiger
	Springfield	Forbes & Wallace		Houston	Foley's
MICHIGAN	Detroit	J. L. Hudson		Longview	Fedway
	Grand Rapids	Herpolsheimer's		San Antonio	Joske's
		Wurzburg's		Wichita Falls	Fedway
	Lansing	F. W. Arbaugh	UTAH	Salt Lake	Auerbach's
	Muskegon	Hardy-Herpolsheimer			ZCMI
MINNESOTA	Minneapolis	R. S. Donaldson	VIRGINIA	Newport News	Nachman's
		Dayton's		Richmond	Miller & Rhoads
	Rochester	Donaldson's			Thalheimer's
	St. Paul	The Esorium	WASHINGTON	Eugene	Bon Marche
MISSOURI	Springfield	Heer's		Seattle	Bon Marche
	St. Louis	Famous-Barr		Tacoma	Rhodes
NEBRASKA	Omaha	J. L. Brandeis		Yakima	Bon Marche
NEW JERSEY	Newark	Kresge-Newark	WISCONSIN	Green Bay	H. C. Prange
	Perth Amboy	Reynold's		Madison	H. Manchester
	Trenton	S. P. Dunham		Milwaukee	Gimbel's
NEW MEXICO	Albuquerque	Fedway			
NEW YORK	Albany	Whitney's	CANADA	Alberta	Woodward Stores
	Brooklyn	Abraham & Straus			
	Buffalo	A H & A			

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORPORATION

v.

CIVIL ACTION

SPELLRIGHT CORPORATION,
WILLIAM H. WOLOWITZ,
and
EATON ALLEN CORPORATION

NO. 1514-63

Philadelphia, Pa., May 29, 1964

Oral deposition of John Nagy

George H. Lennox, Jr.
OFFICIAL COURT REPORTERS
UNITED STATES DISTRICT COURT
PHILADELPHIA 7, PA.

see why we can't go forward, so you may proceed.

JOHN NAGY, having been duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. GONDA:

Q Would you state your full name, please?

A My name?

Q Yes.

A John Nagy, N-a-g-y.

Q Your home address, please?

A 13 Schoolhouse Lane, Broomall, Pennsylvania.

Q Your business address, please?

A It will now be 1222 Cherry.

Q With what company are you associated?

A We own New Era Ribbon & Carbon.

Q When you say we, --

A Well, myself, my wife. It's a family operation.

Q Are you familiar with a product which comprises a fabric having a film connected to the fabric only along the edges of the fabric?

A Yes, nylon.

Q Nylon fabric?

A Nylon fabric with a film.

Q Do you also know this fabric under the name of Filmon?

A Yes.

Q Have you or has your company ever sold this product called Filmon?

A Yes.

Q In what width?

A Half inch, 9/16, 3/4, a little inch and 3/8.

Q For how long?

A Since 19 -- since I went in business, 1960, I believe; yes, 1960.

Q For what type of equipment are these products in the various widths you mentioned used?

A 3/4 for tabulators; half inch and 9/16 for the conventional typewriter. The wider widths were for Addressograph.

Q What do you mean by wider widths?

A Inch and 5/8, inch and 7/8.

Q And from whom have you purchased this Filmon material?

A Schwarzenbach.

Q Have you purchased Filmon material from anyone else other than Schwarzenbach?

A Yes. We purchased some from Standard Products -- Standard Products, and I can't think of the other name. We purchased through one other source; a small amount from

BY MR. GONDA:

Q I asked you whether it was before or after you gave him the ribbons.

A I think it was before. Again, I think it was before; I am not sure.

Q I show you an affidavit forming pages 37, 38, and 39 of the file wrapper of U. S. Patent 3010559, and I ask you if you recognize the signature on page 39.

A 39?

MR. KLINE: That is the same as this.

THE WITNESS: This is different.

Oh, down here?

BY MR. GONDA:

Q Is this your signature?

A Yes, it is.

Q Would you review the affidavit, please, and tell me when you are finished as to whether there is anything in the affidavit that you wish to change?

MR. HALL: I think I will object to that as a leading question.

MR. GONDA: In view of the objection, I would like to rephrase the question, and ask the witness, after he has reviewed the affidavit, would he state whether the statements in the affidavit are true?

testimony that the statements in this affidavit, on pages 37, 38, and 39 of Patent 3010559 are true?

MR. HALL: I object as leading.

THE WITNESS: Well, the answer to it is yes, these are what we found. This is what most people found.

I can't say anything other than that.

BY MR. GONDA:

Q Mr. Nagy, has Mr. Ploeger or Filmon Process Corporation ever suggested to you that you buy other products from them?

A From them?

Q In order for you to be able to purchase Filmon material?

A They have nothing else to sell us because we buy from the cloth cutters and we don't buy from a cloth cutter.

Q Has Mr. Ploeger or Filmon Process Corporation ever suggested to you that you utilize their cutting or slitting services in order for you to be able to obtain Filmon material?

A No.

MR. GONDA: I have no further questions, Mr. Hall.

MR. HALL: I have a letter which I would ask the reporter to mark Defendants' Exhibit No. 1 Nagy Deposition for identification.

(Letter, undated, but bearing received stamp January 20, 1964, on letterhead of New Era Ribbon & Carbon Company, Inc. to Spellright, signed John, was marked Defendants' Exhibit No. D-1-Nagy Deposition, for identification.)

CROSS-EXAMINATION

BY MR. HALL:

Q Mr. Witness, would you be so kind as to look at this exhibit and tell us if that is a letter which you wrote?

A Yes, it is. I wrote that.

The date is on there. I thought this would be a terrific thing for Mr. Wolowitz's ribbon.

Q Better than the Filmon material of Mr. Ploeger?

A Yes, this is what I thought, yes.

Q You said here in the letter, the last four words of the first paragraph, "...and will not bulk."

A That's right.

Q What does that mean?

A That means in Filmon, the two edges are fused and this being fused across the whole thing won't have a sort of a stocking or bulking. You see, a Filmon ribbon bulks.

MR. HALL: Off the record.

THE WITNESS: A Filmon ribbon bulks, anything, it's like a stocking, and the film is of a different con-

sistency or length, if you want to call it, and constant pounding on the typewriter will cause it to bulk or pucker or do some such thing; and this causes bad feeding through a typewriter.

Our experiences with the Spellright ribbon were that a certain part of it did buckle and I was trying to do him a favor in trying to promote this with him.

Q Your findings were that the Filmon material was the thing that did the bulking; is that right?

A Yes.

MR. HALL: Now off the record.

(Discussion off the record.)

BY MR. HALL:

Q Now you mentioned in your letter that this cotton material held more ink than the Filmon material.

Is that a true statement?

A Well, how do you answer such a question?

Let me put it this way -- in our opinion, it did. In our opinion, it did, if you want to mark that down.

We have run a few tests, not extensive tests, but I have been after this kind of stuff for so long it isn't funny, to have it laminated right solid.

Q You mean when you say "this kind of stuff" you are referring to the cotton material that is attached to the letter

of Defendants' Exhibit 1?

A Yes.

Q And that is quite old then and the art goes back ahead of 1959?

A No, I don't think the art goes back that far. This is something we are fooling around with and we don't even know if it is going to be any good yet.

Q Was the Filmon material of Ploeger any better than ordinary nylon so far as holding ink was concerned?

A Well, we found it to be true. That's why in here that we thought it was true, yes.

Q Now is it your understanding that you are giving a deposition in a patent infringement suit brought by the Filmon Corporation against the Spellright Corporation?

A This is all news to me.

Q Well, I know, but is it your understanding that you are now giving a deposition in this suit by Filmon Process Corporation against Spellright Corporation?

A I am only stating the facts as I know them and see them. I have nothing to -- I don't know anything about -- you hear about these things, but I don't want to be involved. I am only telling what happened to me with the Filmon ribbon.

Q I would like to show you a copy of U. S. Patent No. 3010559 to Mr. Ploeger.

Have you ever seen that patent before?

A Boy, if I did, I haven't seen it --

Q You say you haven't seen it before?

A Let me put it this way -- I don't remember seeing it.

I have checked patents and whathaveyou, but I don't recall.

Q Did you ever see the drawing before that is on the front of that patent?

A No, positively not. I didn't see this.

Q Now, of course, before the patent issued there were some papers that constituted an application for the patent. Did you ever see them?

A I worked -- no, I don't believe I have seen anything like that before, no.

Q You mentioned something about this affidavit that is in the file wrapper at pages 37, 38, and 39.

Would you tell us the circumstances under which you signed the affidavit, that is, who came to you and talked to you about it and wrote it up and things like that?

Tell us all the circumstances that you can remember with reference to you signing that.

A Well, Flexene or Edge-Craft made it. They made it way back in 1959, if I remember right. I think it was an experimental run at the time.

MR. GONDA: I think you misunderstood the

question.

MR. HALL: Let him go on.

BY MR. GONDA:

Q Have you understood it whereby Mr. Hall is asking you the circumstances which surrounded the affidavit?

He is not talking about Filmon material.

A Well, how this came about is from what we understood when this thing was first made, people had a lot of difficulty in inking it and we had equipment there that we had no real problem inking it on; so, on the strength of this, I believe that Walter came to me and asked me would I go ahead and help make up such a thing as we did, and would I sign this for patent purposes.

These were our findings and I did and from there on you fellows took it over.

BY MR. HALL:

Q Who came to you with the affidavit in blank form before you signed it? Was it Mr. Ploeger, Jr.?

A No.

MR. GONDA: I think that is a leading question here, Mr. Hall.

MR. HALL: I am entitled to --

MR. GONDA: There has been no testimony to that effect. I think that is an unfair question and I object

to it very strenuously.

MR. HALL: I am entitled -- you tried to introduce the affidavit. I am entitled to ask him how it got there.

BY MR. HALL:

Q Who was it that brought you the piece of paper to be signed?

A I don't know. I couldn't -- I don't even recall who came to have it signed.

I know Walter did not come.

Q Was it Mr. Seidel, who is sitting over here?

A Mr. Seidel? This is the first time I saw Mr. Seidel and I don't remember -- it could have been somebody else in your office that came over with it.

Q Did they mail it over to you or bring it to you by hand?

A I will say I don't recall. I honestly don't recall that.

We are so damn busy we don't know whether we are coming or going and I don't remember whether it was mailed or in person.

Q Were any other papers brought along with it at the same time for you to look at?

A Not that I remember.

Q At the end of the affidavit, in the next-to-the-last paragraph, you say,

I have received enthusiastic reports from customers who applaud the ribbon of the above-identified patent application as being the major advance in printing ribbons in recent years.

A Yes, we had people call us up and tell us that.

Q That was all oral?

A Oral.

Q They didn't write you --

A No, sir.

Q -- any letters?

A No.

Q And all that that is based on is that other people called you and told you that?

A Yes, this is correct.

MR. HALL: Then I move to strike both in connection with his direct examination and that part of the cross-examination relating to that part of it as being hearsay.

MR. GONDA: I don't think that there is any problem at this time. I think that if Mr. Hall has an objection to this he should raise it at the trial.

I don't believe it is necessary for me to take a position regarding Mr. Hall's motion here.

BY MR. HALL:

Q When did you first start selling Filmon material?

A I believe in '60.

Q Now did the Filmon material that you sold have a nylon inked portion?

A Yes. We did the inking. We bought the cloth.

Q And the cloth was nylon?

A The cloth was nylon. The film, I don't know.

Q You don't know what it was?

A No.

Q I gather that you never did know what the backing was made out of --

MR. GONDA: I object to that.

BY MR. HALL:

Q -- that is, what the film was made out of?

MR. GONDA: I object to the leading question.

THE WITNESS: No. It was not our business.

I did not know.

BY MR. HALL:

Q Is there anything involving capillary action that goes on in this Filmon material?

A Capillary action in typewriter ribbons goes on in all fabrics. With the film, you get a little bit more because of the nature of the two films, because the clear film will hold some ink, thereby, with a continual striking, it will pick up back and clean the back of the film off in time.

Q Have you ever seen film on material used in multilith machines?

A Yes. We sold some for -- not multilith machines -- multilith -- on multilith plates, which in turn goes through the multilith machine for printing.

I am sure you are familiar with that. You type on a mat and the mat then works from the multilith machine really.

Q Perhaps you misunderstood my question.

I asked you whether you ever saw any actually on the multilith machine.

A Not ribbons, no, no.

MR. HALL: All right. Then I move to strike that portion of the affidavit and that portion of his testimony which refers to use on multilithograph machines.

MR. GONDA: I don't think it is necessary, at this time for me to take a position in that regard.

BY MR. HALL:

Q Did you ever see the Filmon material actually in use in a computer?

A Yes, I have -- well, a computer? Now it depends on what you call a computer. A computer can be an adding machine, it could be a 407 tab, or whathaveyou. These we have seen, yes.

Q Now you have seen what?

A Working in these computers.

Q In which type of computer? The adding machine?

A 407 and the adding machine; both.

Q On an experimental basis?

A Yes. That's how I saw it.

Q If, instead of attaching the film to the ink-bearing layer of the film material only at the edges of the film, the film had been attached across the entire width of the absorbent nylon material, would it have been better or worse?

MR. GONDA: I object. There is no testimony that the witness has made any tests in this regard; therefore, no basis for such a question having shown that the witness is capable of expressing an opinion in that regard; therefore, the question also calls for an opinion, so I will object to the question.

MR. HALL: I am very glad you said that, Mr. Gonda, and I will accept your statement because the affidavit in the third paragraph of page 2 of it makes quite a comparison between those two situations.

Therefore, in view of counsel-for-the-plaintiff's statement I will move to strike that paragraph, which is the third full paragraph on page 2 of the affidavit.

MR. GONDA: I think you misunderstood me, Mr. Hall.

I said that you have not shown that the witness has made any tests. I have not stated that no tests were made.

Until you have shown that the witness has made these tests I think the question is out of order. If you will ask him whether he knows this for a fact and how he knows it, that's another story; but the way you presented the question and the record as it stood up to that point, in my opinion, is showing that the witness has not made any tests. Therefore, I think the question is objectionable at this point.

MR. HALL: All right. Then the original affidavit was equally objectionable and my motion to strike it applies.

Thank you very much, Mr. Gonda.

BY MR. HALL:

Q Now, Mr. Nagy, would you look at page 3 of the affidavit, the first full paragraph there, where you say,

I have sold printing ribbons in accordance with the above-identified patent application to almost every major manufacturer of office equipment in the United States and to manufacturers of other types of printing equipment and multilithograph machines.

A This is a wrong statement, almost every major manufacturer. We did not.

Q Are you selling it today to any major manufacturers of office equipment? I won't ask their names.

A Not manufacturers. This is one place where we did not sell manufacturers.

We sold it to consumers and users. The word "manufacturers" should not be there, actually.

Q Are the Ploegers in the business of slitting ribbons?

A Slitting fabric, yes.

Q Talk to the gentleman over there.

Is it generally understood in the trade that a slitter keeps the business of his clients confidential?

A I don't know. No, I don't know. I don't know that.

Q Well, would you expect that one manufacturer who is dealing with a slitter, that the slitter would go out and tell competing manufacturers what the first one told him about?

MR. GONDA: I will object to the question. It is purely hypothetical. It calls for a mind reading process.

MR. HALL: I am asking him for the custom in this trade.

MR. GONDA: And we don't know who the customers are --

THE WITNESS: Ask that again.

MR. GONDA: -- that are being referred to here.

MR. HALL: All right.

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,

Plaintiff,

v.

Civil Action 1514-63

SPELLRIGHT CORP.,
WILLIAM H. WOLOWITZ,

Defendants.

Washington, D. C.

October 2, 1967

The above cause came on for trial before
THE HONORABLE ALEXANDER HOLTZOFF, United States District
Judge, at 10:00 am.

Appearances:

For the Plaintiff:

MORTON S. ROBSON, ESQ.,
EDWARD C. GONDA, ESQ.,
IRVIN A. LAVINE, ESQ.

For the Defendants:

WILLIAM D. HALL, ESQ.

- - -

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WITNESSESDIRECTCROSS

PLOEGER, WALTER JR.

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EXHIBITSFOR IDENTIF.IN EVIDENCE

Plaintiff's:

1 - File Wrapper

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2 - Certified copy of Patent
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3 - Test samples conducted on auto-
matic electric typewriter

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4 - Assignment of patent to plaintiff

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feel that in the interest of expedition and justice we would be willing to waive a jury under those circumstances since Your Honor will decide all the issues anyhow.

THE COURT: Is that agreeable to you, Mr. Hall?

MR. HALL: Very much so.

THE COURT: Very well. Both sides waive a jury trial. We will proceed without a jury.

MR. HALL: Your Honor, I overlooked something when I spoke to you before.

In their pretrial statement and in their pretrial order they didn't claim any damages, they only claimed the accounting, they just asked for the accounting in the pretrial.

THE COURT: That is all they could get, anyway, in view of the waiver of a jury trial.

Thank you.

You may proceed, then, gentlemen. You may make an opening statement.

PLAINTIFF'S OPENING STATEMENT

MR. ROBSON: May it please the Court, this action is presently in three separate issues, three separate areas. On the one hand, we are claiming that a patent owned by the plaintiff has been infringed. Secondly, we are claiming that the defendant improperly marked as patented an item which

it was selling which was not patented, in violation of the false marking statute. Thirdly, we are claiming that the defendant improperly used a trade secret or trade secrets of the plaintiff which had been revealed to the defendant in confidence by the plaintiff.

I will address myself, first, very briefly, to the question of patent infringement, which will be the principle issue at the trial.

The patent involved is a rather simple one. It is a typewriter ribbon or an impression ribbon or a printing ribbon. It is variously termed by different people --

THE COURT: What is it used for?

MR. ROBSON: For typewriters, business machines, any machine that a key of some sort hits a ribbon and makes an impression on some paper.

Prior to the invention of the plaintiff all typewriter ribbons which were in use involved a material which was filled with ink and which was placed between a key and the paper so that when the key struck it the impression was made on the paper.

I may be over-simplifying things but I do it only to help myself in presenting this.

THE COURT: I think it is always well to simplify

referring to Ploeger, and that disposes of the issue as specifically framed in the complaint because the complaint merely says we used the patent to represent their patent. They don't allege that there was no patent involved in our device, because there were. There were patents all over our ribbon. Scotch tape is patented. You get one dollar above the de minimis amount of selling an infringing Scotch tape and you will have Minnesota Mining on your back in three minutes. Your Honor is familiar with the aggressive character of M.M.M. in suing on their Scotch tape patents because there have been such legal fusses go on that I can't imagine that you haven't heard about it. You know they have been suing everybody two or three times on that. Their famous case was against Plymouth Rubber Company, I believe.

So, Scotch tape is patented. When we say we got a patented backing, it was patented. The Scotch tape was patented and we bought it from M.M.M.

Now that is not the reason that Mr. Kaufman put the word patented down, I am sure, but it is a true statement. Mr. Kaufman apparently was under the impression that Mr. Wolowitz had a patent because the Patent Examiner had allowed a claim to Mr. Wolowitz at this time and Mr. Kaufman maybe had heard about that at another time. He wasn't told about that

THE COURT: Isn't that the same as your process?

MR. ROBSON: There cannot be leakage because we do not melt.

THE COURT: What do you do?

MR. ROBSON: We weld, and there is a substantial difference between welding the edges and melting.

THE COURT: What is the difference between welding and melting?

MR. ROBSON: When you melt you melt one material into another. Only one material is changed in composition. It softens and then seeps in.

THE COURT: Then you make a single material out of the two?

MR. ROBSON: Yes, and that is where the difference is.

THE COURT: Very well. I don't want to try the case on opening statements, I just wanted to crystallize the issues.

MR. HALL: Could I say a word on that question?

THE COURT: Yes, indeed, Mr. Hall.

MR. HALL: Your Honor, Mr. Robson I think has not read his own patent. Could you look with me at column 2 --

THE COURT: Which are you referring to?

don't know that it makes any difference what I think. I think so too, but after all, I don't sit here to overrule the Supreme Court.

MR. ROBSON: But with all due respect to the Second Circuit and the Supreme Court, that is not our case.

Mr. Ploeger tried the German patent and the German approach would not work and I will tell you why it wouldn't work. The German approach involved, number one, two dissimilar materials, a thermoplastic and a natural fiber.

THE COURT: Is it your claim that the German patent is inoperative?

MR. ROBSON: It is inoperable.

THE COURT: You will have to prove that, of course.

The burden of proof is on the party that claims that a prior art patent is inoperative.

Your contention is it is inoperative?

MR. ROBSON: Yes, sir.

THE COURT: In what respect?

MR. ROBSON: Because the edges, the seam that was provided for was provided to be made by melting the thermoplastic into the fabric. That melting did not create a seal, so that ink was permitted to leak around the edges of that onto the other surface of the film.

MR. HALL: Ploeger's own patent, column 2, line 9. He refers there to his woven strip, which is the thing that carries ink, may be cotton, silk or nylon.

Now silk is one of the materials that is specifically named in the German patent.

THE COURT: I see.

MR. HALL: Now if you go on down to line 20 of Ploeger's patent, column 2, you will see that Ploeger describes as his invention exactly the thing that Mr. Robson says was not his invention and was the German thing that won't work.

THE COURT: What line are you referring to?

MR. HALL: Line 20. He says:

"When the edges 14a of the impervious strip 14" -- now the impervious strip 14 is the film backing-- "are fused to the edges 12a of the absorbent strip 12, some of the material of the impervious strip 14 penetrate into the edges 12a of the absorbent strip 12 to provide a strong bond between the edges 12a and 14a."

Well, now, remembering that the upper strip may be cotton, it is well known that nylon can not weld to cotton. Nylon can only flow up into cotton and, in effect, grab onto it and hold it, which is the very thing that Mr. Robson was

telling you won't work.

Now let's read on:

"In addition, the fused seal between the edges 12a and 14a provides the ribbon 10 with ravel-proof edges. Although in the illustrated embodiment of the ribbon 10 of the present invention, the edges 14a of the impervious strip 14 are shown to be fused to the edges 12a of the absorbent strip 12 . . ."

Now let's stop right there and look at the drawing. If you look at Ploeger's drawing, figure 4 right at the left end of it, you will see 14a. You will see that the film is now distorted due to the heat and the film has been melted up and flows into the cloth that is up on top, the cloth 12. The film has been melted into the cloth at the borders.

And if you read that claim of the German patent you remember it said that the film is melted into the borders, at the borders only. That is exactly what Ploeger says that he is doing and he names exactly the same material.

THE COURT: Mr. Robson, you have the usual file wrapper, of course.

MR. ROBSON: Yes, sir.

THE COURT: I would like to have it at the beginning.

You can offer it in evidence so as to make it of record.

MR. ROBSON: I will offer in evidence as Plaintiff's Exhibit 1 the file wrapper in this case.

(File Wrapper marked Plaintiff's Exhibit No. 1 and received in evidence.)

THE COURT: Now I will give you back your copy of the complaint, but I would appreciate it if you can have a loose copy for me by morning. Can you have that done?

MR. ROBSON: I certainly can, sir.

THE COURT: You may proceed.

MR. ROBSON: The plaintiff calls Walter Ploeger, Jr.
WALTER PLOEGER, JR.

called as a witness by Plaintiff, having been duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. ROBSON:

Q Will you state your name and address, please?

A My name is Walter Ploeger, Jr. I live at 1404

Dewey Avenue, North Bellmore, New York.

Q Are you associated with the plaintiff in this action?

THE COURT: You may ask leading questions for this preliminary matter so as to save time.

BY MR. ROBSON:

Q Are you the vice-president of the plaintiff, Mr. Plonker?

A Yes, sir.

Q What is the business of the plaintiff, Filmon Process Corp.?

A The Filmon Process Corp. cuts edges various widths, ribbons made of nylon films, papers and so on, for various commercial purposes.

THE COURT: It does what?

THE WITNESS: It slices ribbons of various widths used for various commercial purposes.

Q From whom does the Filmon Process Corp. receive the material which it processes or cuts into ribbon?

A The material, the fabric material that we process is sent to us by our customers who own cloth and direct us to cut this cloth into various widths.

THE COURT: You mean all you do is cut ribbons for other people?

THE WITNESS: Yes, sir. We are highly specialized in this respect.

THE COURT: It must be a very specialized industry.

THE WITNESS: Yes, sir.

BY MR. ROBSON:

Q What is your educational background, Mr. Ploeger?

THE COURT: Are you trying to qualify the witness as an expert?

MR. ROBSON: Yes, sir, in this area.

THE COURT: I mean are you going to elicit expert testimony from him? If you are not, I think this is immaterial.

MR. ROBSON: We will elicit some expert testimony at this time and probably more on rebuttal.

THE COURT: Very well.

A Would you repeat the question?

Q What is your educational background?

A I attended Syracuse University and Brooklyn Polytechnic Institute in Brooklyn, New York.

Q For how long have you been associated with Filmon Process Corp.?

A I have been associated with the Filmon Process Corp. since its inception.

Q When was that?

A January of 1962.

Q Prior to your association --

A Yes, that is correct.

THE COURT: January 1962 was the time the plaintiff

corporation was organized?

THE WITNESS: Yes, sir.

BY MR. ROBSON:

Q Prior to your association with Filmon Process Corp. with what company or business were you associated?

A I was associated with the Flexene Corp., with the Edgecraft Process Corp., and with the Edgecraft Company.

Q Where were these companies located?

A They were located in New York City.

Q Were they in the same premises where the Filmon Process Corp. eventually operated?

A Yes, sir.

Q And were they in the same business as the Filmon Process Corp.?

A In a similar business.

Q For how long all told have you been connected with the business of cutting and slicing material into ribbons?

A I started relatively young. I believe I have been 20 years in this business.

Q Have you ever designed or built any machines for use in cutting ribbons?

A Yes, sir, I have.

Q Have you obtained patents on any such machines?

A Yes; I have obtained patents on not so much the machines but the resulting products on machinery that we designed ourselves.

Q Have you ever designed any machinery for the cutting of nylon fabric?

A Yes, we have.

Q At the time you designed a machine, to your knowledge was there any machine in operation for use in cutting nylon fabric?

A No, sir. We feel that we were the pioneers. I particularly designed the first usable fusing machine, as we call it, to slit and heat seal nylon tape.

Q Have you on occasion been consulted as an expert on the cutting and processing of material into ribbons?

A Yes, I have been consulted by some of the largest corporations who avail themselves of our service, yes.

Q Would you identify some of the corporations by whom you have been consulted?

THE COURT: I think you have enough background. I have no doubt but that the witness knows his business and I don't suppose Mr. Hall would contest that.

BY MR. ROBSON:

Q Now did there come a time, Mr. Ploeger, when you

developed a ribbon which consisted of a nylon fabric and a nylon film?

THE COURT: Is film a word of art? The way it is used here it is very misleading. We don't think of a fabric as a film. Ordinarily we think of something that is liquid or semi-liquid, like a film of ice or something of that sort.

MR. ROBSON: What I am trying to distinguish between is this: a nylon --

THE COURT: Layer is the word, isn't it?

MR. ROBSON: Nylon layer would be a good word, yes.

THE COURT: I am not trying to limit your vocabulary but I am trying to straighten out my own. Very well.

MR. ROBSON: One of the reasons I have been using the word film is because it is the word which is used in our patent.

THE COURT: Is it used in your patent?

MR. ROBSON: Yes, it is the word in the claim.

THE COURT: Very well, you may continue using it.

Would you mind reading the question, please?

(The Reporter read the last question.)

THE WITNESS: Yes.

BY MR. ROBSON:

Q Prior to that time did your company, the Filmon

Process Corp., or any of the other companies with which you were affiliated, process or cut or slice fabric which was to be used in printing machines such as typewriters and computers, et cetera?

A Yes, we were engaged in slicing all different types of material.

Q At that time what were the materials normally used, commonly used for this purpose?

A Cotton, silk and nylon to a very, very small degree.

Q Was there a reason why nylon was used to a small degree?

A Yes, the ability for the nylon fabric to retain ink was very minimal.

Q In the course of your operations in the processing of typewriter ribbon did you ever have occasion to consider the problem of protection of type faces?

A By all means.

Q Was that a problem common in the industry which used printing machines?

A Oh, yes, it certainly was.

Q Would you describe what that problem was?

A Well, if we take an example of an Addressograph machine, which utilizes a metal plate, this metal plate

impacts the ribbon and becomes dirty, and it was found that in this particular instance it would be helpful to have a protective coating of some kind on the ribbon to keep the plate clean. The plate actually acts as a type face might.

Q Prior to May of 1959 was there, to your knowledge, any printing ribbon on the market which provided a protection for the type face?

A None to my knowledge. I haven't seen any.

Q Did you perform any experiments in an attempt to develop a printing ribbon which would protect type face?

A Yes, I did.

Q Would you describe briefly but fully the tests or experiments which you performed in an attempt to develop a ribbon which would protect type?

A I employed the available films that were most handy at the time. I believe they were the polyethelene types, which were certainly very easy to come by. There was a mylar which I was able to put my hands on. And I attempted to paste adhesively these films to the complete face of the ribbon.

Q What did your experiments establish were the results of this kind of construction?

A Well, this construction had very serious drawbacks.

Actually, there were two that I can think of right now. One was simply a matter of the ink actually softening the glue that I had used and in so doing we found that the film parted itself from the inked tape.

The second drawback was that the glue or adhesive that I had used had penetrated the fibers of the fabric to such an extent that there was no room left for the ink, so consequently we had an inked ribbon that held very little ink.

Q Did you make any further experiments in an attempt to discover a ribbon which would protect typing keys?

A Well, I figured that what I ought to do is not to paste the film down over the complete face of the ribbon but instead maybe employ the method by which we were cutting our regular nylon ribbons, and the regular nylon ribbons are cut in such a manner as to pass the cloth, the fabric, over heated knives so that a simultaneous action took place whereby we not only cut a strip of ribbon but also achieved a welded edge to the ribbon, because it is very important to have an edge on the ribbon. It is very important.

So that I decided that I ought to take the polyethylene and mylars and try to run the film and the cloth through my existing fusing machine, you see.

Q And did you do that?

A Yes, sir.

Q And what was the result?

A The result was that the weld which I had tried to achieve just didn't exist.

What I am trying to say there is that at the point where the edges are, where the knife would touch both the cloth and the film, I did not get any effective weld whatsoever, the film just parted itself from the fabric tape.

Q Did you attempt to attach the film to the fabric along the edges in any other way prior to that, besides the welding process?

A Well, I did try to melt the film along the border of the ribbon by trying to press it into the cloth. In other words, over the top of the tape, as opposed to on the side. I tried to melt the film into the cloth.

Q And what was the result when you did that?

A Well, the first result was that I experienced a very severe curl, a very, very severe curl. The edges of the ribbon just curled up upon themselves so that the ribbon would not lie flat.

It seems that there was an uneven expansion due to this heat applied to the film and not having the same heat applied to the fabric member and this caused a very severe curl.

Q Did you attempt to apply ink to the fabric portion of the ribbon which you made by attempting to melt the plastic film to the fabric?

A Yes, sir, we did.

Q And what happened when you applied ink to the ribbon?

A The ink just seeped across over to the side that you would normally want to keep free of ink. In other words, there was no effective ink-proof seal by that method. The ink just flowed out and flowed onto the other side.

Q By flowed out do you mean flowed out from the edges?

A Well, it flowed out from the edges and found itself on the side that was supposed to be clean.

Q Did there come a time when you attempted to accomplish the result which you were seeking by the use of nylon film and nylon fabric?

A Yes, there was.

Q Did you ever attempt to melt nylon film into nylon fabric?

A Yes, I did.

Q And what was the result which was achieved when you did that?

A The same thing happened, the same thing happened. We still had the curl, we had a tremendous amount of curl.

again because the heat was applied only to the film itself, melting the film and not affecting the fabric at all. And the same leaking took place, the ribbon just leaked from the ends and went onto the side that was supposed to be clean.

Q Did there come a time when you attempted to effect a bond between the nylon film and the nylon fabric by another method?

A Yes, I did.

Q What was that method?

A That method simply employed the method which we had originally pioneered, the same method that we cut all our nylon ribbons with, namely; the hot knife method which slices --

THE COURT: What is the name of the method?

THE WITNESS: It's the hot knife fusing method, sir. These knives are heated by elements --

THE COURT: I want to get the name.

THE WITNESS: Hot knife fusing method.

BY MR. ROBSON:

Q What is the difference in the type of connection which is obtained when you melt the plastic material into the fabric by applying heat from above and when you use the hot knife method which you have just described?

THE COURT: But you describe it again. I can't think he described it.

Just what is the hot knife method?

THE WITNESS: The hot knife method is simply a matter of taking a tool, a sharpened tool, similar to something that would be shaped in the manner of the blade of a knife, and this knife is electrically heated so as to effect it hot enough to be able to melt a synthetic.

Certainly many synthetics require different heats, but in actuality what you have got to do, you have got to get the knife hot enough --

THE COURT: But what do you do with the knife?

THE WITNESS: There is a simultaneous operation here. It's a cutting and melting operation, you see.

THE COURT: But what did you cut with it?

Bring that out. Most witnesses assume that the Court knows their business.

BY MR. ROBSON:

Q Would you describe briefly the process? Just what was done?

A Certainly. The process of, as we call heat slitting nylon fabric, is a simple one in one respect --

THE COURT: Just what did you do with the knife? How did you apply it?

BY MR. ROBSON:

Q How did you make this ribbon now which had a nylon film attached to a nylon fabric?

A All right. A strip of nylon fabric and a strip of film were laid basically one on top of the other. These were then simultaneously run over a heated knife which cut and welded the ribbon in the place where the knife contacted it and cut through it.

THE COURT: What did it cut?

THE WITNESS: It cut the nylon fabric and the nylon film, sir.

THE COURT: I thought you already had the ribbon and you laid one on top of the other.

I think you better bring that out.

MR. ROBSON: Let me see if we can explain this just a little bit further.

Q Do I understand the fabric which you cut was wider than ribbon width?

A Oh, yes, yes. We are making multiple ribbons here. I'm sorry I didn't make that clear. May I try again?

Q Would you try it again?

A Yes. The operation is such that if you will picture a piece of cloth 15 inches wide, it's a web of cloth rolled

up in the form of what we call a bolt. This bolt of cloth is mounted on a mount. And we have an equally wide roll of nylon plastic film which is located let's say down here. Now two of these layers are made to run down and they finally meet at an anvil. We call it a circular anvil. They both meet; they come together, and where the anvil is located we also have located a multiple section of knives. For example, if we should want to make ten cuts we would have ten knives there.

So that this wide piece of cloth ultimately will be cut into smaller strips.

THE COURT: I think the witness assumes that I know a lot about the background of the ribbon cutting industry.

Where were these two ribbons? I mean the ribbon on the film or these two pieces of cloth. Were they on rollers?

THE WITNESS: They sort of hang like on a roller. In other words, the cloth itself, the wide cloth is wound upon a paper spool. The paper spool supports this wound cloth.

THE COURT: A roller.

THE WITNESS: And then we have a shaft that runs through this paper core and it acts as an axle so that this cloth can spin.

THE COURT: What about the other film, is that on

another roller?

THE WITNESS: That is on another roller, yes, sir.

THE COURT: And you pull each one down by machinery, is that it?

THE WITNESS: That is correct, they are pulled down together. They are pulled together, yes, sir.

THE COURT: One roller is on top of the other?

THE WITNESS: Yes, sir.

THE COURT: And where do they meet?

THE WITNESS: They meet at some place immediately before being contacted by the hot knives, just immediately before they are cut.

THE COURT: Where do they go from there?

THE WITNESS: Then as they are cut, all these cut ribbons are guided up to a take-up spool and all the cut ribbons now wind themselves up on another shaft, you see.

THE COURT: I see. But what is the knife attached to? It isn't suspended in mid-air.

THE WITNESS: Well, the knife is attached to an axle. It is a gang of knives.

THE COURT: It is what?

THE WITNESS: It's a gang of knives. You have many, many knives, one next to the other, and they are all commonly

heated by a heating element.

THE COURT: Are they suspended somewhere or are they on a table or how?

THE WITNESS: No, sir, they are suspended under the machine and they are so placed that they impact the anvil cylinder, as I pointed out before --

THE COURT: What machine are you referring to?

THE WITNESS: I am referring to the machine that cuts this nylon tape.

THE COURT: You mean there are two rollers suspended--

THE WITNESS: These are feed rollers. The rollers that we spoke of before are feed rollers. They are the raw material, so to speak, before the operation takes place.

THE COURT: There are two rollers, one contains the fabric and the other contains the film?

THE WITNESS: Yes, sir.

THE COURT: And each of the two materials is pulled down from the rollers?

THE WITNESS: Yes, sir.

THE COURT: And they meet and are fed into a machine?

THE WITNESS: Yes, sir.

THE COURT: And the knives are attached to the machine?

THE WITNESS: Yes, sir.

THE COURT: And the hot knife cuts them longitudinally? Is it longitudinally?

THE WITNESS: Yes, sir, they do.

THE COURT: And the product is rolled up on another roller on the other side of the machine?

THE WITNESS: Well, it is part of the machine itself.

THE COURT: Well, on the other side of the knives?

THE WITNESS: Oh, yes, by all means.

THE COURT: Very well. Now we get it in words of one syllable.

BY MR. ROBSON:

Q When the ribbon comes out at the other end of the machine it has now this welded edge between the fabric and the film, is that correct?

A Yes, that is correct.

THE COURT: This hot knife causes a welding process?

THE WITNESS: Yes, sir, it simultaneously cuts it to width and also welds the edges to make them fast.

Q What is the difference between a melting process and a welding process?

A A melting process deals with rendering one member soft by means of heat.

A welding process, simply stated, means that you

have got two members which are both rendered soft and run together and combine into one unit.

Q When you completed the construction of this ribbon now which had a welded edge and was made of a nylon film and a nylon fabric, what were the results you discovered with respect to curling and leakage?

A I experienced no curling. The ribbon laid beautifully flat as one would expect any ordinary nylon to lie. And there was absolutely no leakage.

Q Did you discover, in addition to the fact that you now had a ribbon which did not leak and which did not curl and which provided a backing for protection of the ribbon, any other results?

A Yes, I experienced some very amazing results.

Q Would you describe those?

A Well, to my great surprise, we evidently achieved something that was really sought after for many, many years. Briefly, what we had achieved was to take nylon fabric, which up to that point had always been considered a very poor absorbing type of material, and we had increased its ability -- in other words, the fabric's ability, by adding this film of ours to the nylon fabric we had actually taken the worst absorbent cloth, namely, nylon as compared to cotton and silk,

and we had made it the best cloth. We had made it the best cloth absorbency-wise.

Q Do you recall any other results which you observed?

A Well, of course we experienced the fact that this nylon film was able to very, very handily take care of the tremendous impact on a lot of equipment.

Q Do you recall any results that dealt with the capacity of the ribbon, the ink capacity?

A Oh, yes. We found that this ribbon also had a fantastic ability to hold more ink than a nylon ribbon had ever held before, and this is very interesting because nylon ribbons if they are over-inked -- when I say nylon ribbons I mean ordinary nylon ribbons must never be over-inked because if they over-ink a nylon ribbon they get a condition which we call in the trade puddling or sweating out. Simply stated, what this means is for some strange unknown reason nylon in itself is not capable of keeping the ink spread out, so to speak, and the ink has a tendency to want to puddle in one certain area. Now if a ribbon is over-inked, if an ordinary nylon ribbon is over-inked and if you were to put such a ribbon on your typewriter, you would experience a condition whereby you would be writing lightly and your next impression might be so splattered that you couldn't even read

is, you see.

So that we found and discovered that we not only could increase the ink capacity of a given piece of nylon fabric but we did not experience this splatter. Our ribbon wrote dark and sharp.

Q With respect to the increased absorption rate, what was the significance or value of that fact?

A Well, of course it is recognized in the ribbon business that you have just so many impressions in a ribbon. What I mean to say is this: there is just so much ink in any one given ribbon, which means that you are able to expect a certain amount of impressions, certain characters written from this ribbon.

Now when an impression is made, two things happen to a ribbon. The type key, first of all, actually removes some ink from the ribbon and puts it onto the paper. So you have an ink loss in that particular area in that instance. Also, you experience a case where the ink is actually pushed to the side and again that tends to reduce the ink content of that area.

Now it is very important to have a piece of fabric designed which will be able to rapidly recuperate in that the ink must be replaced, must be replenished in the area

where you remove the ink, you see, because if you didn't have this what we call recuperative factor you wouldn't have a typewriter ribbon, you would have a hair ribbon.

Q Is there a test which has been devised in the industry which you are connected with for determining the absorption rate of various fabrics?

A Yes, sir, there certainly is.

Q What is that test?

A Well, simply stated, it's a test whereby a test solution is employed and the ribbon is hung onto a test stand. In other words, the ribbon is hung onto a test stand which we call a rack.

If I may, I would like to demonstrate it. I brought a little -- it would take just a moment of the Court's time.

THE COURT: Just a moment. Let counsel proceed in his own way. Counsel knows best.

THE WITNESS: It is very hard to describe.

THE COURT: Just a moment. Counsel knows best.

You just answer questions.

You may proceed.

BY MR. ROBSON:

Q Let me show you, Mr. Ploeger, a stand and a jar

and ask you whether this is the testing device to which you are referring?

A Yes, sir, it is.

MR. ROBSON: With Your Honor's permission, I would like to have the witness identify the components of this.

THE COURT: I don't think you have to have formal identification. He can describe it.

MR. ROBSON: That is what I mean.

THE COURT: Very well.

MR. ROBSON: I would like to perform this experiment, which would take about 30 seconds.

MR. HALL: Your Honor, this exhibit was not marked as an exhibit at pretrial. They are bringing it in on --

THE COURT: I think this is only for purposes of illustration, Mr. Hall.

MR. HALL: All right.

BY MR. ROBSON:

Q Now, Mr. Ploeger, would you describe briefly what you have before you?

A Yes. What I have got here is a rack which contains five representative strips of tape used in the printing ribbon industry. Two of these tapes are tapes of our invention. One tape is a nylon tape which is identical in regards

to its fabric structure but without our invention. In other words, what I am saying is we have a piece of nylon tape and we have a piece of the identical nylon fabric with our invention included. We also have a strip of silk tape and we have a strip of cotton tape.

Q I notice you have a large glass jar. Would you describe what you are going to do and then do it?

A Yes, sir. I am going to put this test medium in this beaker. The test medium is oleic acid and it is colored with a methyl violet coloring base.

It is a standard procedure in many of the large inking corporations to establish exactly what we are trying to show here.

Q What does this test establish? What is it designed to establish?

A This test is designed to establish at what rate a given piece of tape will absorb this particular fluid in a specific length of time.

There are certain requirements of a piece of tape before it is even purchased by the ultimate user, namely, the large inker. He will not purchase any raw material unless it more or less passes the minimum requirements of this test.

MR. HALL: Your Honor, may I make an objection on the ground that he is not qualified to do this because during his deposition he specifically disclaimed any knowledge of inking. May I confront him with his deposition?

THE COURT: Well, that goes to the probative value of the testimony. I will overrule the objection.

BY MR. ROBSON:

Q Do I understand correctly, just to simplify it, that this test works by your placing these various fabrics in a solution of this liquid and then determining how rapidly the liquid rises up into the fabric?

A That is correct.

Q Would you now proceed?

A Yes. I tried to pour this liquid into this beaker at roughly the level at which these ribbons will start.

Q May I ask one more question. I take it that the material which allows the liquid to rise most rapidly is the one with the greatest absorbent capacity?

A Without a doubt.

I am a little nervous; I hope I don't spill it.

All right, we have got them in without a mishap.

As I am watching this test now --

Q Perhaps we can put that up on the edge of the bench.

A May I, sir?

THE COURT: No.

MR. ROBSON: Can Your Honor see it from there?

THE COURT: You just proceed.

MR. ROBSON: With Your Honor's permission we would like to leave that for a few moments and allow the --

THE COURT: Yes. Well, suppose we take our usual mid-afternoon recess and let this operate in the meantime.

MR. ROBSON: Fine.

(Recess.)

THE COURT: You may proceed.

MR. ROBSON: If Your Honor please, I would appreciate it if we could have the record indicate now what the results were of the test during the approximately --

THE COURT: Proceed in your own way.

BY MR. ROBSON:

Q Mr. Ploeger, would you identify now the various tapes, and I will give you a ruler, will you indicate the height on each one of the tapes to which the ink or liquid has risen?

A As long as the samples are in the glass I can just approximate it.

Q As best you can.

A May I leave the chair just one moment?

Q Surely.

A Let's consider the silk first. The silk has risen approximately one inch over and above the level of the solution. That is the silk.

We are dealing now with the cotton and that is about an inch and an eighth, roughly an inch and an eighth over the surface of the liquid.

Now we have the nylon, which is about $7/8$ ths of an inch over the level of the solution.

Q This is the nylon fabric with nothing attached to it?

A That is correct.

Now we will take the sample which includes the same nylon fabric but with a ribbon of our invention, namely, film added to that fabric. It's approximately three and a half inches above the level of the solution. Let me just double check that. Yes, three and a half inches above the level of the solution on a ribbon of our invention, the nylon ribbon of our invention.

Now we have one other sample here which is also a ribbon of our invention which is similar to the ribbon that was sent to Spellright. It is a different type of nylon but

it does have film, and that has risen three inches above the level of the solution.

THE COURT: What was the nylon without the film?

THE WITNESS: Only 7/8ths of an inch.

THE COURT: And about three inches if the film was added, is that it?

MR. ROBSON: Yes, sir.

THE WITNESS: And three and a half for the one with the film on it.

THE COURT: I don't want the exact but just a general idea.

THE WITNESS: I would like to just qualify the significance, if I may, so that it makes any sense.

BY MR. ROBSON:

Q Let me ask you this: What are the standards which are required in the printing ribbon industry of absorption rate?

A Well, this test basically requires that a four-hour period take place so that the fabric rises between two and a half inches and three inches. In other words, a cloth should rise two and a half to three inches in four hours.

Q And this ribbon rose three inches in 15 minutes approximately, is that correct?

A Well, I would say approximately, yes.

THE COURT: When you refer to the printing industry, that does not include the typewriter ribbon, does it?

THE WITNESS: Yes, sir, it does.

BY MR. ROBSON:

Q Did there come a time when you filed an application for a patent for a product which embodied the construction you have described?

THE COURT: The file wrapper speaks for itself. I like to avoid technical proof.

MR. ROBSON: I would like to offer in evidence, then, the certified copy of the patent which was issued.

THE COURT: Let it be admitted.

MR. HALL: No objection.

(Certified copy of Patent No.

3,010,559 marked Plaintiff's Exh.

No. 2 and received in evidence.)

THE COURT: You have already offered the file wrapper.

MR. ROBSON: Yes, sir.

Q Mr. Ploeger, I ask you to look at the patent which has been marked Exhibit 2 and specifically to claim 1 and I ask you if you would read claim 1.

THE COURT: No, I can read it.

MR. ROBSON: Not in the record, just to himself.

THE COURT: To himself, yes.

Well, proceed with the next question. I assume he knows what is in it.

BY MR. ROBSON:

Q I call your attention to the fact that in claim 1 reference is made to the fusing together of a nylon film and a nylon fabric, and I ask you in what way there is a difference between fusing together the nylon fabric and the nylon film and welding it and melting it?

A They are exactly the same.

Q I'm sorry, I may have confused you. Which is exactly the same?

A The fusing or welding is the same procedure. It is a matter of choice of words.

MR. ROBSON: With Your Honor's permission I would like to put up on the board a blow-up of the picture of the patent.

THE COURT: Yes, that will be very helpful, I am sure.

Q Can you see that?

A Yes.

THE COURT: That is an enlargement of one of the figures in the patent?

MR. ROBSON: The figure in the patent.

THE COURT: Which one? Is that figure 4?

MR. ROBSON: Yes, that is figure 4.

The only difference between this and figure 4 is there is a break mark indicated there --

THE COURT: There is what indicated?

MR. ROBSON: There is a break mark indicated because we couldn't show it as long as it would be on the blow-up.

THE COURT: What is that above the ribbon of figure 4? What does that indicate?

MR. ROBSON: Which are you looking at, Your Honor?

THE COURT: What are those cross-hatches above the ribbon?

MR. ROBSON: This cross-hatching?

THE COURT: Yes, this field.

MR. ROBSON: This is, I think they call that the fill and this the warp. This is the fabric up here. That is the thread going in one direction and this is the thread in the other.

THE COURT: What does the bottom figure indicate?

Is that the nylon fabric?

MR. ROBSON: That is the nylon film.

THE COURT: And is the nylon fabric shown on this drawing?

MR. ROBSON: Yes, the nylon fabric is this portion here. These two together constitute the nylon fabric.

THE COURT: You mean this broad field is the nylon fabric?

I think you better hand me that. Have you got a small copy of that drawing, of what you put on the blackboard?

MR. ROBSON: Well, the patent is exactly the same thing, the drawing on the patent.

THE COURT: I still don't understand what that stuff is above the matter that is shown in figure 4 in the patent.

MR. ROBSON: The matter above the nylon film?

THE COURT: Hand me that drawing.

(The drawing was handed to the Court.)

THE COURT: Mr. Robson, what is all this?

MR. ROBSON: That is the fabric, Your Honor.

THE COURT: This is the fabric?

MR. ROBSON: Yes.

THE COURT: And this is the film?

MR. ROBSON: Yes.

THE COURT: What are these circles?

MR. ROBSON: The circles are the threads going in the longitudinal direction, they are the threads, the warp of this fabric.

This fabric is woven like cotton would be, except they use nylon thread instead of --

THE COURT: The fabric is just a layer of cloth, isn't it, a piece of cloth?

MR. ROBSON: Yes, but the cloth is made up of threads of nylon, some of which constitute the warp and some the fill.

THE COURT: It is too wide, that is the whole trouble with it. That is why it is meaningless to a layman.

MR. ROBSON: It is an exaggerated cross-section, obviously.

THE COURT: I always think of a cloth as a thin layer.

MR. ROBSON: This is just one thread going a long way.

THE COURT: This is probably under a microscope, multiplied a hundred fold.

MR. ROBSON: Probably. What you see there is what it would look like if you sliced it on the front leading edge

and then looked at it under a microscope.

THE COURT: I am afraid I am too obtuse. I still don't understand what the circles are.

MR. ROBSON: They are the cross-section of the thread which runs along that tape longitudinally.

THE COURT: Then what is the rest of it?

MR. ROBSON: In other words, you have got the thread which is running right at Your Honor and the rest are the fill which is woven over the thread.

THE COURT: I see. I thought I had a good imagination but it didn't go that far.

MR. ROBSON: You haven't had as much time as I have had to try to understand that.

THE COURT: Very well. There is no use putting up illustrations unless you can get the Court to understand them. Now I understand it.

BY MR. ROBSON:

Q After you filed -- withdraw that. Prior to your filing the application for a patent on this product did you make any attempt to explore the possibility of marketing it commercially?

A Would you repeat that question, please? I don't quite understand that.

THE COURT: Let the question be read.

(The Reporter read the last question.)

A Yes.

Q Would you describe what you did?

A Well, I gave an un-inked sample of the ribbon, namely, a nylon ribbon with a nylon film, to an inker for his evaluation.

Q What was --

THE COURT: You gave a sample to whom?

THE WITNESS: To an inker, sir, a person who would normally put ink into the tape. When I say inker I mean a company that is concerned with putting ink into un-inked fabric and then cutting the larger spools into smaller spools and marketing them as usable ribbons.

BY MR. ROBSON:

Q What was the identity of that inker?

A That inker was, I believe it was Eaton Allen. I believe it was Eaton Allen.

Q Is that Eaton Allen Corp.?

A I believe it is, yes.

Q And did they give you any indication of the marketability of this?

A Yes --

MR. HALL: This sounds like hearsay to me.

THE COURT: Objection sustained.

BY MR. ROBSON:

Q What other steps did you take prior to filing the patent application?

A Well, as I indicated before, I had some of this material inked and it was returned to me and I was able to evaluate its potentials --

THE COURT: Just a moment. I don't think you are answering the question at all. You have gone beyond the confines of the question.

Would you mind reading the question?

(The Reporter read the last question.)

THE COURT: Don't repeat what you have already told us. You started to repeat what you already told us.

THE WITNESS: Well, I did offer the ribbon to Eaton Allen Corp. for their evaluation. I don't recall any other at this particular time. I gave the Eaton Allen Corp. un-inked fabric for their evaluation, and at this time I don't recall any others.

Q Did you perform any tests to determine the feasibility of using this ribbon for printing machines?

A Oh, yes, I did.

Q What tests did you perform?

A Well, I took some inked material which the inkers had kindly enough inked for me. I placed it into our typewriters. I wanted to see just how the film would react in the typewriter.

And I also performed what we call a wear-down test on a little gadget which had been in our possession for many, many years.

Q Did you have any test performed by any outside sources?

A Yes, later on, I believe we did.

Q Was that after you filed the patent, the patent application?

A Possibly. I am not sure at this time. I know more sophisticated tests were made, yes.

Q What sort of tests were made?

A The ribbon was given a test whereby it was placed on an automatic electric typewriter which subjected the ribbon to, I believe, six or seven hours of continuous usage.

Q And by whom was that test performed?

A That test was performed by Standard Products Corp.

Q Did you receive the results of that test?

A Yes, I did.

Q I show you what has been marked Plaintiff's Exhibit 3 for identification and ask you whether this is the copy of the run-down test which you received?

A Yes, it is.

MR. ROBSON: I offer that in evidence.

MR. HALL: I object, Your Honor. It is hearsay.

THE COURT: Have you shown it to Mr. Hall?

MR. ROBSON: Not yet, sir.

MR. HALL: This is a test somebody else ran, Your Honor.

THE COURT: I know, but this is a patent suit and a non-jury trial. If this was a trial with a jury I would exclude it.

I think I will admit it. You know, the rules of evidence are not so stringent in non-jury trials, especially in patent cases.

What do you claim it shows?

Q Would you tell us what that --

THE COURT: Suppose you tell us what you are offering it for and what you claim it shows.

MR. ROBSON: I am offering it for the purpose of establishing that after six or seven hours of continuous typing there was virtually no reduction in the clarity,

legibility of the imprint...

THE COURT: Very well.

(Test samples conducted on automatic electric typewriter marked Plaintiff's Exhibit 3 and received in evidence.)

MR. ROBSON: With Your Honor's permission, at this point I would also like to offer in evidence the assignment of the patent from the original patentee to the plaintiff in this action, as Exhibit 4.

THE COURT: Let it be admitted.

(Assignment of patent to plaintiff
Marked Plaintiff's Exhibit No. 4
and received in evidence.)

THE COURT: Have you shown all these exhibits to Mr. Hall?

MR. ROBSON: Mr. Hall has seen this one.

THE COURT: I think I am going to ask you, after we adjourn court for the day, will you be good enough to show Mr. Hall all the exhibits you intend to offer tomorrow, because that will expedite things.

MR. ROBSON: I certainly will, Your Honor.

THE COURT: You may proceed.

BY MR. ROBSON:

Q Mr. Ploeger, I show you a piece of ribbon and ask you whether that is a sample of the ribbon which is the subject of that patent?

A Yes, it is.

MR. ROBSON: May I offer that in evidence, if Your Honor please.

THE COURT: Let it be admitted. Show it to Mr. Hall.

MR. ROBSON: I just did, Your Honor.

THE COURT: Is that the same as the sample you informally showed the Court?

MR. ROBSON: Yes, sir; just thinner, but the same thing.

THE COURT: Thinner and narrower also.

MR. ROBSON: Just narrower. I used the wrong term.

(Sample ribbon marked Plaintiff's Exhibit No. 5 and received in evidence.)

Q Mr. Ploeger, are you acquainted with William Wolowitz, one of the defendants in this action?

A Yes, sir, he is the president of Spellright, I believe.

Q When did you first meet Mr. Wolowitz?

A In September, I believe, of 1961.

Q Would you describe the circumstances under which you met Mr. Wolowitz?

A Mr. Wolowitz appeared at our office at that date, September '61, I believe, and he appeared unannounced. He carried with him a typewriter. He proceeded to put the typewriter on the table and demonstrate a ribbon which he indicated he had invented.

The ribbon, pure and simple, was a two-member ribbon which included an inked member a quarter of an inch wide, and a correction member roughly a quarter of an inch wide, both members joined together with a piece of Scotch tape.

Q Did the Scotch tape extend across the back of the printing portion of the ribbon?

THE COURT: Just a moment. I want to get this exact and I am going to have the Reporter read the previous answer.

(The Reporter read the last answer.)

BY MR. ROBSON:

Q Was the Scotch tape attached to the printing portion of this ribbon or the inked portion as well as the correction portion?

A Yes, it was.

Q Was it attached to the entire surface of the printing portion?

A I believe it was. It went all the way across, yes.

Q It went all the way across the inked and the correction portion?

A Yes, sir.

Q Would you tell us what Mr. Wolowitz said to you on that occasion and what you said to him?

A Mr. Wolowitz came to us because he had heard that we had invented a film-back ribbon. His own embodiment, which we just described, had very serious drawbacks. There were actually two. The first one dealt with the fact that the ink in the inked portion had a tendency to melt or soften the adhesive on the Scotch tape, which resulted in the ribbon falling apart. The second part of the problem was the fact that the impact face of that ribbon, which would have been in this case the Scotch tape, was very thick and rigid. In other words, what I am saying is, for printing purposes the Scotch tape would have been contacted by the type faces and this was wholly inadequate because Scotch tape is very rigid, it is not pliable, and it is very thick; so that the ultimate print work that you could ever hope to achieve from that ribbon would be very poor, it would probably not even be acceptable as a

printing ribbon.

Q Do I understand correctly that the Scotch tape on the printing portion of that ribbon was in the same relation to the ribbon itself as the film shown on this diagram?

A Everything would be the same except the fact that the Scotch tape actually held itself fast to the surface of the cloth; but everything else would be the same, yes.

Q The Scotch tape, then, was connected across the entire surface of the cloth?

A That is correct.

Q There was no space between the ribbon and the Scotch tape?

A There was no space, no. The adhesive in the Scotch tape had already pulled the fabric to itself.

THE COURT: I want to make sure I understand this correctly. Was the Scotch tape in the same position as the nylon film in your ribbon?

THE WITNESS: Yes, sir.

BY MR. ROBSON:

Q Have you told us as much as you can recall of that conversation?

A Well, Mr. Wolowitz asked us if we wouldn't cut some material for him. He felt that the film backing on our ribbon

would answer the drawbacks that I had just mentioned, namely, that he could now take his Scotch tape binder and merely hold the two members together along the very, very narrow border along the film surface of our ribbon, he no longer had to cover his ribbon with Scotch tape. He now could have a correction ribbon or a printing ribbon which would use our film backing as the impact surface, so that he then would get clean print work, and certainly the Scotch tape could not come off because the Scotch tape was now fastened to our film and it never came in contact with the ink.

THE COURT: Let me see if I understand this. Do you mean the new ribbon was to have three layers, the inked member, the correction member and your film?

THE WITNESS: Yes, sir.

MR. ROBSON: With Your Honor's permission I would like to place another chart on the blackboard which shows this particular embodiment that we are coming to now.

THE COURT: Surely.

BY MR. ROBSON:

Q Now did you at Mr. Wolowitz' request prepare a sample of a ribbon which consisted of your printing ribbon, his correction ribbon and a piece of Scotch tape holding them together?

A Did I? Did you say did I prepare such a sample?

Q I did say did you prepare such a sample.

A No, I did not prepare a complete sample, no.

Q What did you do?

A I prepared a sample of a nylon tape and a nylon film as per our invention, so that he could himself fabricate these two together.

THE COURT: In other words, you used your nylon film and not Scotch tape, is that it?

THE WITNESS: No, sir, we had nothing to do with Scotch tape. The Scotch tape was Mr. Wolowitz' fabrication.

MR. ROBSON: May we mark this?

(Ribbon marked Plaintiff's Exhibit
No. 6 for identification.)

MR. ROBSON: Would Your Honor bear with me for just one second?

THE COURT: Surely. Take whatever time you need. There is no necessity for haste.

MR. HALL: While we are having this interruption I would like to ask you a question. I mentioned Mr. Kaufman as being one of our witnesses. He cannot be here on the 4th and the 5th is a Jewish holiday and the 6th. He is a very busy man and I was wondering if we could agree that he could

take the stand just after the opening of tomorrow's session.

THE COURT: Yes, indeed. There is no reason why we couldn't make that adjustment.

You have no objection to that?

MR. ROBSON: No, sir.

MR. HALL: Tomorrow just at the beginning of the afternoon session, would that be all right, at 1:45?

THE COURT: Yes, indeed. How long will his testimony take?

MR. HALL: Oh, 15 minutes.

THE COURT: We will take him at the beginning of the afternoon session, interject him if we are doing something else.

BY MR. ROBSON:

Q Mr. Ploeger, I show you what has been marked Plaintiff's Exhibit 6 for identification and I ask you whether that is the ribbon which was eventually produced by the Spell-right Corp. consisting of a combination of the Filmon patent ribbon, the correction material, bound together by Scotch tape?

A In order to answer that question correctly I wonder if I might just have a small strip which I can pull apart?

THE COURT: Surely.

(Pause.)

THE WITNESS: Yes, this is a ribbon that was the early conception of Scotch tape and our --

THE COURT: That was the defendant's ribbon?

THE WITNESS: Excuse me, sir? I didn't hear you.

THE COURT: Would you identify this again? Is this the defendant's ribbon, Mr. Robson?

BY MR. ROBSON:

Q This was the ribbon produced by Spellright, is that correct, the defendant?

A That is correct, produced by Spellright --

THE COURT: What are the members of which it consists?

MR. ROBSON: It consists of a nylon fabric and nylon film produced by the plaintiff, a correction portion produced somewhere else, and the two of them held together by a piece of Scotch tape.

THE COURT: I thought that the film performed the function of holding them altogether, doesn't it?

MR. ROBSON: No, sir, and we will use this diagram in just a second to show that.

THE COURT: Very well. In other words, there were four members instead of three?

MR. ROBSON: At this point there are now four members, yes.

THE WITNESS: I can answer this question possibly a little clearer.

I did pull this ribbon apart, which enabled me to show that it pulled apart into two separate entities plus Scotch tape. One entity, the inked tape, is the tape of our invention --

THE COURT: I think you better wait until a question is asked, Mr. Ploeger.

Now as I understand it, there were four members of this ribbon, the inked member, the correction member, the nylon film?

MR. ROBSON: Yes.

THE COURT: And Scotch tape?

MR. ROBSON: Correct.

THE COURT: Very well. Now you may proceed.

BY MR. ROBSON:

Q I call your attention now, Mr. Ploeger, to the chart which is on the board and I call your attention to the portion on the left side which is labeled nylon fabric and I ask you whether that portion is the nylon fabric which was part of the invention covered by the patent?

A Yes, sir.

MR. HALL: Well, now, wait a minute. When he says

it is part of the invention covered by the patent, that is a conclusion. We don't think he can give conclusions like that.

THE COURT: What is your point, Mr. Hall?

MR. HALL: Well, maybe it's not much of a point, but he says it is the film covered by his invention. We don't agree to that.

THE COURT: Well, of course you don't, but as I say, there is no jury here. There is no concession there.

MR. HALL: I might say further that I haven't objected to any of this, although --

THE COURT: Oh, no.

MR. HALL: But all this talk is about a ribbon they don't even charge to infringe.

THE COURT: I understand. You know, I think a plaintiff ought to be allowed to make his own presentation in his own way, and in non-jury trials we don't pay too much attention to strict rules of evidence. After all, the history of the law of evidence shows it was developed for jury trials.

You know, Mr. Hall, the old-time patent lawyers were afraid that when the new Federal rules came in, that the law of evidence would be imparted into patent cases and that is why there is a provision that whatever evidence was admissible under the old equity procedure should continue to

be admissible. That was put in at the behest of the patent bar because they did not want to have strict rules of evidence introduced to which they had not been used.

MR. ROBSON: I wonder, Your Honor, if I could make one thing clear in view of a statement that Mr. Hall has just made and which he has made on many occasions during these proceedings. He says --

THE COURT: This is all for purposes of illustration, very largely.

MR. ROBSON: No; but more than that, he says this is a ribbon --

THE COURT: Suppose you ask the next question.

BY MR. ROBSON:

Q The embodiment of construction on the left, the nylon fabric with the nylon film under it, is the same as the construction or is intended to be the same as the construction in the chart representing the patented article, is that correct?

A Yes, sir.

Q Now on the right are two items labeled camouflage and carrier sheet. Do those refer to the camouflage or correction material, those two together, which Mr. Wolowitz used or the Spellright Corp. used for correction purposes?

A That is correct.

Q And the Scotch tape identified here is the Scotch tape which was used to hold these two members together, is that correct?

A That is correct.

Q Now I note that the Scotch tape does not run the full length of the nylon film and nylon fabric or full width.

A That is right.

Q Is that correct?

A That is correct.

THE COURT: It doesn't run the full width or the full length?

MR. ROBSON: The full width is what it should be.

BY MR. ROBSON:

Q Is that correct?

A That is correct.

Q Do I understand from that, then, that the type key would not come in contact with the Scotch tape?

A Absolutely not.

Q It would only come in contact with the nylon --

THE COURT: I think we will recess at this time until tomorrow morning.

(At 3:55 p.m. trial stood in recess, to reconvene 10:00 a.m., October 3, 1967.)

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,

Plaintiff,

v.

SPELLRIGHT CORP.,
WILLIAM H. WOLOWITZ,

Defendants.

Civil Action 1514-63

Washington, D. C.

October 3, 1967.

The above cause came on for further trial before
THE HONORABLE ALEXANDER HOLTZOFF, United States District
Judge, at 10:00 a.m.

Appearances:

For the Plaintiff:

MORTON S. ROBSON, ESQ.,
EDWARD C. GONDA, ESQ.,
IRVIN A. LAVINE, ESQ.

For the Defendants:

WILLIAM D. HALL, ESQ.

- - -

I N D E X

WITNESSES

DIRECT CROSS REDIRECT RECROSS

Ploeger, Walter Jr. (Resumed)	170	277
Kaufman, Henry J. (244-261)	244	254

EXHIBITS

FOR IDENTIF. IN EVIDENCE

Plaintiff's:

7 - Spellright box & ribbon	185	185
7A- Leaflet	185	185
7B- Ribbon from Plaintiff's Exh. 7	189	189
8 - Film-On label	190	192
9 - Remington Rand box & ribbon	204	204
10- Spellright box	224	226
11- Ribbon	224	226
12- Patent 3,274,039	238	239
13- Patent 3,156,338	241	241
14- Patent 3,086,901	242	242
16- List of department stores	272	
17- Ribbon	273	

Defendants:

1 - Kaufman invoice to Spellright 31 Mar 62	250	262
2 - Kaufman invoice to Spellright 30 Sept 61	251	262
3 - Publicity release	252	254
4 - Pg 70, International Management Magazine, 1962	252	254
5 - Ribbon	311	
6 - Ribbon	312	

P R O C E E D I N G S

THE COURT: Before we resume, the Court has been informed that an inquiry has been made what would be the attitude of the Court if the trial of this case should interfere with religious holidays which come later this week. Naturally, it would be unthinkable for the Court to interfere with anybody's religious observance. I hope, however, that we will finish this case before then.

The holidays start tomorrow evening, do they not?

MR. ROBSON: Yes, sir.

THE COURT: I hope we will finish the case before then. However, if we don't, naturally, I would not interfere with anybody's religious observance. I can always find some other case and we can recess this case for the day or the two days or whatever any counsel or witness observes. But I do hope we can finish this case by tomorrow noon.

MR. ROBSON: I hope so too, because it would mean I would have to come back to Washington again if we don't finish, and I would like to finish it while I am here, as much as I like Washington.

THE COURT: Did you wish to address the Court?

MR. ROBSON: No, I am prepared to proceed.

THE COURT: Before we proceed, the Court inquired

of you yesterday what your attitude was as to the third count. Perhaps that might be a good matter to clear up at this time.

MR. ROBSON: That was the first matter I was going to take up. We will withdraw our claim for an injunction on the third count and limit our claim on that count to damages, and for that purpose I believe that it would be necessary for me to apply to the Court for leave to amend the pretrial order to include a damage claim with respect to the third count. I believe the order inadvertently omits to indicate that damages are sought on that count.

THE COURT: What do you say about that, Mr. Hall?

MR. HALL: I object violently because we had that up before Miss Bunten and I questioned her and told her that if there were any damages on that third cause of action I wanted to know what they were, and she questioned Mr. Gonda and he said, We are not claiming any. And I said, Let's put it down. And so she put this little thing in parenthesis that plaintiff is claiming no special damage.

Then the case got up to the Court of Appeals and Judge Sirica had said in his opposition that they weren't claiming damages on this because that was what had come at the pretrial. And then Judge Leventhal questioned Mr. Gonda at great length. It was just like a judge would question

somebody at a pretrial hearing. It was the first time I have ever heard of a Court of Appeals judge you might say acting as a pretrial judge, and it wound up that Mr. Gonda told the judge he wasn't claiming any damages. And Judge Leventhal then said, and I quote, "Petitioner admits it cannot establish that any pecuniary damages resulted from the alleged wrong."

THE COURT: Of course, I don't consider that binding, but what I do consider binding is the pretrial order.

MR. HALL: Your Honor, far be it from me to suggest to you something about civil procedure because 90 per cent of all I know about it I learned from you directly or indirectly, but I would like to throw this out to you --

THE COURT: I will be very glad to get your viewpoint.

MR. HALL: It is my understanding if a judge, where there is no court reporter to take something down, if a judge enters an order or a paper and says a party has admitted this, that or the other thing, it will be assumed that he did make that admission.

THE COURT: There is no question about the fact that Judge Leventhal says that that admission was made during the argument in the Court of Appeals, but I am more impressed

by the pretrial order because the pretrial order supersedes the pleadings; that is more than an admission.

MR. HALL: And it is my recollection that Judge Sirica said to the Court of Appeals that it was his understanding they weren't claiming any damages, and they didn't call him on that and say that he was wrong; and then the Court of Appeals said it.

THE COURT: I am turning back to page 5 of the pretrial order. Paragraph 2 states: "Plaintiff claims an accounting for profits received by defendants for sale of infringing ribbons and consequent damages to plaintiff." That, of course, is the damages for infringement. Then in parenthesis there is the statement, "Plaintiff claims no other special damages."

A pretrial order is more than just a scrap of paper. A pretrial order is intended to act as a chart for the trial and to narrow the issues at the trial and it cannot be treated cavalierly. Two or three years ago the Court of Appeals took the same position, that pretrial binds the parties.

Now, of course, to prevent manifest injustice the Court may grant leave to amend the pretrial order, but there should be a showing as to why.

It looks to the Court as though there is just a

change of position. There was no inadvertence or mistake or anything of that sort.

Certainly, I presume, the defendant is taken by surprise and even if an amendment were allowed it would be necessary to continue the case to give the defendant an opportunity to check the claim and possibly secure evidence to rebut it.

MR. ROBSON: May I say a few words on that, Your Honor?

THE COURT: Yes, yes.

MR. ROBSON: If I understand the law correctly, and I think there is a certain amount of misunderstanding in the opinion of the various courts and in the statements of Mr. Hall, which is the result of confusion between the terms special damages and damages, we do not claim special damages by virtue of the use of the trade secret, nor do we claim, I don't believe, any special damages with respect to the patent infringement.

This is not to say, however, that we are not entitled to the profits made in the case of the patent infringement by the defendant by the use of our patent, and similarly we would be entitled to any profits if there was in fact an improper use of our --

THE COURT: You see, in the pretrial order you ask an accounting for profits received by defendants from sale of the infringing ribbons and consequent damages. Obviously, there can be no infringing ribbons until after the patent issued.

MR. ROBSON: I concede that the pretrial order does not anywhere refer to special or general damages arising out of the use of, the improper use alleged, of the trade secrets, and I honestly can't tell Your Honor how it was that counsel who was present --

THE COURT: Perhaps you did not personally participate in the earlier proceedings.

MR. ROBSON: I was retained as counsel but I was not present, so I don't know what was in counsel's mind and how it was that matter slipped out. I know counsel did stipulate --

THE COURT: It must have been a solemn admission in the oral argument in the Court of Appeals because Judge Leventhal said so in his opinion.

MR. ROBSON: What counsel advised me just now was what he admitted to was that no special damages were being claimed; and apparently there has been some confusion by the loose use of that word.

THE COURT: I think defendant's counsel had a right to assume that there was no claim for damages on the third cause of action because apparently both Judge Sirica and Judge Leventhal so understood and there is no reference to any such claim in the pretrial order.

I am going to deny the motion for leave to amend the pretrial order.

I would consider a modified application. I am not saying I would grant it but I would hear it, if it was coupled with a request for a continuance so that the other side would have an opportunity to check the claim.

In view of the opposition I wouldn't permit the pretrial order to be amended in this very drastic way.

MR. ROBSON: There would be absolutely no additional proof offered in this area than was intended otherwise.

THE COURT: There would have to be proof of damages.

MR. ROBSON: That would be identical with the patent infringement cause --

THE COURT: I understand, but you would have to prove the number of articles that were manufactured prior to the issuance of the patent and Mr. Hall would have to have an opportunity to meet that evidence. No --

MR. ROBSON: May I make this request, Your Honor,

since it is my understanding that we are going to reserve questions of accounting until after the determination is made of the validity of the patent, may we proceed to offer evidence on the question of the trademark?

THE COURT: I am not going to exclude evidence, but I am not going to permit you to amend the pretrial order, which is what is before me.

MR. ROBSON: What I would hope to do, then, is if the Court finds that that trademark was in fact improperly used --

THE COURT: You don't mean trademark.

MR. ROBSON: Trade secret was in fact improperly used, there would be an opportunity in the future, at the same time as we obtained an accounting for any infringement, to obtain an accounting of any profits derived from the defendant of the trade secret.

THE COURT: I am not going to even go that far. I will permit you to make an application at a later date, but I am not going to rule now that you may have an accounting for profits under your third count if you sustain the cause of action on the third count.

MR. ROBSON: I think I understand Your Honor's position and I am prepared to proceed accordingly.

THE COURT: At the present time I am denying the motion for leave to amend the pretrial order.

MR. ROBSON: Thank you, sir.

THE COURT: You may proceed.

MR. ROBSON: May I hand to Your Honor a copy of the complaint which Your Honor requested yesterday.

May I have the record indicate on the basis of a stipulation with Mr. Hall that --

THE COURT: Are you addressing the Court?

MR. ROBSON: Yes, sir.

THE COURT: Then don't say may I have the record indicate; just make your statement. I don't like this business of lawyers addressing the notebook when they are addressing the Court.

MR. ROBSON: Mr. Hall, if Your Honor please, has indicated that he is prepared to stipulate that the inventor Walter Ploeger, Jr. properly assigned his right to a patent to the Edgecraft Company, which is the named patentee.

The patent in suit was issued to the Edgecraft Company pursuant to an assignment and I merely wish to indicate --

THE COURT: You mean there was a mesne assignment?

MR. ROBSON: There were two assignments, yes, one

from the inventor to the patentee and one from the patentee to the plaintiff. We have already introduced in evidence the assignment --

THE COURT: Who is the patentee?

MR. ROBSON: The patentee is the Edgcraft Company.

THE COURT: Very well.

MR. ROBSON: May we recall Mr. Ploeger.

WALTER PLOEGER, JR.

recalled as a witness, was examined and testified further as follows:

DIRECT EXAMINATION (Cont'd)

BY MR. ROBSON:

Q Mr. Ploeger, during the course of your testimony yesterday I believe you stated that in the course of developing the ribbon which is in suit here you discovered two unexpected results. One was an increased absorbency rate of the nylon and the other was an increase in the ink capacity of the nylon.

Can you explain, on the basis of your expertise in the field of ribbons, why the use of the film welded to the edge of the ribbon resulted in an increased absorbency rate and increased capacity?

THE COURT: Let me get those two terms again, Mr. Robson. One is increased ink absorbency?

MR. ROBSON: Absorbency rate.

THE COURT: And what is the other?

MR. ROBSON: Increased ink capacity.

THE COURT: Very well.

THE WITNESS: May I have that question repeated, please?

(The Reporter read the last question.)

THE WITNESS: No, I cannot.

BY MR. ROBSON:

Q Have you made an effort to determine why those two phenomena occurred?

A I have only thought about it. I haven't come up with the answer.

THE COURT: I want to be sure that I understand these terms correctly. Just precisely what is the difference, Mr. Robson, between ink absorbency and ink capacity?

MR. ROBSON: The absorbency rate is the speed with which the material absorbs the ink, that is, the length of time it takes for a given amount of ink to enter the material. The capacity is the amount of ink which the material is capable of holding when it has fully absorbed the ink. In other words, if we used --

THE COURT: What is the value of increased rate of

ink absorbency? I remember by the experiment that was conducted here in the courtroom yesterday you showed the increased rate or absorbency, but what is the value of it, the practical value of it?

MR. ROBSON: If Your Honor will recall, the witness testified that when the key strikes the ribbon ink is pushed, number one, onto the paper, and number two, away from the point of impression, and the speed with which the ribbon absorbs will determine the speed with which that ink returns to the point of impression.

THE COURT: Tell me briefly, in words of one syllable, what is the importance of ink absorbency. Every trade and business and science has its own jargon but let's get away from that and use ordinary English as though you were explaining it to some friend who knew nothing about this.

MR. ROBSON: Judge Hand once said it requires more ability to state things simply and concisely, and I am trying very hard. I may not be as able as I would like to be.

In effect what I am saying is, the recuperative power of the ribbon is faster. The ink comes back more quickly to the point of impact.

THE COURT: You mean if this capacity did not exist the ink would spread when that spot is hit and would not come

back to that spot so that that spot would be bereft of ink, is that the point?

MR. ROBSON: It would be less inked than other spots.

THE COURT: Is that ink absorbency or ink capacity?

MR. ROBSON: Ink absorbency.

THE COURT: What is ink capacity?

MR. ROBSON: The amount of ink which the ribbon will hold so the ribbon will last much longer in its usage.

THE COURT: I see. It is so easy to explain things simply, Mr. Robson.

MR. ROBSON: I try.

THE COURT: I know. I don't want you to think that I am critical. Now you may proceed.

BY MR. ROBSON:

Q If you recall, Mr. Ploeger, yesterday at the end of the session we were discussing -- I was asking you about the ribbon which resulted from the processing of your ribbon for the Spellright Corp. and the combination of that ribbon with their correction material and I asked you whether the key ever struck the Scotch tape on that ribbon and I believe you stated it did not, and I meant to make certain that the record was clear on that. When you said the key did not strike the

film, the plastic film which was placed on there by your company you were referring, were you not, to the printing portion of that ribbon?

A I was referring to what I -- what I said yesterday was that the type did not impact any Scotch tape on the printing portion of the ribbon. The type face impacted the film portion of the printing ribbon, the film which we had applied as per our invention.

Q The type, however, would impact the Scotch tape when the correction portion is in use?

A That is correct.

Q So that --

THE COURT: Just a moment. Does the key hit the Scotch tape?

THE WITNESS: The key will hit the Scotch tape, sir, when the machine is placed in a position for the key to print on the white portion. The white portion is the one which corrects the mistake. The black portion merely writes the characters and the white portion corrects the mistake.

THE COURT: The Scotch tape extends across the entire width of the ribbon, doesn't it?

THE WITNESS: No, sir, only across the width of the white portion.

THE COURT: The white portion is the correcting portion?

THE WITNESS: That is right.

THE COURT: When you use the correcting portion, then the key strikes the Scotch tape?

THE WITNESS: Yes, sir, that is correct.

BY MR. ROBSON:

Q But when you use the printing portion it strikes the plastic film which is placed on it by your company?

A That is correct, sir.

Q I believe you testified yesterday that after your initial conversations with Mr. Wolowitz you prepared some samples of your ribbon for Mr. Wolowitz' use in preparing the correction tape which he was using, is that correct?

A That is correct, sir.

Q After you prepared those samples did you have any further conversation with Mr. Wolowitz with respect to your printing ribbon?

A Well, after I gave Mr. Wolowitz those early samples he took those samples and combined them into his first correction ribbons, using our material, and he came back and immediately wanted to use our product and he asked us to give him an exclusive on our product.

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A That is correct, sir.

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A Well, after I gave Mr. Wolowitz those early samples he took those samples and combined them into his first correction ribbons, using our material, and he came back and immediately wanted to use our product and he asked us to give him an exclusive on our product.

Q Did you agree to give him an exclusive on your product?

A We did not.

THE COURT: Exclusive what?

BY MR. ROBSON:

Q Did you agree to give him an exclusive license on your product?

A No, we did not.

Q Did you agree to give him any license to use your product?

A No.

Q Did he ask to purchase your product?

A Well, he wanted to purchase the ribbon itself, yes, a supply of ribbon, cut ribbons, yes.

Q Did you indicate to him that your business did not include the sale of ribbon?

A Yes, we did. We told him we were only slitters.

Q Did you have any conversation with him advising him as to how he could obtain a supply of this product?

A Yes, I mentioned to him that he could go to fabric supply houses from whom he could buy the raw woven nylon fabric.

Q Did you identify any particular supply house to him?

A Yes, I mentioned offhand two that I knew of.

Q Which two?

A Standard Product Corp. and the Schwarzenbach-Huber Corp.

Q Did Mr. Wolowitz thereafter, to your knowledge, arrange for a supply of this material from either of those two companies?

A Yes, sir.

Q Which company?

A I believe it was the Schwarzenbach Huber Company.

Q Did you thereafter receive any orders for the processing of the ribbon in issue here from the Schwarzenbach-Huber Company?

A Yes, we did.

Q And to whom was that material delivered?

THE COURT: What kind of orders? You said did he receive orders from Schwarzenbach-Huber Company. Orders for what?

THE WITNESS: The orders entailed for us to slit ribbons made up as per our patent, namely, our film onto woven cotton fabric.

THE COURT: Who furnished the ribbon?

THE WITNESS: The raw material was furnished by the Schwarzenbach-Huber Company and the film --

THE COURT: You were only to cut it, is that it?

THE WITNESS: Yes, sir, we applied the film and slit the ribbon.

BY MR. ROBSON:

Q Who provided the nylon film?

A We provided the film. Our company, Filmon Process, provided the film.

Q So that Schwarzenbach-Huber provided the nylon fabric and your company provided the nylon film?

A I believe I may have made an error in that last answer. Would you ask me that question again? It's a matter of dates here and I may have not answered that question.

Q Is it correct, then, that Schwarzenbach-Huber provided the nylon fabric and your company provided the nylon film?

A That is correct.

Q And then you joined the two, slit them into ribbon size and delivered them to the Spellright Corp., is that correct?

A That is correct, sir.

THE COURT: In other words, you cut the nylon fabric and applied the film and made the finished article, is that it?

THE WITNESS: Yes, sir, that is correct.

BY MR. ROBSON:

Q Did Spellright, to your knowledge, sell -- withdraw that. The ribbon which was processed by you, was that inked or uninked ribbon?

THE COURT: Was that what?

MR. ROBSON: Let me withdraw that and rephrase it.

Q The material which was received from Schwarzenbach-Huber, the nylon fabric, was that nylon fabric inked when you received it or was it uninked?

A It was uninked.

Q Did you ever receive fabric which was inked?

A Yes, we have received inked fabric, certainly.

Q From Schwarzenbach-Huber?

A I don't recall.

Q Did the Spellright Corp. obtain, to your knowledge, ribbon manufactured in accordance with the patent in issue here from any other supplier besides Schwarzenbach-Huber?

A I wouldn't know.

Q During what period of time were you making these deliveries to the Spellright Corp. on instructions from the Schwarzenbach-Huber Corp.?

THE COURT: Why don't you limit it? Lawyers have a way of putting too many qualifications in their questions.

The simple question is, during what period were you making these deliveries to the defendant, isn't that it?

MR. ROBSON: Yes, sir.

THE COURT: Very well. Now suppose you reframe your question.

BY MR. ROBSON:

Q During what period of time were you making deliveries of ribbon to the Spellright Corp.?

A I believe the shipments started in late 1961 and ran into possibly the middle or late summer of '62.

Q Do you recall approximately how much ribbon you shipped to Spellright?

A Oh, about one and one-half million tape yards. In other words, the tape yards of quarter inch material.

THE COURT: What is a tape yard?

THE WITNESS: A tape yard as opposed to a wide yard. A tape yard refers to a narrow ribbon as opposed to a broad yard, which is the wide cloth.

THE COURT: You mean --

THE WITNESS: In other words, that reel I gave you yesterday, sir, that is what we call a tape yard reel.

THE COURT: A yard is a yard. Suppose we find out what a tape yard is.

THE WITNESS: It's a trade term. I'm sorry, I shouldn't have used it. It is a trade term and most people wouldn't be aware of it. Excuse me.

BY MR. ROBSON:

Q You mean one and one-half million yards of ribbon?

A That is what I mean, yes. Right.

Q Was that ribbon, to your knowledge, sold to the general public in form for use in typewriters?

A I believe it was.

Q I show you a box containing some ribbon and ask you whether you have ever seen a box like that before?

A Yes, I have seen a box like this before, many times.

Q What is that box that you have before you?

A It's a box which contains a typewriter ribbon which is marked "Spellright For Typewriters That Don't."

Q Is that one of the boxes which was used by Spellright to sell the ribbon during the period of late 1961 to September 1962 which was processed by you?

A Yes, sir.

MR. HALL: Your Honor, I object.

A I believe it is.

MR. HALL: This is getting to be highly leading.

THE COURT: I will overrule the objection.

MR. HALL: And I think that this is secondary evidence.

THE COURT: Well, that is different. I will sustain that objection, but not the objection on the ground of leading. I think we allow leading questions very often.

Let me see that box, Mr. Robson.

Mr. Hall, let's shorten and streamline this. I will sustain your objection because this is hearsay evidence. But here is a box marked "Spellright For Typewriters That Don't" and it is marked "Manufactured and Guaranteed by Spellright Corporation, 813 - 14th Street, N.W., Washington 5, D.C." Do you want to stipulate that this came from the defendant?

MR. HALL: I have already marked such a box as --

THE COURT: My question to you is, are you willing to stipulate that that came from the defendant?

MR. HALL: Surely.

THE COURT: Well, that is all there is.

MR. HALL: Well, no, there is more than that, Your Honor. He is trying to get into this false marking now and he is trying to --

THE COURT: Let's take one step at a time. The defendant corporation did distribute this box with its contents,

the ribbon, is that correct?

MR. HALL: I don't know about the contents of that particular box.

THE COURT: Suppose you look at it.

I think those matters ought to be stipulated so we wouldn't consume time making technical proof.

(Pause.)

MR. HALL: Your Honor, we are prepared to stipulate that we sold ribbons at one time in boxes of this kind and that this ribbon looks like, roughly, at least, one of our ribbons, but all of our ribbons have an identifying number on them approximately at this position and this ribbon does not, so apparently somebody has cut enough off of this that we can't tell what lot or what manufacture this ribbon came from. So this is sort of an incomplete job that they are giving us; we can't tell the whole story unless the full ribbon is here.

MR. ROBSON: May we indicate, Your Honor, that this was --

THE COURT: Just a moment.

MR. ROBSON: I'm sorry.

THE COURT: You do stipulate that you sold ribbons in boxes of that type?

MR. HALL: Yes.

THE COURT: Suppose we mark that as an exhibit.
Do you want to offer that in evidence?

MR. ROBSON: Before we do that, Your Honor, may I have the cellophane wrapper in which this was sealed when you got it? You just ripped it out of a cellophane wrapper, Mr. Hall.

MR. HALL: Did we do that?

MR. ROBSON: Yes, you did. When I handed this to you this was in a cellophane wrapper with this attached to the ribbon and you ripped the cellophane wrapper open.

MR. HALL: I don't remember that. Do you remember that, Your Honor?

MR. ROBSON: I was standing here watching it.

THE COURT: Now, gentlemen, let's proceed.

MR. ROBSON: We offer that in evidence, If Your Honor please.

THE COURT: Let it be admitted.

You just offer the box, not the contents?

MR. ROBSON: I thought Your Honor said to offer the box. I want the box and the contents.

THE COURT: Then put the contents into the box, and that includes this little leaflet.

Does your stipulation, Mr. Hall, cover the leaflet

also, that this leaflet was enclosed in the box in which the ribbon was contained that you sold?

MR. HALL: That leaflet has our 14th Street address on it. When our company was at 14th Street we issued such leaflets as that.

THE COURT: Suppose we mark this leaflet Plaintiff's Exhibit 7-A.

MR. HALL: I might add that it wasn't necessarily so that these leaflets were packed in the box.

THE COURT: Anyway, they were distributed with the article?

MR. HALL: Well, we'd in many cases supply the store with a supply of leaflets and the store could have the leaflets on the counter and if somebody wanted a leaflet without a ribbon they could have it.

THE COURT: I see. Very well. Then the leaflet can be treated as a separate exhibit. We will still call it 7-A.

(Spellright box and ribbon
marked Plaintiff's Exhibit No.
7 and received in evidence;
Leaflet marked Plaintiff's
Exhibit No. 7-A and received in
evidence.)

THE COURT: Now you may proceed.

BY MR. ROBSON:

Q Mr. Ploeger, where and when did you obtain the box which has just been identified as Exhibit 7?

THE COURT: So long as there is a stipulation, is that necessary?

MR. ROBSON: It's important as to the time when it was obtained, Your Honor.

THE COURT: Your question was where, wasn't it?

MR. ROBSON: Where and when, yes.

THE COURT: Which is it?

Q Let's start with when. When did you obtain that box?

A I received that box very early during the sale of this type of ribbon and I may very well have gotten it from Mr. Wolowitz himself because he did give me a few for use on my office machinery.

Q At the time you received that box did it contain the insert which it presently contains?

A Oh, yes. It was sealed and included an insert, yes.

THE COURT: I don't know what you mean by the insert. I think you better make it clearer.

Q Did it contain the two-page pamphlet which has been marked Exhibit 7-A?

A Yes, it did.

Q Would you examine the ribbon which is contained in that box and tell me whether, if you know, it is the same ribbon as has been previously identified as the ribbon manufactured by Spellright with ribbon produced by you?

A May I have permission to cut off a small strip and try and pull the ribbon apart? Because that would be the most sure and immediate test that I could make.

MR. ROBSON: With Your Honor's permission.

THE COURT: Whom does the ribbon belong to? Is it yours?

MR. ROBSON: It is my ribbon, yes.

THE COURT: I don't mean your personal ribbon.

MR. ROBSON: It is the plaintiff's.

THE COURT: Very well, I have no objection to that. I just didn't want somebody else's property to be interfered with.

(Pause.)

THE WITNESS: I would conclude that this is the ribbon which the defendant made, incorporating our patented material such as the chart that you showed me earlier.

BY MR. ROBSON:

Q And is that --

A Namely, using the Scotch tape as the binding medium between the two members; namely --

THE COURT: Is the Scotch tape there?

THE WITNESS: Yes, sir. We have our ribbon, our patented ribbon, and we have the Scotch tape.

THE COURT: Mr. Robson, let me see it.

MR. ROBSON: Yes, sir.

THE WITNESS: I have pulled it apart here.

(Pause.)

THE COURT: The Scotch tape is attached back of the white portion of the ribbon, is it not?

THE WITNESS: All the way across the white and it just slightly touches the surface of the film on our ribbon, just slightly, by maybe a 32nd or a 16th of an inch.

THE COURT: But it completely covers the white?

THE WITNESS: Yes, sir.

THE COURT: But not the inked portion?

THE WITNESS: Not completely, no; only by a very small narrow area.

THE COURT: Very well. I think that there be no confusion let this be marked as 7-B because it might get separated from its container.

MR. ROBSON: I think that is a good idea, yes, sir.

we would like to offer that, then, as 7-B.

THE COURT: It is already in evidence, but I want it marked separately as 7-B. It is part of Exhibit 7 that has already been admitted.

(Ribbon from Plaintiff's Exhibit 7
marked Plaintiff's Exhibit 7-B
and received in evidence.)

BY MR. ROBSON:

Q When you delivered -- withdraw that. With respect to the material which was processed by you, that is, the nylon fabric which you received from Schwarzenbach-Huber to which you welded your nylon film, did you deliver that finished product directly to Spellright or did you deliver it somewhere else?

A Sometimes it was shipped to Spellright and sometimes it was shipped somewhere else.

Q On what occasions was it shipped to Spellright?

A On occasions when he so directed or someone directed it to be shipped there, namely, Spellright.

Q On the occasions when it was shipped to some other place, to whom was it shipped?

A It was shipped to an inker. It was shipped to New Era Carbon Ribbon Company and I believe some was shipped to

Eaton Allen Company, both inking manufacturers.

Q And it was shipped there for the purpose of applying ink, is that correct?

A That is correct.

Q When you shipped these ribbons to either Spellright, Eaton Allen Corp. or the New Era Carbon Manufacturing Company, was there any label of yours affixed to the package?

A Oh, yes, there was.

MR. ROBSON: Would you mark that?

(Film-On label marked Plaintiff's
Exhibit No. 8 for identifica-
tion.)

BY MR. ROBSON:

Q I show you what has been marked Exhibit 8 for identification and ask you whether that is the label which was affixed to the package?

MR. HALL: Your Honor, I object.

MR. ROBSON: May we get an answer to the question?

THE COURT: This calls for a yes or no answer. I think your objection is premature.

MR. HALL: I think it is too, but I wanted to make sure it wasn't --

THE WITNESS: This is a label similar to what we

would put right on the package of ribbons that we cut, yes, on the outside of the package.

BY MR. ROBSON:

Q And this was during the entire period of time that you dealt with the Spellright Corp.?

A Yes, we used this type of label, yes.

Q And was this label affixed on the packages which were sent to the Spellright Corp.?

A Yes, yes.

MR. ROBSON: I offer it in evidence.

MR. HALL: Your Honor, I object. This is an effort--

THE COURT: Let me see it. Hand the exhibit to the Clerk when you are offering it in evidence.

What is the ground of your objection?

MR. HALL: On the ground that this is outside the scope of the pleadings and directly contrary^{to}/their answers to sworn interrogatories that they gave us a few days after --

THE COURT: I don't think that is a ground for excluding the evidence.

MR. HALL: Well, wait just a minute.

You see, they cannot recover any damages unless they marked their product patented. They are trying to prove patent marking. They have their patent number on that label.

This was all before Judge Sirica when we were before him and he held, in connection with his opposition in the Court of Appeals, that there must be a pleading before the plaintiff can offer evidence of patent marking, it must be alleged in the complaint.

THE COURT: I am going to rule it is not necessary to allege that in the pleadings, not under modern rules of pleading. I am going to allow this, Mr. Hall.

MR. HALL: Your Honor, the Court of Appeals in this very case said it.

THE COURT: I am going to overrule the objection. I am going to allow this evidence.

The point whether he has a right to recover is a different matter, but he has a right to prove his case in his own way and then we will rule on the question whether he has a cause of action. I don't like to rule on questions of substantive law on admissibility of evidence.

Let it be admitted.

(Plaintiff's Exhibit No. 8 for
identification was received
in evidence.)

THE COURT: I might ask you this in order to clarify my own thinking. What is the purpose of this exhibit, Mr. Robson?

MR. ROBSON: The purpose of this exhibit is, along with other evidence in the case --

THE COURT: What is the purpose of this exhibit?

MR. ROBSON: To establish knowledge on the part of the defendant of the fact that this was a patented article.

THE COURT: As I understand it, in answer to an interrogatory --I want to be sure I am right about this-- you answered, when I say you I mean the plaintiff answered the articles were not marked as required by the statute; is that correct?

MR. ROBSON: That is not correct.

THE COURT: What was the answer to the interrogatory?

MR. ROBSON: There were several interrogatories, at least two of which referred to a similar problem. In answer to one interrogatory, and I read from it now, and that was served back in November 1963 --

THE COURT: I don't care when it was.

MR. ROBSON: The following statement appears:

"The marking 'Patented' or similar information was applied to an over-wrap for the product or on literature shipped with the product. The plaintiff has used the terminology that uninked ribbons originating from the plaintiff are patented when inked."

That was in answer to an early interrogatory.

THE COURT: What was that last sentence?

MR. ROBSON: "The plaintiff has used the terminology that uninked ribbons originating from the plaintiff are patented when inked."

The patent refers to inked products, and when the product was uninked there was another stamp.

THE COURT: I think we will go into the substantive law question later on. I am not ruling now that this is a proper marking, all I am doing is to allow plaintiff to prove his case in his own way.

MR. HALL: Could I say another word on this subject?

THE COURT: Yes.

MR. HALL: Your Honor, at the time that we asked this Interrogatory 36 it was immediately after the filing of this suit, four years ago.

THE COURT: I understand, but I am not going to rule --

MR. HALL: But we did not investigate any further because they said point blank in answer to 36 that they didn't mark.

THE COURT: Suppose you locate that answer to the interrogatory.

MR. HALL: The Court of Appeals quoted it in their opinion.

THE COURT: What was before the Court of Appeals was merely an attempt to mandamus Judge Sirica.

I never consider myself bound by dicta, even if they are from the Supreme Court, only by rulings. However, answers to interrogatories are admissions which are binding on the parties.

MR. HALL: Yes. I have marked here on my copy of the papers the Interrogatory 36 and the answer. This is from Judge Sirica's brief.

THE COURT: In order to identify it give me the number of the interrogatory and would you mind reading me the answer?

MR. HALL: Interrogatory 36.

THE COURT: Interrogatory 36 addressed by the defendant to the plaintiff?

MR. HALL: Right.

"Has the owner of the patent in suit made, used or sold anything under said patent or authorized anyone else to make, use or sell anything under the patent in suit? If so, state in complete detail, the thing made, used or sold, by

whom made used or sold, and all steps taken to market the same with the patent number. If there are records kept with reference to the patent marking, give the name and address of the custodian of the records.

"Answer: Yes, the thing sold is a ribbon corresponding identically to that disclosed and claimed in the patent in suit. In addition, services have been rendered in processing ribbon materials for customers who then inked the ribbon material and sell the same. No steps, as such, were taken by the plaintiff to market the patented ribbon with the patent number. No records were kept with respect" --

THE COURT: I see. Very well.

In ruling on admissibility of evidence I only rule on the question whether under the rules of evidence the evidence is admissible; its legal effect I determine later.

MR. HALL: But there is one thing I want to say, though, Your Honor. This answer was given just after this suit was filed and as a result we never investigated to get other evidence which we could have gotten at this time. For example, he was selling this material to other people and we

could have gotten other people to swear that they never got this marking and that they never got --

THE COURT: I understand. We are not going to reach that question unless the plaintiff prevails both on validity and infringement, and then the matter would have to be referred to a special master to fix damages, and at that time I will rule upon this.

MR. HALL: Well, Your Honor, I believe that you will reach that question and, in fact, if you exclude this exhibit we can, I believe, dismiss their case as soon as they rest.

THE COURT: I am not going to exclude it. I don't believe it is appropriate to decide against a plaintiff without giving him an opportunity to present his case on his own theory, and I don't decide substantive law questions in connection with rulings on evidence.

I am overruling the objection. I am admitting this evidence without indicating any views as to its effect on the substantive rights of the parties. That I will determine later.

MR. ROBSON: May I simply indicate to Your Honor I don't want to go into it now, but I disagree very violently with the interpretation of that interrogatory and its answer.

THE COURT: You may proceed with the next question to the witness, Mr. Robson. The record may not indicate anything except what goes on in the courtroom; the record is automatic.

MR. ROBSON: I realize that, sir.

BY MR. ROBSON:

Q Mr. Ploeger, you were shown earlier an exhibit, Exhibit 7, which contained an insert which is Exhibit 7-A. I show you Exhibit 7-A and I call your attention to the wording on the last page of this pamphlet, which says:

"Patented construction backing keeps type clean. Clean your type when you install your Spellright ribbon - you'll never have to clean it again."

THE COURT: Please don't read exhibits. Let's not waste time doing that. What is your next question?

Q Did you have any conversation with Mr. Wolowitz with respect to the use of that language on that pamphlet to be included in packages of the Spellright ribbon?

A Yes, I did.

Q Would you tell us when you had such conversations and where?

A The conversation took place at the plaintiff's offices. The request --

Q When was that?

A That was, oh, I would say possibly very early in '62 or possibly late in '61. I am not quite sure now what the date was there.

Q And would you tell me what was said by you and what was said by --

THE COURT: May I have that date again, the date of the conversation?

THE WITNESS: It was very late '61 or possibly very early in '62.

BY MR. ROBSON:

Q Would you tell us what that conversation was, what was said by you and Mr. Wolowitz?

A Well, Mr. Wolowitz approached me and asked me whether or not I would permit the words "Patented construction backing keeps type clean," seeing that I was going to issue or that -- in other words, seeing that I had a patent covering those words and in the absence of his own patent, if we would dignify his product with those words.

Q And what did you do when Mr. Wolowitz made that request, what did you say?

THE COURT: What words?

THE WITNESS: The words were "Patented construction

backing keeps type clean."

BY MR. ROBSON:

Q What did you say to Mr. Wolowitz when he made that request?

A I said it would be perfectly fine with me.

Q Did you consult with anyone before replying to Mr. Wolowitz?

A Oh, yes, I contacted my attorney's office and Mr. --

THE COURT: I don't think that is material. Whom he consulted is not material and whether he consulted counsel or not is immaterial.

Q What patent was referred to or intended to be referred to in your conversation with Mr. Wolowitz by the words "Patented construction"?

A The patent in suit.

Q In your conversation with Mr. Wolowitz was any other patent mentioned as a patent intended to be referred to by the words "Patented construction"?

A No, I don't recall any. The only patents we ever discussed were the patent in suit.

Q In your conversations with Mr. Wolowitz -- withdraw that. During the period that you were selling or providing ribbon to the Spellright Corp. did you have any occasion to

discuss with Mr. Wolowitz his approval or disapproval of the product which you were processing?

A Well, Mr. Wolowitz was very happy with our product.

Q Did he indicate to you his satisfaction at any time?

A Certainly. Verbally.

Q During the period from September 1961 to August 1962 did you provide the ribbon in suit to any other persons? Commercially I mean?

A Yes, I believe we did.

Q What other companies or customers did you deliver that material to?

A We had occasion to process material for the Eaton Allen Corp., also for Aetna Products Corp.

Q Do you recall any others?

THE COURT: What is the purpose of this line of inquiry?

MR. ROBSON: It is slightly anticipatory, but in order to save time, that one of the defenses being raised here will be lack of commercial success.

THE COURT: That is not a defense.

MR. ROBSON: Well, in connection with one of the defenses.

THE COURT: You mean you want to prove commercial success?

MR. ROBSON: Yes, sir.

THE COURT: That is proper. You may proceed.

BY MR. ROBSON:

Q Do you recall any of the other concerns to whom you delivered the ribbon in suit?

A I think I misunderstood your question, Mr. Robson. I thought you were referring to the type of material that we had been supplying to Spellright and my answers were as to that particular width of tape.

Q I am talking about the material produced in accordance with the patent in suit, no matter what the width.

A I see. Now I understand. Then of course my answer would be we shipped ribbons of our invention to many different sources, yes.

Q Can you identify some of the sources?

A Well, first of all, there would be Schwarzenbach-Huber; Standard Products Corp.; Remington Rand; Leedol Products; Textile Cutting Corp., I believe; New Era Carbon & Ribbon Company; Quest Mfg. Company; Kee Lox Carbon & Ribbon Company; Columbia Carbon & Ribbon Company; I believe Royal Typewriter received our material. There were a number of others which right now I can't recall.

Q Among those you named is Remington Rand still a

user of the ribbon in suit here?

A Yes, they are.

Q I show you a box and ask you whether you can tell us what that box is?

A It's a box containing a -- first of all, it's a box marked Remington ribbon. Do you want me to identify what it says on the box?

Q No, just tell us what the box is and where you obtained it.

A Well, this is a box which you would commonly find being used for typewriter ribbons.

Q Where did you obtain the box?

A This was sent to me from Remington Rand, directly from Remington Rand.

Q And is the ribbon contained in that box ribbon processed in accordance with the patent in suit here?

A Yes, it is.

Q And is that in current use by Remington?

A Yes, it is in current use; that is right.

MR. ROBSON: I would like to offer that in evidence.

THE COURT: Do you claim that is an infringing use or is it derived from the plaintiff?

BY MR. ROBSON:

Q Is the material in this box processed by your

company?

A It is processed by our company.

Q The plaintiff, that is?

A That is correct.

MR. ROBSON: I offer that in evidence, if Your Honor please.

THE COURT: Let it be admitted. Show it to Mr. Hall first.

MR. HALL: Let's see it. I have never seen it before.

(Pause.)

THE COURT: Let's proceed, gentlemen. Hand the exhibit back to counsel, please.

MR. ROBSON: They may look at it first. I am not going to use it any more at this point. I don't have to make any further reference to it now that it is in evidence.

THE COURT: Let it be admitted.

(Remington Rand box and ribbon
marked Plaintiff's Exhibit No. 9
and received in evidence.)

THE COURT: You may proceed.

BY MR. ROBSON:

Q Were your ribbons used by any Government agency?

A Yes.

Q Which agency?

A It's the FAA, I believe.

Q And do you know in connection with what equipment those ribbons are being used?

A Yes, it is being used on the Remington Univac computer.

THE COURT: What Government agency did you mention?

THE WITNESS: The Federal Aeronautics Administration, I believe is the designation.

BY MR. ROBSON:

Q And you were telling us on what equipment it is being used.

A Yes, it is being used on a Remington Rand Univac.

Q Do you know if it is being used on any computers?

A Yes, it is.

Q Which computers is it being used on?

A It is being used on IBM 407s and another number that I am not quite certain of at this moment.

Q Is there a ribbon being specially manufactured by anyone for use on IBM computers?

A Yes, sir, several manufacturers.

Q Which manufacturers are manufacturing ribbons for use on IBM computers?

A There is Leedol Products, there is New Era, Kee Lox,

and a number of others using that specific specialized ribbon for that purpose.

Q Did there come a time when you discontinued supplying the ribbon manufactured in accordance with the patent in suit to the defendant?

A Yes, sir.

Q And approximately when did that occur?

A That was later in '62, about October of '62, I would say.

Q Could it have been September?

A It could have been September. It's a little indefinite. I am not quite sure as to the exact date, but it was sometime about there.

Q Can you describe the circumstances leading up to the termination of your relationship with Spellright?

A Yes. Mr. Wolowitz was very annoyed in the interim that we had not given him an exclusive on our ribbon and he just decided to infringe our patent and make it a different way.

Q Tell us what happened. Did you have a conversation with Mr. Wolowitz before the relationship terminated?

A Yes, I did.

Q Where did that conversation take place?

A We had a conversation at the plaintiff's offices in September, I believe, of '62.

Q And who was present at that time?

A That meeting involved, I believe, Mr. Wolowitz, myself, Mr. Brunner, who is deceased.

Q Who was Mr. Brunner?

A Mr. Brunner was a member of our firm and he is now deceased.

I believe Mr. Mesirow was in attendance at that meeting.

Q Who is Mr. Mesirow?

A Mr. Mesirow, I believe, is an attorney for the defendant.

Q And will you tell us, as best you can recall, what was said by the parties at that conference or at that meeting?

A Well, at that meeting it was brought out to us that they were expecting a competitor to come out with a similar ribbon and that we should immediately without further delay give them an exclusive because of this other competitor coming out with a similar ribbon.

Q Was the competitor identified?

A Yes, the competitor was identified as being Eaton Allen.

Q And what did you say to that request?

A I said I could not give them an exclusive.

Q Did the meeting terminate at that point or was there anything further said that you can recall?

A At that meeting, as far as I can recall, that more or less terminated that meeting, yes.

Q Was there another meeting thereafter?

A Yes, we had a meeting shortly thereafter in Philadelphia.

Q And that was at whose office?

A That was at the office of my attorney, Mr. Seidel.

Q And who was present at that meeting?

A At that meeting representing, I believe, the defendant was Mr. Wolowitz and Mr. Montague. Mr. Montague also, I believe, is an attorney for the defendants. Also, Mr. Seidel was present, I was present, Mr. Brunner of our company who is now deceased was present, and our accountant Mr. Loozis, I believe, was present.

Q Will you tell us, to the best of your recollection, what the conversation was at that meeting? Incidentally, when did this meeting take place, approximately?

A I would say maybe possibly three or four weeks later or maybe even shorter. It was about September of '62,

September or October.

Q Would you tell us now, to the best of your recollection, what was said at that meeting?

A Well, that meeting was more or less a repetition of what we had been going through all along, that Mr. Wolowitz again wanted an exclusive, he said if he couldn't have an exclusive would we sell him the patent, and things of that nature.

Q What was your reply to the request for either an exclusive -- by an exclusive do you mean an exclusive license?

A Yes, when I say exclusive I mean exclusive license, yes.

Q And what was your reply to his request for an exclusive license or for the sale of the patent?

A We told him that we could not grant either request.

Q What did --

THE COURT: You say either request?

THE WITNESS: Yes, either to give him an exclusive license on the product or to sell him the patent.

BY MR. ROBSON:

Q What, if anything, did Mr. Wolowitz reply to that?

A Well, after the meeting we went to a restaurant. I don't know if it was across the street or where it was, but

we were all seated at the table and during the course of social conversation Mr. Wolowitz told me point blank, Mr. Ploeger, if you don't give me the exclusive I am going to break your patent, I am going to infringe.

Q And did you make any reply to Mr. Wolowitz?

A I told him we would have to sue him if he infringed our ribbon, we would have to protect our rights.

Q Did anyone else make any statement to Mr. Wolowitz after he made that statement to you?

A Well, I believe Mr. Seidel had heard the original statement by Mr. Wolowitz and he so informed Mr. Wolowitz, that if Mr. Wolowitz chose to infringe, that we would have to sue him.

Q Did Mr. Wolowitz make any reply to your statement and Mr. Seidel's statement that if he infringed you would have to sue him?

A I don't recall any reply at this particular moment.

Q Did you have any further occasion to discuss your relationships with Mr. Wolowitz or the Spellright Corp. after that meeting in Philadelphia and prior to the institution of this law suit?

A Would you repeat that question?

THE COURT: Suppose we have the question read.

(The Reporter read the last question.)

A Right now I don't recall any further discussion with Mr. Wolowitz.

Q Now did there come a time when you had occasion to believe that a ribbon identical with the ribbon involved in your patent was being sold although it had not been processed by you?

A Yes, there was a time.

Q And when for the first time did you have reason to believe that such a ribbon was being marketed?

A I believe it was in May of 1963.

Q And would you tell me how that information, or what was the basis for that belief?

A A customer of mine, namely, the New Era Carbon and Ribbon Company --

Q Incidentally, don't tell us anything that was said to you, just tell us what happened.

A Well, a customer -- I received a ribbon from a customer of mine, namely, the New Era Carbon and Ribbon Company.

Q Did you examine that ribbon?

A Yes, I did.

Q Would you tell us what your examination of that ribbon revealed?

A Well, the very first thing that I saw was that it

seemed to look exactly like a ribbon made by a process which we had invented. That was the very first reaction. In other words, it was a ribbon that did not include the Scotch tape embodiment which we have been discussing before. This ribbon did not have its two components, namely, the printing portion and the correction portion, fastened by means of Scotch tape.

Q Limiting yourself for the moment to the printing portion of that ribbon -- withdraw that.

If I understand correctly, the ribbon did contain a printing and a correction portion?

A That is correct.

Q Limiting yourself now to the printing portion of that ribbon, can you tell us what the construction was, what the materials were that made up the printing portion of the ribbon?

A The construction was identical to the patent in suit, identical to a ribbon of the patent in suit, namely, a nylon fabric impregnated with ink and having a nylon plastic film sealing one side and fused only along the edges.

Q In other words, the nylon film was attached to the nylon fabric, the nylon printing fabric, at the edges of the printing fabric, is that correct?

A Yes, welded to the extreme edges of the printing

portion.

Q And next to that, alongside of that was the correction material, is that correct?

A That is correct.

Q And how was the correction material fastened or held to the printing portion of the ribbon?

A Well, I could only determine that it was held by a means which I had conveyed to Mr. Wolowitz.

Q It was not held by Scotch tape?

A No, it was not.

Q It was held by some sort of a welded joint, was it?

A Some sort of a weld, that is correct.

THE COURT: Does that mean that this ribbon had three layers, the nylon fabric, nylon film, and a correction fabric?

THE WITNESS: Yes, you might say that, although the correction portion was also covered with a film but that film was more or less glued down. So you might actually say he had four members. You had a film covering the correction material and you had a film covering the printing material, so you had actually four layers.

THE COURT: There were separate films?

THE WITNESS: Two separate films, that is correct.

THE COURT: We will take our usual mid-morning recess at this time.

(Recess.)

THE COURT: You may proceed.

BY MR. ROBSON:

Q Mr. Ploeger, earlier this morning you identified a label which you testified was placed on material shipped by you to persons requesting you to process the ribbon in question. I neglected to ask you whether at any time you placed any additional information on that ribbon other than what appears on the ribbon in blank spaces?

A Yes, we did add to the existing print work, yes.

Q What did you add?

A We added the words which similarly stated that -- in other words, if the ribbons were inked they would then be covered by the above-mentioned patent, or words to that effect.

THE COURT: I think you have to produce the writing, Mr. Robson.

MR. ROBSON: Would Your Honor bear with me for just a moment, then?

THE COURT: You don't have to if you don't want to produce the writing, but I think secondary evidence like that--

MR. ROBSON: I may be able to produce it in just

a moment if I can find the stamp.

THE COURT: Go on to something else.

MR. ROBSON: With Your Honor's permission may I use this chart?

THE COURT: Yes, surely.

BY MR. ROBSON:

Q Now I call your attention to the chart which has just been placed on the table, Mr. Ploeger, and I ask you whether this is a representation of the ribbon which you received from New Era Ribbon and Carbon?

A Yes, it is.

Q Would you explain what the various items are in this ribbon?

A Well, if we look to the left of the chart we find a narrow ribbon fabricated exactly as the ribbon in our invention, namely, a nylon fabric welded along the edges to a nylon film.

On the right side of this chart we find a camouflage material which has been completely covered by a film, and these two members joined together by a weld through the exact center portion of that ribbon, the longitudinal center portion, I should say.

Q Now the nylon fabric --

THE COURT: What do you mean by camouflage material?

THE WITNESS: The camouflage material is the material which covers the mistake, the erroneous letter is camouflaged. There is this chalk or whatever it is, it is a chalk of some kind which is released by the impact of the type upon it and it releases itself and covers an erroneous character.

BY MR. ROBSON:

Q Now were you able to tell from examining this ribbon how the ribbon was constructed? Withdraw that.

Calling your attention to the lefthand portion of the ribbon as it appears on that chart, that is, the nylon fabric welded to the nylon film, were you able to ascertain in examining the ribbon you received from New Era Ribbon and Carbon whether or not that fabric and that nylon film had been processed, that is, slit and welded together by your company, the Filmon Company?

A I could ascertain that it was not slit by our company.

Q Will you describe the methods you used in determining that it was not manufactured by your company?

A Yes. There are two glaring methods by which one can almost immediately ascertain this and these methods are,

first of all, that this particular ribbon has a tendency to fold itself in the direction of the films facing each other. In other words, you can fold this ribbon so that the film on the paper -- on the camouflage material, I should say, and the film on the ink fabric fold that ribbon in such a way as to have both those films touch one another face to face.

Now that indicated to me that the ribbon was made by trade secrets given to Mr. Wolowitz earlier. That was my very first test as to knowing that I did not make this ribbon.

Q Were there any other ways that you had of determining that?

A Yes. The second method was to part --and as I did before on the witness table here-- I merely snipped off a piece of the ribbon and proceeded to part the two entities. I was not interested in the correction entity but, rather, I gave the printing entity my examination and I found immediately that I could not have fabricated that printing entity, again for two reasons, the most prominent of which would be that the leading edge, the outer leading edge, that is, the edge on the left side of that chart there --

Q The extreme left, you mean?

A The extreme left side; right. That extreme left leading edge was very shiny. Now that shininess means

something to me because the shininess is the result or manifestation of a heated knife scraping along the fabric portion of that ribbon.

Now we never manufactured ribbons whereby the knife contacted or impacted the fabric side of that two-layer ribbon but, rather, we always impacted our cutting procedure by having the knife touch the film and then go on through to the cloth.

So the fact that the leading edge was shiny showed me that I could never have cut that ribbon.

And, of course, the second indication that I did not make this ribbon was that the very fact, the very fact that the trade secret was employed, through necessity requires that you end up with a ribbon of our invention. In other words, if you employ our trade secret --

Q Don't get into that yet for a moment.

A Oh, I see. Well, that was my test.

THE COURT: What trade secret are you referring to?

THE WITNESS: I am referring to the trade secret involving the center weld of that particular entire ribbon, sir.

THE COURT: It is what?

THE WITNESS: Earlier we had transmitted trade secrets relative to joining those two members, namely, the

camouflage material and the printing material, so as to be able to get rid of that Scotch tape which had been used earlier. So there was --

THE COURT: You mean the trade secret consisted in the welding process?

THE WITNESS: Well, it consisted in the manner in which these two members were joined, the object being to get rid of the Scotch tape and just join these two members by means of this trade secret.

BY MR. ROBSON:

Q Do you recall any other test which you used for the purpose of ascertaining whether or not the printing portion of this combination had been constructed or processed by your company?

A Well, certainly the first test would be to find out what the materials were.

Now the insert in this ribbon that I purchased indicated that it was a nylon ribbon. It was a nylon ribbon. I assume that he meant an entire nylon ribbon, namely, film and cloth being nylon, exactly as we had been using in our ribbon.

MR. HALL: Your Honor, I think the insert ought to be produced. He ought to produce the insert instead of trying

to surmise as to what it means and let Your Honor --

THE COURT: All I can do is to pass upon admissibility of evidence, not on its weight.

MR. HALL: I move to strike his statement as to what the insert said until the insert has been produced.

THE COURT: Will you read the last sentence?

(The Reporter read the answer as follows:

"Now the insert in this ribbon that I purchased indicated that it was a nylon ribbon. It was a nylon ribbon. I assume that he meant an entire nylon ribbon, namely, film and cloth being nylon, exactly as we had been using in our ribbon.")

THE COURT: Let that part of the answer be stricken.

BY MR. ROBSON:

Q Let me refresh your recollection. Did you make any test with respect to the thickness of any of the material contained?

A Yes, yes.

THE COURT: What are you trying to prove now, Mr. Robson?

MR. ROBSON: I am attempting to prove now that the printing portion of that ribbon was not processed by the

plaintiff.

THE COURT: I wonder if that couldn't be stipulated, that this particular ribbon was not the product of the -- of the plaintiff, you mean?

MR. ROBSON: Yes, sir.

MR. HALL: We don't know, Your Honor. A great many--

THE COURT: You don't want to stipulate?

MR. HALL: No.

THE COURT: That is all right; you don't have to. You may proceed.

BY MR. ROBSON:

Q Do you recall the question?

A I believe we were talking about --

THE COURT: Suppose you read the question.

(The Reporter read the question as follows:

"Did you make any test with respect to the thickness of any of the material contained?")

THE WITNESS: Yes, I did.

Q What test did you make and what was the result of that test?

A I subjected the nylon fabric portion of the entire printing portion to a micrometer caliber test, which indicated to me the exact thickness of the fabric portion of that ribbon.

Q And what was the thickness you ascertained it to be?

A It was slightly more than two-thousandth of an inch.

Q And what was the thickness of the nylon fabric which you processed?

A Exactly the same.

Q And did you measure the thickness of the nylon film?

A Yes, I did.

Q And what was the thickness of the nylon film on the ribbon which you examined?

A Well, that was also a very, very thin film. The test there indicated, on the caliber, between a half and three-quarter mil. It was questionable because the film may have been subjected to some kind of stress or so.

Q And what is the thickness of the nylon film which you used in your process?

A It was three-quarter mil.

Q Did this differ in any respect from the thickness of the film which you used?

A It may have, it may have.

Q After having received this ribbon from New Era did you make any attempt to ascertain whether -- withdraw that.

Did you obtain any other ribbons after the receipt of this ribbon from any source which you had reason to believe--

THE COURT: Are you trying to prove infringement?

MR. ROBSON: Yes, sir.

THE COURT: I think for the present purposes one instance is enough. If you prevail and the matter is referred to a special master for ascertaining damages, then you can prove as many instances as you can. But at this time I think a single instance is sufficient.

MR. ROBSON: Could I ask Your Honor's indulgence because I would just like to introduce one more, and that is all I had in mind, which was sold in a public department store.

THE COURT: You may prove two instances, if you wish.

MR. ROBSON: Because one was a department store and one was a commercial outlet.

THE COURT: Very well.

BY MR. ROBSON:

Q Did you procure any other ribbon of this type from any source after having received this ribbon?

A Yes, I did.

Q And where did you procure that?

A At the Abraham and Strauss Department Store in New York City.

Q And approximately when did you procure that?

A I would say sometime in early June, very early June, late May or early June of that same year.

MR. ROBSON: May we mark this box as one exhibit and the ribbon as one exhibit?

(Spellright box marked Plaintiff's Exhibit No. 10 for identification; Ribbon marked Plaintiff's Exhibit No. 11 for identification.)

BY MR. ROBSON:

Q I show you what have been marked Exhibits 10 and 11 and ask you whether this is the ribbon and this is the box in which it was contained that was purchased at A&S?

A Yes, it is.

Q When did you purchase that?

A It was in, I believe, very early June.

THE COURT: Let me inquire of counsel, is this evidence offered to show commercial success or is it offered as proof of infringement?

MR. ROBSON: As proof of infringement, Your Honor.

THE COURT: Then you have to show, of course, that it came from the defendant.

MR. ROBSON: I believe the box speaks for itself.

THE COURT: Very well. That is a matter of argument.

MR. ROBSON: In addition to which there are admissions in the defendants' answers to interrogatories and deposition.

THE COURT: Of course, I always allow full time for oral argument. You will have to point all that out because I am not going to go through the voluminous files without guidance of counsel.

MR. HALL: Your Honor, that was offered in evidence and I tried to object sooner but there was other conversation. Could you reserve your ruling on the admission of that evidence until I have had a chance to cross-examine the man?

THE COURT: No, I am going to admit it. Your cross-examination would go to probative value. Very often evidence is admissible under rules of evidence which turns out not to have too much probative value in the end, but that would be no reason for excluding it.

BY MR. ROBSON:

Q Did you examine the ribbon which was contained in Exhibit 10 which is marked Exhibit 11, in the same manner --

THE COURT: Is it marked for identification?

MR. ROBSON: Yes. I have offered it in evidence now.

THE COURT: I don't think you did.

MR. ROBSON: Mr. Hall has seen this on a number of occasions.

MR. HALL: Yes; and we have to deny that and I object to it on the ground that it is incomplete. It is not a complete ribbon. You see, they have cut off our identification number.

THE COURT: I will overrule the objection and I will admit it.

MR. ROBSON: There has been no testimony of any identification number.

THE COURT: There is no use arguing when the Court rules in your favor because you might convince the Court to change its mind.

MR. ROBSON: You are absolutely right.

THE COURT: You may proceed.

BY MR. ROBSON:

Q Did you have occasion to examine the ribbon which is Exhibit 11 in the same fashion as you examined the ribbon which you received from New Era Carbon and Manufacturing?

A Yes, I did.

Q And was that ribbon constructed in the same manner?

A Yes, it was.

Q And were you able to determine whether the printing

MR. ROBSON: I'm sorry. I meant to. I offer Exhibits 10 and 11 in evidence.

THE COURT: You didn't offer the prior ribbon in evidence either.

MR. ROBSON: Which prior ribbon was that?

THE COURT: The responsibility is with counsel.

MR. ROBSON: If I overlooked it, I offer in evidence Exhibits 10 and 11.

THE COURT: Very well. 10 is the exhibit that was obtained from a customer, is that it?

MR. ROBSON: 10 is the exhibit that was obtained from Abraham and Strauss.

THE COURT: What about the one that was obtained from a customer?

MR. ROBSON: I do not have that physically present, Your Honor.

THE COURT: Very well.

(Plaintiff's Exhibits Nos. 10 and 11 for identification were received in evidence.)

BY MR. ROBSON:

Q Did you examine the ribbon which was just marked --

THE COURT: Have you shown this to Mr. Hall?

A No, I do not know.

MR. ROBSON: And I state to Your Honor that I don't know and I have consulted with co-counsel.

THE COURT: We don't want counsel to act as witnesses.

MR. ROBSON: Apparently it was delivered to one of my co-counsel in this case at some time during the preparation of this case and we are unable to locate it.

THE COURT: Well, I will allow the question. I think you have laid some foundation for secondary evidence.

BY MR. ROBSON:

Q Is this pamphlet identical with the pamphlet which was in that box?

A May I just take a moment to read it?

Q Yes.

A In respect to the last page and -- at least in respect to the last page, I would say it is identical. I really never made too much of a study of the center portion and I could be incorrect in that regard, but as far as the last page is concerned it looks exactly the same to me.

Q I call your attention to the yellow label appearing on Exhibit 10 containing the words, "Latest Model - Longer Lasting," and I ask you whether that label was on the Spell-right boxes, to your knowledge, during the period of time

when you were providing or processing the ribbon for the Spellright Corp.?

A I never saw that label applied on ribbons that we manufactured.

Q Did you ever see --

THE COURT: You never saw what?

THE WITNESS: I never saw that label used in conjunction on boxes which contained ribbons that included our patented ribbon.

THE COURT: May I see this exhibit, please?

You may proceed.

THE WITNESS: Mr. Robson, I would just qualify my answer, if I may.

MR. ROBSON: To which question?

THE WITNESS: Your last question.

THE COURT: Suppose we have the question read.

THE WITNESS: I may not have understood it correctly.

(The Reporter read the last full question.)

THE WITNESS: I gave the correct answer. I thought I had misunderstood it. My answer should stand.

BY MR. ROBSON:

Q Subsequent to September 1962 did you ever authorize the Spellright Corp. or anyone on its behalf to manufacture

or process a ribbon in accordance with the specifications of the patent in suit here?

A Subsequent --

Q Subsequent to September 1962.

A Subsequent means, again, what?

THE COURT: Suppose we have the question read.

(The Reporter read the question.)

THE WITNESS: No, sir.

BY MR. ROBSON:

Q Did you ever authorize anyone on behalf of the Spellright Corp. to use the expression, "Patented Construction Backing Keeps Type Clean"?

MR. HALL: Your Honor, I object. This is leading. He has already testified in his own words.

THE COURT: This is repetitious.

MR. HALL: And he has already said that he did authorize.

THE COURT: I think this is admissible, but I do call counsel's attention to the fact it is repetitious.

Q I am asking now with respect to subsequent to September 1962, did you ever authorize the use of the words "Patented Construction"?

A No, sir.

Q Earlier you testified that the center weld on the product which you examined which had been received from the New Era Carbon and Ribbon Manufacturing Company had been made by a process which you identified as a trade secret. Would you describe how that center weld was created, in your opinion, based on your examination of that product?

A Certainly. We had --

THE COURT: Suppose you read the question.

You have got so much in it I am afraid I haven't been able to follow it.

(The Reporter read the last question.)

THE COURT: I always consider it objectionable to have preludes to questions. Suppose you just ask the question and simplify it, please.

MR. ROBSON: I will try, sir.

BY MR. ROBSON:

Q Will you describe how the center weld, in your opinion, was constructed on the ribbon which you obtained from New Era Carbon?

A The ribbon was manufactured in a manner as to have the film portions of both separate entities be in direct contact with one another.

If we can picture that model as being folded down.

In other words, we have the center portion and if we picture that we just merely have the center as being a hinge. Where we have the mark "Weld" let's consider that as being a hinge, and all we then do is to loosen the hinge and let both those portions, namely, the left portion, which is the film and fabric, hinge down, and then have the righthand portion, which is the camouflage material and film, hinge down; so that we bring these two members into contact so that the film is in contact with film.

Once we have achieved that we merely run a hot knife -- in other words, what I am just saying is to picture how the relationship is. Actually, there is no weld --

THE COURT: I think he is not answering your question. He is answering how he does it. You asked him how in his opinion it was done in this particular case.

THE WITNESS: Yes, I am trying to answer.

MR. ROBSON: I think he is. His answer is --

THE COURT: He said "what we do."

Very well, proceed.

THE WITNESS: That ribbon was made in such a manner as to have the film portions of both separate entities lie flat longitudinally with the films facing one another. The ribbons were laid one on top of the other longitudinally and

a hot knife was passed right through all four layers.

In other words, if we lay two ribbons on the table longitudinally with the bottom layer having its film facing up and the top layer having its film facing down, we have two strips of ribbon lying longitudinally with the films facing the film. Our next --

MR. ROBSON: May I interrupt --

THE COURT: Let him finish his answer.

THE WITNESS: In other words, we have actually four members here. We have film, film, paper, and fabric, as shown in that. And then what we simply do is to pass a heated, hot knife --

THE COURT: He is not answering your question.

BY MR. ROBSON:

Q Don't tell us what you do; tell us how this ribbon was made.

A Yes. This ribbon was made, again, as I said before, it was laid down strip and strip, one strip on top of the other, with their films facing one another, one film facing up, one film facing down. Then a knife was passed through all four layers, creating, then, that center weld which we have there. That is how that ribbon was made.

Q After that weld was cut, after that hot knife

passed through, how many resulting ribbons like that were there?

A There could have been either one or two. I would say the ribbon was made in such a way as to --

THE COURT: No; you have answered the question.

THE WITNESS: It's either one or two. It could be either.

BY MR. ROBSON:

Q Did you ever have occasion to discuss with Mr. Wolowitz the method which you have just described for constructing the ribbon with the correction material that was purchased in A&S and obtained from the New Era Carbon Company?

A Yes, we did.

Q And when for the first time, to the best of your recollection, did you discuss that with Mr. Wolowitz?

A Oh, that was later in 1961, November or early December of '61.

THE COURT: You are referring to the welding process?

THE WITNESS: Yes, sir, the process by which these two entities were held together, that is what we are discussing.

Q Would you describe to us the conversation, to the best of your recollection, what you said and what Mr. Wolowitz

said?

A Well, the whole thing came into being because of this Scotch --

THE COURT: No, no. Read the question, please. Just answer questions.

(The Reporter read the last question.)

THE WITNESS: Mr. Wolowitz said that he would like to do away with his Scotch binder. I indicated to Mr. Wolowitz that I had a method by which the Scotch binder could be eliminated.

BY MR. ROBSON:

Q Did Mr. Wolowitz ask you to describe the method?

A Yes, he did.

Q Did you describe it?

A Yes, I did.

Q Would you tell us what you said and what you did?

A I got two strips of material, two strips of the material that were made exactly as per the patent in suit. I proceeded to lay these two ribbons on top of one another. They were probably six or eight inches long. I had the film surface of these ribbons arranged so that the film surfaces touched one another and I proceeded to, using a hot knife, part the two members by having the knife cut through and seal all four members together.

THE COURT: How did you seal them?

THE WITNESS: The ribbons were sealed by means of heating a butcher knife with a blow torch and getting the butcher knife hot enough to be able to fuse and then weld all four members together.

THE COURT: Very well.

BY MR. ROBSON:

Q Did you have any conversation with Mr. Wolowitz with respect to your plans for this process?

A Yes, I indicated to Mr. Wolowitz that I had planned to file patents on it.

Q Did you say anything further to Mr. Wolowitz with respect to your intentions to file a patent application?

A Well, I certainly wanted Mr. Wolowitz to retain that information -- I told him to retain it as confidential information.

Q Did you in fact file an application for a patent?

A Yes, I did.

Q Do you recall when?

A I believe it was April of '62 or thereabouts.

MR. ROBSON: Would you mark this?

(Copy of Patent 3,274,039 marked
Plaintiff's Exhibit No. 12 for
identification.)

BY MR. ROBSON:

Q I show you what has been marked Plaintiff's Exhibit 12 and ask you whether this is a copy of the patent which was issued to you on the basis of that application filed in April 1962?

A That is correct.

Q And does that patent describe the process which you have just --

THE COURT: I think the patent speaks for itself.

MR. ROBSON: I offer Exhibit 12 in evidence.

MR. HALL: No objection.

THE COURT: Have you shown it to Mr. Hall?

MR. HALL: No objection.

(Plaintiff's Exhibit No. 12 for
identification was received in
evidence.)

Q Prior to your filing the application for the patent which has now been marked Exhibit 12, did you ever file an application for a patent which embodied a process identical to the process covered in Exhibit 12?

A Yes, I did..

THE COURT: Just what is the purpose of this line of inquiry? What is its relevancy?

MR. ROBSON: The purpose is to establish the defendant's knowledge and use of this principle long prior to his first meeting with Mr. Wolowitz.

THE COURT: I know, but how does the fact that the witness applied for a patent and obtained one bear on that issue?

MR. ROBSON: Mr. Wolowitz' position, as I understand it in the defenses raised so far in this case, is that he for the first time told the plaintiff, Mr. Ploeger, about this process sometime in 1961 or 1962.

THE COURT: I understand. Will you please answer my question. How does the fact that the witness applied for a patent and obtained one bear upon the issue that we are trying?

MR. ROBSON: It bears upon it in the following way, as I understand it. It will establish that the witness knew about this procedure before he ever spoke to Mr. Wolowitz, thereby making it unlikely that he first learned of it from Mr. Wolowitz.

THE COURT: Very well, you have answered the question.

MR. HALL: I have no objection to this that he is doing.

THE COURT: Very well. Sometimes the Court excludes

irrelevant testimony even if it is not objected to, but under the circumstances I will let it stand.

MR. ROBSON: Would you mark this?

I offer Exhibit 13 in evidence.

THE COURT: What are you offering in evidence?

MR. ROBSON: Exhibit 13, which is the patent issued on November 10, 1964 on the basis of the application filed --

THE COURT: Very well, let it be admitted.

MR. HALL: No objection, but I don't think it has been tied in with his testimony very well.

THE COURT: I think the record ought to identify the number of the patent so that we know what the exhibit is.

MR. ROBSON: The prior --

THE COURT: Just what are you offering now?

MR. ROBSON: The present patent is 3,156,338.

THE COURT: Are you offering it in evidence?

MR. ROBSON: As Exhibit 13.

THE COURT: Let it be admitted.

(Patent 3,156,338 marked Plaintiff's Exhibit No. 13 for identification and received in evidence.)

MR. ROBSON: I would also like to offer in evidence Patent No. 3,086,901, issued on April 23rd, 1963 to Walter

Ploeger, Jr., this one covering the method and the one which has already been introduced as Exhibit 13 covering the product.

THE COURT: Let it be admitted.

(Patent 3,086,901 marked Plaintiff's Exhibit No. 14 for identification and received in evidence.)

THE COURT: These are all patents issued to the plaintiff.

MR. ROBSON: These were issued to Walter Ploeger, Jr. and thereafter assigned to the plaintiff.

THE COURT: Yes, I should say issued to the witness.

MR. ROBSON: Yes, sir.

MR. HALL: That last patent, could I have the date on it?

THE COURT: Our practice here is always to show an exhibit to opposing counsel as it is being introduced.

MR. ROBSON: I'm sorry, sir.

Would Your Honor bear with me for a moment? I am coming rather close to the end of this witness' testimony.

THE COURT: If you wish we can recess now so you can take an inventory. You are pretty near finished with this witness?

MR. ROBSON: Yes, sir.

THE COURT: I believe, Mr. Hall, you have a witness that you want to put on at the opening of the afternoon session?

MR. HALL: Yes, sir.

THE COURT: How much longer will your direct examination take?

MR. ROBSON: Of this witness? My guess is 10 or 15 minutes.

THE COURT: I think we better interrupt it, then, in accordance with the commitment made yesterday and let Mr. Hall call his witness.

MR. ROBSON: I have no objection to that.

MR. HALL: May it be understood that in taking the testimony of Mr. Kaufman at 1:30 or whenever you resume, that it will be part of our defense and not part of their case?

THE COURT: Oh, yes.

MR. HALL: And that by doing this out of order I do not lose my right to move to dismiss at the termination of their case?

THE COURT: Yes, but a motion to dismiss in an equity case doesn't amount to very much.

I am going to take the testimony on both sides and

decide the case on the merits. I think that is more satisfactory to both sides.

MR. HALL: All right.

THE COURT: I hope, however, Mr. Robson, you can bring this to a close pretty promptly.

MR. ROBSON: We have one witness after Mr. Ploeger.

(At 12:20 p.m. trial stood in recess,
to reconvene 1:45 p.m.)

- - -

AFTERNOON SESSION

THE COURT: You may proceed.

MR. HALL: We are calling Mr. Kaufman as a witness,
Your Honor.

HENRY J. KAUFMAN

called as a witness by Defendants, having been duly sworn,
was examined and testified as follows:

DIRECT EXAMINATION

BY MR. HALL:

Q Would you state your name, age, and occupation?

A My name is Henry J. Kaufman. I am 60 years of age.
I have an advertising and public relations agency.

Q How long have you been in the advertising and public relations business?

A Well, if you go back to the days prior to the advertising agency, probably since 1923.

Q Did there come a time when you got the account of the Spellright Corp.?

A Well, I don't know whether you would call it an account. It was sort of a friendly accommodation arrangement. We were asked by Mr. Wolowitz to prepare some material for him. I was intrigued with the idea that he was marketing and we agreed to help him for a brief period of time, yes, sir.

Q I hand you a document which has been marked Plaintiff's Exhibit 7-A and ask you if this document was composed by your advertising agency?

A Yes, I believe it was.

Q If you would look at the last sheet of it, it refers there to a patented construction backing keeps type clean. Could you tell us the history of that, where your agency got the information, what information you got and how it came about that this was written?

MR. ROBSON: If Your Honor please, I wonder if we could have dates fixed when Mr. Kaufman was retained --

THE COURT: I don't like any interruption except

for the purpose of noting an objection, and the objection should be stated in legalistic phraseology.

MR. ROBSON: I object to the testimony unless the witness states when he composed that document.

THE COURT: Objection overruled. Don't make argumentative objections. Say, I object on the following grounds, so that the witness won't -- the purpose of that is sometimes an argumentative objection gives ideas to the witness.

MR. HALL: Would you proceed with your answer?

THE WITNESS: Would you repeat the question, please?

THE COURT: Read the question.

(The Reporter read the last question.)

THE WITNESS: Of course most of the information we get, and I assume it was equally true in this case, is the result of discussions between representatives of my agency and the client.

In this case we dealt mainly with Mr. Wolowitz and a Mrs. Jacobs, I believe, his sister.

The product was described to us --

MR. ROBSON: If Your Honor please, I am going to object on the ground that this is hearsay.

THE COURT: Please don't interrupt. You can move to strike after the answer is finished but you can't interrupt

a witness; and besides which, I will say the same thing to you that I said to Mr. Hall, we take a very dim view of objections to evidence in a non-jury case.

Objection overruled.

MR. ROBSON: I'm sorry, sir.

THE WITNESS: This information is obtained in discussions with the client, in this case Mr. Wolowitz and his sister.

I was also asked to be a director of this company, in which capacity I served for several years, and in the course of directors' meetings we picked up more information concerning the progress of the product, its patent rights, and so forth.

So, I can only assume that the information which is contained in this was gained in that fashion. We would have had no other way to get it, Mr. Hall.

BY MR. HALL:

Q You mean you got it from attending a director's meeting?

A Director's meeting and subsequent and prior discussions with Mr. Wolowitz and Mrs. Jacobs.

Q What kind of information was given to you; what was said, in other words?

A Well, the product was demonstrated to us and it was described to us, and of course we didn't know whether there were products of a like nature or similar nature of the product, so we wanted to know what the unique features were so we could describe the unique features and their purposes in such material as you have handed to me.

We did know that it was a plastic backing and we did understand that that was unique.

We also understood that patents had been applied for on this and in the course of a director's meeting were told that a patent had been allowed, which as far as I was concerned was passed on to our copywriters as information indicating that this was a unique feature and that it was a patented feature.

Q To what extent does your advertising agency deal with the word "patent" in connection with its advertising and copywriting? I don't mean with respect to Spellright but I mean in general, how much experience have you had in that field?

A Very little. Most of the products that we are involved in and the services that we are involved in, in promoting, are consumer products where the technical aspects of it are not a matter of great importance. So, I wouldn't

say that we have a great deal of experience from the standpoint of patent practice.

Q Well, were you familiar with the distinctions between a patent allowed and patented and patent pending and all that sort of thing?

A Not clearly. I would assume that patent allowed means it was allowed, that it was granted.

Q When you wrote this were you referring to some possible patent right of Mr. Wolowitz?

A Well, that would be the only one I would have any interest in protecting, yes, sir.

Q Did you ever hear of Mr. Walter Ploeger, Jr., who doesn't seem to be in the courtroom right now, but did you ever hear of him, Walter Ploeger, Jr.?

A No, I don't know Mr. Ploeger.

Q Did you ever hear of Walter Ploeger, Jr.?

A No.

Q Did you ever hear of the Filmon Process Corp.?

A No.

Q I show you the Ploeger patent 3,010,559, and ask you if you ever saw or heard of it before?

A Well, I can tell you without looking at it I didn't because I am not accustomed to looking at such things

as this.

Q And you never heard of that patent before this controversy arose?

A No.

Q And you didn't write your copy for the purpose of referring to this patent?

A No; we only wrote our copy for the purposes of emphasizing the importance and the uniqueness of the product which Mr. Wolowitz had described to us.

Q I don't suppose there is any need to get into this because the Court probably knows it. However, is there some code of ethics with respect to advertising agencies?

A There certainly is, and there is certainly one with regard to mine, and that is to present products in their best possible but also the most accurate light possible.

Q And this statement about patented backing was written in good faith, believing that to be a true statement?

A It certainly was.

MR. HALL: I have here an invoice that has previously been marked Plaintiff's Pretrial Exhibit 103 and I ask that it be marked Defendant's Exhibit 1 for identification.

(Kaufman invoice to Spellright dtd

Mar. 31, 1962, \$30, marked Defendants'

Exhibit No. 1 for identification.

MR. ROBSON: No objection.

MR. HALL: And I have another invoice that I ask be marked Defendants' Exhibit 2 for identification.

(Kaufman invoice to Spellright dtd Sept 30, 1961, \$20, marked Defendants' Exh. No. 2 for identification.)

BY MR. HALL:

Q Mr. Kaufman, what has happened to the file of your agency relating to your early work for Spellright Corp.?

A Well, due to the temporary nature of our relationship and most of the work that we did was on an accommodation basis, we didn't attempt to maintain any basic files on the account, and I moved our offices from 14th and H to the Canal Building in Georgetown about four years ago and any files that didn't relate to active accounts, most of them were cleaned out.

Q I hand you these invoices, Defendants' Exhibit 1 and Defendants' Exhibit 2, both for identification, and ask you if these are invoices of your company?

A Both of them are invoices of our company.

Q Are you able to say whether those invoices pertain to this leaflet that we had earlier?

A I would assume that they did because this bill was rendered for this kind of purpose at about that time and I don't think we had any other invoices relating to it.

Q Did your company ever cause there to be any publicity releases on behalf of Spellright?

A On several occasions we used our mailing list to send out brief product releases to the trade press.

MR. HALL: I have this document that I ask be marked Defendants' Exhibit 3 for identification.

(Publicity release marked Defendants' Exhibit No. 3 for identification.)

MR. HALL: May this be marked, a sheet which is page 70 of the magazine International Management for November 1962, and I ask that be marked Defendants' Exhibit 4 for identification.

(Page 70, International Management, 1962, marked Defendants' Exhibit No. 4 for identification.)

MR. ROBSON: I have no objection to Defendants' Exhibit 3. May I see Exhibit 4?

BY MR. HALL:

Q Is this document, Defendants' Exhibit 3, something that was prepared by your company?

THE COURT: No, I can read it. When we have a jury I like to have counsel read the exhibits if anyone is to read them, but when there is no jury the Court can read them itself and save time.

(Defendants' Exhibits Nos. 3
and 4 for identification were
received in evidence.)

MR. HALL: You may cross-examine.

THE COURT: You may proceed.

CROSS-EXAMINATION

BY MR. ROBSON:

Q Mr. Kaufman, when, if you recall, were you first consulted by Mr. Wolowitz or the Spellright Corp.?

A It was either the end of '61 or early in '62, to the best of my recollection.

Q Do the exhibits in front of you, the invoices from your company, assist you in arriving at that determination?

A Yes, you are right. One invoice here is September '61 and the other is March '62. So, it would have to be toward the end of 1961 or the last quarter.

Q I believe you testified that you were responsible, or your company was responsible for preparing the information in Exhibit 7-A, the little pamphlet which was shown to you, is

A I would assume that they did because this bill was rendered for this kind of purpose at about that time and I don't think we had any other invoices relating to it.

Q Did your company ever cause there to be any publicity releases on behalf of Spellright?

A On several occasions we used our mailing list to send out brief product releases to the trade press.

MR. HALL: I have this document that I ask be marked Defendants' Exhibit 3 for identification.

(Publicity release marked Defendants' Exhibit No. 3 for identification.)

MR. HALL: May this be marked, a sheet which is page 70 of the magazine International Management for November 1962, and I ask that be marked Defendants' Exhibit 4 for identification.

(Page 70, International Management, 1962, marked Defendants' Exhibit No. 4 for identification.)

MR. ROBSON: I have no objection to Defendants' Exhibit 3. May I see Exhibit 4?

BY MR. HALL:

Q Is this document, Defendants' Exhibit 3, something that was prepared by your company?

A I believe we laid that out and wrote the copy for it, yes, sir.

MR. ROBSON: I have no objection to Exhibit 4, either.

BY MR. HALL:

Q I notice that it says on Exhibit 3 that it has a reprint from the 1962 -- excuse me, I have made a mistake. I thought that that was this, but it's not.

MR. HALL: All right, if they have no objection to these, I will just --

THE COURT: What is the relevancy of this material?

MR. HALL: Your Honor, they have offered no objection.

THE COURT: I don't care about that. The Court of its own motion does not exclude evidence just because it may be incompetent but it does exclude evidence that is irrelevant on its own motion.

MR. HALL: Your Honor, these leaflets show the nature of the Spellright product.

THE COURT: Very well, that answers my question. Let them be admitted.

MR. HALL: Just so you will understand it, could I read what it says here?

THE COURT: No, I can read it. When we have a jury I like to have counsel read the exhibits if anyone is to read them, but when there is no jury the Court can read them itself and save time.

(Defendants' Exhibits Nos. 3
and 4 for identification were
received in evidence.)

MR. HALL: You may cross-examine.

THE COURT: You may proceed.

CROSS-EXAMINATION

BY MR. ROBSON:

Q Mr. Kaufman, when, if you recall, were you first consulted by Mr. Wolowitz or the Spellright Corp.?

A It was either the end of '61 or early in '62, to the best of my recollection.

Q Do the exhibits in front of you, the invoices from your company, assist you in arriving at that determination?

A Yes, you are right. One invoice here is September '61 and the other is March '62. So, it would have to be toward the end of 1961 or the last quarter.

Q I believe you testified that you were responsible, or your company was responsible for preparing the information in Exhibit 7-A, the little pamphlet which was shown to you, is

that correct?

A That is correct.

Q Did you personally prepare that information?

A No, one of the writers in our office prepared it.

Q Did you, however, supervise it at any time or review it?

A No, I just passed the information along to the copywriters, who processed it and saw that it was approved and printed.

Q The information, then, emanated from you after --

A The original information emanated from me, that is right.

Q Is it your recollection that the pamphlet was prepared by you sometime during the early part of 1962, prior to that invoice of March 1962?

A Yes, it would have had to be within, say, 60 days of that time that we prepared it.

Q Do you have a copy of that pamphlet in front of you?

A No, sir, I do not.

THE COURT: You have other copies, don't you?

MR. ROBSON: I have one that is similar to it. I don't have the exhibit copy.

THE COURT: Well, it doesn't make any difference.

They are all alike, aren't they?

MR. ROBSON: Yes, sir.

THE COURT: I am keeping the exhibit.

BY MR. ROBSON:

Q I would like to ask you some questions about the information contained on that copy. First let me understand, it is your testimony --

THE COURT: No, just ask your questions without any preludes.

Q Is it your testimony that you received this information which you then gave to your copywriter from Mr. Wolowitz and Mrs. Jacobs and the board of directors?

A No, either from Mr. Wolowitz or Mrs. Jacobs. Some of this information may have been provided in the course of a director's meeting, but all information which we got concerning this product came from either Mr. Wolowitz or his sister.

Q Are you able to identify which one gave you which information at this time?

A No, I am sorry.

Q Calling your attention to the second dotted paragraph, the one that starts with the words "Patented Construction," do you see that?

A Yes, sir.

Q What backing of the ribbon was referred to in those words "Patented Construction Backing," do you know?

A Well, the only description that I recall of the product itself at that stage of its development was a plastic backing and that was supposedly the unique feature and that was the feature that I understood was patented.

Q When you say a plastic backing, do you recall that the ribbon had both a correction portion and a printing portion, a black and a white portion?

A I think so.

Q And do you remember that the black portion was used for printing and the white --

THE COURT: I think this is beyond the scope of the direct examination. All that this witness testified to on the direct examination is that he caused this text to be prepared, who he got the information from, and that he acted in good faith. I think to cross-examine the witness concerning the actual structure is outside of the scope of the direct examination.

MR. ROBSON: I wasn't intending to --

THE COURT: In this Court when the Court rules, that is that.

MR. ROBSON: No, I am not questioning Your Honor's

ruling, sir.

THE COURT: Ask the next question.

MR. ROBSON: I am just trying to explain --

THE COURT: Ask the next question.

MR. ROBSON: Yes, sir.

BY MR. ROBSON:

Q Do you know whether the word "Backing" in that sentence referred to the backing of the printing portion of the ribbon or the backing of the correction portion?

A I can only assume that it referred to the correction portion because that was the unique feature.

Q It was your understanding, then, that it was the backing on the correction portion that keeps the type clean?

A I think so, yes.

Q And that was the information you received, as you best recall it, from either Mr. Wolowitz or Mrs. Jacobs?

A Well, in all fairness to you, sir, and also to the Judge, with reference to this question, I am not a technical man, I understood there was a unique plastic treatment which enabled half the ribbon to be used for printing purposes and the other half for correction purposes, and that is my best recollection of the entire product.

Q Let me call your attention to the third dotted

paragraph, which states that it gives you sharper, crisper originals, et cetera. I ask you whether it was your understanding that it was the typing portion or the correcting portion which gave sharper, crisper originals?

A Well, it refers to a combination of the two because in avoiding the problem of erasures it generally created a cleaner page impression, and that is what we are concerned with.

Q But did you believe that it was the correction portion which gave a sharper original?

THE COURT: No, I am going to exclude that. This is in a different paragraph from the reference to the patented construction. The paragraph concerning which you are interrogating the witness does not necessarily refer to the patented construction. I am going to exclude that.

MR. ROBSON: So I may understand, is Your Honor excluding --

THE COURT: I am excluding that question.

It isn't customary in this Court to respond to the Court's rulings.

BY MR. ROBSON:

Q The third paragraph refers to the ability of the ribbon to give more carbon copies. Was that a feature of the

correction portion or the printing portion of the ribbon?

THE COURT: I am going to exclude that. I think it is outside of the scope of the direct examination and outside of the issues.

BY MR. ROBSON:

Q Do you recall whether you were told the manner in which the correction portion of the ribbon effected or had the effect of keeping the type clean, that is, how the backing had the effect of keeping the type clean?

A I really don't recall.

Q Do you recall whether you were told anything at all on that subject?

A I really don't recall.

Q Is it possible that you are mistaken and that the backing which was indicated to you as keeping the type clean was the backing of the printing portion and not the backing of the correction portion?

A Repeat that question.

THE COURT: Of course it is possible that anybody may be mistaken. You are asking the witness whether it was possible that he is mistaken. Of course it is possible for anybody to be mistaken.

MR. ROBSON: Then let me withdraw that question and

ask this question:

BY MR. ROBSON:

Q Are you absolutely certain that you were told that it was the backing on the correction portion --

A No, I am not sure.

Q You are not sure?

A No.

MR. ROBSON: I have no further questions.

MR. HALL: No further questions.

THE COURT: The witness may be excused.

Mr. Robson, in reference to this question of false marking, the way you have been bringing out the evidence I assume that you claim that the ribbon in connection with which this leaflet was used is an infringement of the plaintiff's patent, is that correct?

MR. ROBSON: That is correct, sir.

THE COURT: Well, if that is so, then there is no false marking because you object to the words patented construction but you claim it is a patented construction.

MR. ROBSON: Yes, sir, but the false marking statute makes it a violation to use the term patented without consent of the patentee. In other words, it is intended to apply to a situation where one uses a patented article without

permission and identifies it as patented.

THE COURT: I see. Well, of course, but you haven't read or perhaps you have overlooked the rest of the provision: it must be done with the intent of counterfeiting or imitating the marks of the patentee or of deceiving the public.

MR. ROBSON: Yes, sir, I realize that.

THE COURT: Very well. Do you want to resume your examination of Mr. Ploeger?

MR. ROBSON: Yes, sir.

MR. HALL: Your Honor, since you are taking a dim view of any motion to dismiss I bring, can I offer these documents in evidence, Exhibits 1 to 4?

THE COURT: Let them be admitted.

That does not prejudice your motion to dismiss if you care to make one because we are taking your testimony out of order.

(Defendants' Exhibits Nos. 1 and 2 for identification were received in evidence.)

THE COURT: Now we will resume the plaintiff's case.

WALTER PLOEGER, JR.

resumed the witness stand and was examined and testified further as follows:

VOLUME II

IN THE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA

Appeal No. 21527

FILMON PROCESS CORPORATION,
Appellant,

v.

SPELLRIGHT CORPORATION, *et al.,*
Appellee.

JOINT APPENDIX

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA

United States Court of Appeals
for the District of Columbia Circuit

FILED FEB 19 1968

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Without Prejudice, Counts Two, Three, Four,
Five of the Counterclaim
- 7 Motion To Dismiss Count II of Complaint
dated January 6, 1967
- 8 Order dated February 23, 1967 Denying
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- 9 Pretrial Order Dated December 19, 1966
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721-723, 729, 730, 743, 744, 756, 761, 762,
765, 766, 780, 782, 786-793

15 File wrapper of Letters Patent 3,010,559;
pages 7, 8, 13, 27, 40, 41, 47-55 (plaintiff's
exhibit one)

16 Defendant's Exhibits

1 - Kaufman invoice to Spellright dated
March 31, 1962

2 - Kaufman invoice to Spellright dated
September 30, 1961

3 - Publicity release published November, 1962

12 - Letter from Mr. Ploeger to Mr. Wolowitz
dated December 18, 1961

14 - Letter from Mr. Hall to Mr. Lavine dated
June 27, 1963

17 United States Patents

Stark	1,953,316	April 3, 1934
Phelps	2,044,630	June 16, 1936
Francis	2,657,157	October 27, 1953
Murphy	2,728,439	December 27, 1955
Ploeger	3,010,559	November 28, 1961
Ploeger	3,274,039	September 20, 1966
Markes	2,699,244	January 11, 1955

18 Foreign Patents

German - Gruendel 966,174 June 27, 1957

(with translation - Def. Exh. 9)

British - Wolowitz 961,108 June 17, 1964

19 Opinion of Judge Holtzoff dated October 9, 1967

20 Final Judgment dated October 20, 1967

21 Notice of Appeal

22 Order dated November 29, 1967 extending time
to file transcript

TESTIMONY OF WITNESSES

Walter Ploeger, Jr.	108-244;
	252-386;
	686-698
Henry J. Kauffman	244-261
Estelle Jacobs	387-413
Arthur H. Seidel	413-460;
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William H. Wolowitz	627-679

DIRECT EXAMINATION (Cont'd)

BY MR. ROBSON:

Q Mr. Ploeger, this morning I showed you a label and you testified, I believe, that that was a label which was affixed by the Filmon Process Corp., the plaintiff here, to certain material when it was shipped out; and I ask you whether that label was affixed to ribbons which were uninked at the time they were shipped out, as the label stood?

THE COURT: What is your question?

MR. ROBSON: Whether the label which he identified this morning was affixed to ribbons which did not have ink in them when they were shipped out.

THE COURT: What is your answer?

THE WITNESS: I believe I said --

THE COURT: You are just repeating something that you questioned the witness about. Please don't do that.

MR. ROBSON: I am merely trying to clarify the record.

THE COURT: You don't clarify by repetition. Suppose you go on to something else.

MR. ROBSON: I don't believe he answered fully this morning.

THE COURT: But don't ask the same question more than once, please.

BY MR. ROBSON:

Q Was that label affixed to uninked ribbon?

A That label was affixed to uninked ribbon, with one important addition.

Q As it was introduced in evidence was it affixed to uninked ribbon?

A Well, that label --

THE COURT: The question calls for a yes or no answer or I don't know or I don't remember.

THE WITNESS: Would you repeat the question?

THE COURT: Read the question.

(The Reporter read the last question.)

THE WITNESS: Yes, it was affixed to the package of uninked ribbon, with a rubber stamp having also been added to this label.

Q The exhibit in evidence this morning did not have a rubber stamp.

THE COURT: Please don't make statements to the witness. You will have to confine yourself to asking questions.

The Court would be glad, however, to be informed which exhibit you are inquiring about.

MR. ROBSON: Exhibit No. 8.

THE WITNESS: May I see that exhibit again, please?

THE COURT: Just a moment. You have to wait until a question is asked you and then answer the question.

THE WITNESS: Yes, sir.

THE COURT: Will you answer the Court's question?

MR. ROBSON: I'm sorry, sir, I didn't realize there was a question.

THE COURT: The Court asked you which exhibit you were interrogating the witness about.

MR. ROBSON: Exhibit 8, Your Honor.

THE COURT: Very well. Let me see it, please.

Very well, you may proceed.

MR. ROBSON: May the witness look at exhibit --

THE COURT: Ask the next question.

BY MR. ROBSON:

Q Did a label identical with Exhibit 8, without a rubber stamp on it, was that affixed to ribbons which were uninked?

THE COURT: The witness already answered that it was affixed to the package, not to the ribbon.

Q To the package.

A To the package, yes.

Q Without the rubber stamp on it?

A Without the rubber stamp for the material that was

inked. In other words, the material that was inked did not have the rubber stamp on it. The stuff that was uninked, the stuff that was uninked had affixed to it a rubber stamp.

I am getting a little confused here.

THE COURT: No, I think it is perfectly clear. The witness' answer is perfectly clear.

I think this witness has been perfectly clear all the way along, anyway.

MR. ROBSON: Yes, that answer is clear.

BY MR. ROBSON:

Q This morning you identified a demonstration which you made to Mr. Wolowitz. Prior to that demonstration did you have any conversation with Mr. Wolowitz as to the confidential nature of that process?

A Yes, I did.

Q Prior to that demonstration did you make any other demonstration to Mr. Wolowitz?

A Yes, I did.

Q Would you tell us what demonstration you made to Mr. Wolowitz prior to the one you described this morning?

A Well, I demonstrated to Mr. Wolowitz that I had several patents on file at the Patent Office as patent pendings which resulted in welds which were impervious to leakage. In

other words, I showed him a product which I was in production on, which offered the quality of having a center weld which was ink impervious. Simply stated, ink would not cross this barrier, it was an ink impervious barrier.

Q Did you explain to Mr. Wolowitz how this weld was achieved?

A Yes, I did.

Q How did you explain to him it was achieved?

A I explained to him that this particular product which happened to be an endless loop ribbon, this endless loop ribbon was basically formed from a ribbon made according to the patent in suit and I simply took a piece of this ribbon --

THE COURT: Just a moment. You have answered the question. Just confine yourself to the four corners of the questions that counsel asks you. Counsel knows what questions he wants to ask.

MR. HALL: I move to strike the answer on the ground that this is getting into an alleged trade secret that--

THE COURT: What is your objection?

MR. HALL: I move to strike the answer.

THE COURT: In an equity case I don't strike answers. If it is irrelevant, it won't affect me. Motion denied.

BY MR. ROBSON:

Q I show you Exhibit 15 and I ask you if this is an endless loop of the type which you showed to Mr. Wolowitz?

A Yes.

Q And would you describe how that loop is made, or was made?

A Yes. The loop was made in the following manner: A ribbon roughly two inches wide was first fabricated according to the patent in suit. This tape then was taken in such a way as to fold upon itself so that the film portion on one part of the tape found itself facing the film portion of the other loop of the tape. As soon as this relationship took place -- in other words, it looked something like this. I simply twisted the ribbon around and had the film to film, roughly in this manner. I then proceeded by means of a hot knife heated by a blow torch, this heated knife was hot enough to effect an ink impervious weld by melting through all four layers, because we do have four layers involved here.

THE COURT: Mr. Robson, we have had this two or three times already, as to how he got this weld. Let's not repeat.

MR. ROBSON: All right, Your Honor.

THE COURT: I think you can give the Court credit

for remembering testimony.

MR. ROBSON: In an excess of caution --

THE COURT: I know, but you can waste an awful lot of the Court's time by having things repeated; besides which, we have a heavy docket, we have other lawyers waiting to have their cases tried.

MR. ROBSON: Would Your Honor object to a very short demonstration of how that weld operates?

THE COURT: Very well. That is not repetition because he has not demonstrated yet. But I just don't want the same explanation repeated.

THE WITNESS: I would just like to clarify that I am using the same test medium as I employed yesterday during the absorbency test which we ran, the exact same medium.

What I am just trying to show here is that we are able to -- I will put a little of this medium in this eye dropper and what we are merely trying to illustrate here is that in actual fact --

THE COURT: Just a moment. I think we ought to have a large blotter. I don't want to have any of that liquid spatter.

THE WITNESS: Your Honor, it won't go through, it will be all right. I have some rags here.

THE COURT: I don't want anything spattered on this furniture.

THE WITNESS: Right. I will be very careful.

May I just hand you this. You will see that this medium follows this line without crossing. Incidentally, this is from my finger right here. But if you will look at this ink impervious weld here you will see that this medium will not cross it and it never will. That feature is very important.

THE COURT: I don't want any of that stuff spattering.

MR. ROBSON: May I just hold it up and show it to Your Honor?

THE COURT: Put it away somewhere where it won't spatter on anything.

BY MR. ROBSON:

Q In your conversation with Mr. Wolowitz when you authorized him to use the words patented construction in connection with the Spellright ribbon, did you authorize him to use those words with respect to ribbons which were not produced by you?

A I did not.

MR. HALL: Your Honor, I object. This is leading. He has already testified on this subject. He gave an

unequivocal approval of the right --

THE COURT: You are asking for a conclusion, Mr. Robson. I will sustain the objection on that ground.

BY MR. ROBSON:

Q Would you tell us just what you said to Mr. Wolowitz when you authorized him to use the words patented construction?

MR. HALL: Your Honor, I object to that.

THE COURT: Objection overruled.

You may answer.

THE WITNESS: I'm sorry, would you please repeat that question?

THE COURT: Read the question, please.

(The Reporter read the last question.)

THE WITNESS: Mr. Wolowitz was advised --

THE COURT: No, no, tell us what you said to him.

THE WITNESS: Yes. I said to Mr. Wolowitz, As long as you use my patented ribbon, a ribbon of my invention, you may use that terminology.

Q After you concluded that the ribbon which you purchased from A&S was constructed in violation of what you believe to be your patent rights, did you take any action thereafter?

A I'm sorry, I missed you on the first few sentences.

THE COURT: Let the question be read.

(The Reporter read the last question.)

THE WITNESS: Yes, I did.

BY MR. ROBSON:

Q What did you do?

A I contacted Mr. Seidel.

Q Mr. Seidel was your attorney?

A Is my attorney, yes, that is correct.

Q What did you tell Mr. Seidel?

A I told Mr. Seidel that I had found an infringing ribbon.

Q Did you instruct him to do anything?

A Yes, I instructed him to file suit, a patent infringement suit.

MR. ROBSON: May we mark this?

(List of department stores marked
Plaintiff's Exhibit No. 16 for
identification.)

Q I show you what has been marked Plaintiff's Exhibit 16 and ask you if you can tell us what that is?

A This appears to be a list of Department Stores which were compiled by the Spellright Corp. and distributed by the Spellright Corp. to many, many sources.

Q Where and when did you first see that list?

A I first saw this list in the offices, I believe, of Eaton Allen Corp.

Q And did you obtain a copy of that list?

A Yes, I did.

Q And what did you do with it?

A I gave the list to Mr. Seidel, my attorney.

MR. ROBSON: May we have this marked?

(Ribbon marked Plaintiff's Exhibit
No. 17 for identification.)

MR. ROBSON: If Your Honor please, at this time I would like to ask Mr. Hall whether he will stipulate that this ribbon is the ribbon which was identified at page 44 of Mr. Wolowitz' deposition as Plaintiff's Exhibit 2.

THE COURT: If it is identified you don't have to stipulate. If the record shows that, counsel doesn't have to stipulate.

MR. ROBSON: It is only identified by a little label attached to it.

THE COURT: That is all that is necessary. Please don't stop for that. Proceed.

BY MR. ROBSON:

Q Mr. Ploeger, I show you what has been marked

Plaintiff's Exhibit 17 and ask you whether you have examined that ribbon for the purpose of determining the manner in which it was constructed and whether the printing portion was processed by --

THE COURT: What are you trying to show by this line of inquiry, Mr. Robson?

MR. ROBSON: P-2 was identified during the deposition of Mr. Wolowitz --

THE COURT: Will you tell me what you are trying to show by this line of inquiry?

MR. ROBSON: I am trying to establish that ribbons like P-2 were admittedly sold by Mr. Wolowitz to 21 department stores in 15 states.

THE COURT: Of course, that might go to the issue of damages. I am not going to take evidence at this stage of the case on the issue of damages. All you have to do is to prove one or two instances of infringement in order to make out a case of infringement.

MR. ROBSON: I know, sir, but in the event that any one of the other two that I have identified are questionable, this is an admitted sale by the defendant. It is just this one ribbon and one sheet of paper, is the only evidence I intend to introduce on the subject.

THE COURT: I don't want to go into details as to

how he analyzed it.

MR. ROBSON: No, sir; no details.

THE COURT: Very well. You said you had only 10 or 15 minutes more with this witness.

MR. ROBSON: I have only two or three more questions.

THE COURT: Very well. There is such a thing as over-trying a case, as you know as an experienced trial lawyer.

MR. ROBSON: I am trying not to.

THE COURT: Very well, you may proceed.

MR. ROBSON: Could the question be re-read, please?

(The Reporter read the question as follows:

"Mr. Ploeger, I show you what has been marked Plaintiff's Exhibit 17 and ask you whether you have examined that ribbon for the purpose of determining the manner in which it was constructed and whether the printing portion was processed by --")

THE COURT: That is what I think is cumulative. Let him answer yes or no.

MR. ROBSON: Yes, that is all I wanted, sir.

THE WITNESS: I'm sorry, would you repeat that?

(The Reporter re-read the question.)

MR. ROBSON: -- the plaintiff, Filmon Process Corp.?

THE COURT: The answer is yes or no.

THE WITNESS: Yes.

BY MR. ROBSON:

Q On the basis of that examination will you state whether the printing portion was or was not manufactured by the plaintiff, Filmon Process Corp.?

A The printing portion was --

THE COURT: Just answer yes or no.

Read the question.

(The Reporter read the last question.)

A It was not.

Q Is the printing portion of that ribbon constructed in the same manner as the printing portion of the ribbon which you purchased from A&S?

A Yes.

Q Who is the present owner of all of the patents and all of the trade secrets which were at one time or another owned by you?

A The plaintiff corporation, the Filmon Corp., Filmon Process Corp.

MR. ROBSON: I have no further questions at this time, if Your Honor please.

THE COURT: Any cross-examination?

MR. HALL: Your Honor, I would like to interrogate him with reference to some documents that are in the Court

file and in the deposition that is on your desk. Could we have them?

THE COURT: The Court likes to follow the depositions. Have you got another copy?

MR. HALL: All right. The first matter about which I would like to interrogate him is Interrogatory 36 which we asked and which he personally signed the answer to.

THE COURT: Very well.

MR. HALL: It would be easier for Your Honor to find it in Judge Sirica's opposition.

THE COURT: You may proceed.

CROSS-EXAMINATION

BY MR. HALL:

Q Mr. Ploeger, during the prosecution of this case did you swear under oath to the answers to interrogatories that we propounded to you?

A Would you show me the interrogatory? I don't know which one you are referring to, sir.

Q All right, I refer you to Interrogatory 36 and your answer to it. Would you look at the end of that paper and see if you are the man that executed these answers under oath?

A Well, I would like to see the questions so I can

read the answers.

Q All right. Here is the question, Interrogatory 36, and here is your answer to Interrogatory 36.

I want to ask you if you signed that answer under oath before a notary public?

A Your Honor, may I just read the interrogatory so I can refresh my memory, please?

THE COURT: Of course you may before you answer the question.

(Pause.)

THE WITNESS: Mr. Hall, would you please show me the answer?

THE COURT: Mr. Hall, what was your question to the witness?

MR. HALL: Is he the man that swore to this answer.

(Pause.)

THE WITNESS: Yes, sir.

BY MR. HALL:

Q When did you swear to that answer?

THE COURT: Well, I think it speaks for itself. The oath is dated.

Q You answered that interrogatory in 1963?

A I am looking to see when I signed it.

THE COURT: It speaks for itself. The 6th of August 1963.

BY MR. HALL:

Q I would like to read this interrogatory and your answer and ask you if you still agree to the statement that is made in it:

"Question 36 - Has the owner of the patent in suit made, used or sold anything under said patent or authorized anyone else to make, use or sell anything under the patent in suit? If so, state in complete detail the thing made, used or sold, by whom made, used or sold, and all steps taken to market the same with the patent number. If there are records kept with respect to the patent marking give the name and address of the custodian of these records.

"Answer - Yes, the thing sold is a ribbon corresponding identically to that disclosed and claimed in the patent in suit. In addition, services have been rendered processing ribbon materials for customers, who then ink the ribbon material and sell the same. No steps as such were taken to market the patented ribbon with the patent

number. No records were kept with respect to patent marking. No one has been licensed to make, use or sell the ribbon of the patent in suit except that implied license which flows from dealings with the plaintiff."

Now do you still agree to the truth of that answer?

A Mr. Hall, I do agree with what I said, but if you would be specific as to what your question is. It is a very long question and a very long answer, and I certainly agree with what I said, yes. It's not very clear, though, sir, what exactly you want of me at this particular point.

Q I am just asking you --

A I feel it is true, yes, sir.

Q You feel that that is true?

A Yes, sir.

Q And you felt it was true at the time you signed it, is that correct?

A Yes, I did.

Q Then how does it come that you produce in this court a sticker, Plaintiff's Exhibit 8, with your patent number on it and tell this Court that you were putting that on your product?

A I am afraid I don't -- would you rephrase that

question? I don't quite understand what you ask there.

THE COURT: Would you like to have the question read?

THE WITNESS: Yes.

THE COURT: Would you read the question?

(The Reporter read the last question.)

THE WITNESS: The label which you just presented was affixed to the outer label -- to the outer wrapping, I should say, on packages which were sent to my customers.

BY MR. HALL:

Q Well, how do you reconcile that with your sworn statement, and I quote, "No steps as such were taken to market the patented ribbon with the patent number."

A I understand your question now. What we refer to there simply was that the ribbon -- in other words, we did not merchandise an inked ribbon, Mr. Hall. We did not merchandise an inked ribbon. In other words, the inked ribbon was the responsibility and the interest of my customers.

So, what that answer really involved simply was that we were not in the business of inking this particular uninked material and then re-spooling it into usable typewriter ribbons, so to speak. That was what our answer entailed.

Q Your patent contemplates a ribbon that is inked, is that it?

A Yes, it certainly does.

Q And so if you sold a ribbon that corresponded identically with the patent, it would have ink on it, wouldn't it?

A If I sold it in spool form, that is correct.

Q All right. Now let's look at your answer to Interrogatory 36, and it says, and I quote, "The thing sold is a ribbon corresponding identically to that disclosed and claimed in the patent in suit."

Now was that true?

A That was true, certainly.

Q And were those ribbons that you sold that corresponded identically with the patent in suit marked with this patent number?

A The packages in which these ribbons were shipped had affixed to them that label.

It is impractical to mark a patent number on a very narrow strip of tape, it is impossible, and it certainly is impossible to affix a patent number onto an inked tape. No one would see it.

Q Well, even if the label was on the package, how do you reconcile that with your statement, "No steps as such were taken by the plaintiff to market the patented ribbon with

the patent number."

A Well, the ribbon, again, as I say, becomes a patent when there is ink in it, and we did not attempt to market an inked ribbon, Mr. Hall.

Q Isn't it a fact that you signed the answer to that interrogatory within about a year after you were actually shipping this material to Spellright Corp.?

A I am not sure at this particular point.

Q Well, look at the date on it and see if that wasn't about a year after you were shipping the material.

A Would you first repeat the question, please?

(The Reporter read the question.)

A Was the date on this interrogatory '64, did you say, or '63?

Q Does the answer to the interrogatory show that you signed it in August of 1963?

A Yes, it does.

Q All right. When were you shipping material to Spellright?

A We shipped material to Spellright from late '61 to the later part of '62.

Q So this answer to the interrogatory was about a year after you shipped the material to Spellright?

A Evidently, yes.

Q And then did there later come a time when you heard that the Court of Appeals held or said that you couldn't recover any damages unless you proved that you did mark the number on your patent? Did that come to your attention?

A Mr. Hall, it did not. I am not a lawyer.

Q How does it come about, then, that you have brought up this label at this late time? Why wasn't this label brought up before?

A I don't understand your question, Mr. Hall.

Q Well, you were asked in Interrogatory 36 to state all steps to market the product with the patent number. At that time why didn't you tell us about this label with the patent number on it?

A Well, I would probably say it's possible that there may have been an understanding on our part that you meant inked ribbons, and I think the connotation here in your question is did we mark inked ribbons, and as I pointed out before, it is literally impossible to put a patent marking on an inked ribbon.

Q Well, now, let's go back and look at your answer again. You said, in 36, "The thing sold is a ribbon corresponding identically to that disclosed and claimed in the patent

in suit. In addition, services have been rendered in processing ribbon materials for customers, who then ink the ribbon material and sell the same."

A Mr. Hall, I'm sorry, I didn't follow you. What are you reading from right now?

Q Your answer to Interrogatory 36. You first say that, "The thing sold is a ribbon corresponding identically to that disclosed and claimed in the patent in suit."

Now that would cover an inked ribbon, wouldn't it?

A I want to see what "The thing sold" refers to again. (Pause.) Yes, my answer is correct.

Q That sentence, then, refers to an inked ribbon?

A Which sentence is that, Mr. Hall?

Q The sentence that reads, "The thing sold is a ribbon corresponding identically to that disclosed and claimed in the patent in suit."

A It could or couldn't be, I would say. It could or couldn't be.

Q Well, the thing claimed in the patent in suit, both claims have ink referred to, don't they?

A Yes, ribbons that are to be inked, that is correct.

Q So, if the thing sold corresponded identically with the thing claimed in the patent, the thing sold would have to have ink in it, wouldn't it?

A The ultimate product that was sold would have ink in it, certainly.

Q All right. Now, then, let's read the next sentence of your answer that you gave in 1963: "In addition, services have been rendered in processing ribbon material for customers, who then ink the ribbon material and sell the same."

Now that is referring to material that you sell uninked, is that correct?

A That is correct. That would be uninked tape. That is right.

Q And I take it that your testimony today before this Court is that back in 1963 you were affixing this label of Exhibit 8 to both inked and uninked ribbons, is that correct?

A No, that is not correct.

Q What were you affixing to the inked ribbons, then?

A To the inked ribbons?

Q Yes.

A To the inked ribbons we were affixing this exact duplicate label, exactly as we have it here.

Q And what were you affixing to the uninked ribbons?

A To the uninked ribbons we used the same label with a rubber stamp which added something in writing to that label.

Q Really the question I have for you, the real main

question is, why didn't you tell us that back in 1963 when we asked you that interrogatory?

A Mr. Hall, I will repeat what I said before. The connotation, I believe, of your original question in the interrogatory was understood to mean dealing with finished typewriter ribbons. This is the connotation, the meaning that we derived from your question.

Q All right.

A In other words, again I will repeat this, the reason no effort could be made to mark a finished inked ribbon is that you just can't get a mark onto it.

Q Why didn't you tell us that and say that you affixed the label to the package, then?

A I don't think the question dealt with the uninked ribbon at all. I think you were asking did we merchandise a typewriter ribbon. This is how I believe we understood it. I can only give you, sir, how I understand the question.

MR. HALL: Your Honor, you say you want to follow this deposition. How do you suggest that I do it?

THE COURT: You mean you want to cross-examine --

MR. HALL: I want to confront him with statements that he made on his deposition and ask him if he so testified.

THE COURT: You wish to cross-examine the witness?

MR. HALL: Yes.

THE COURT: Well, you have a right to ask him, Were you asked the following question and did you give the following answer.

BY MR. HALL:

Q Mr. Ploeger, the date on which you claim to have disclosed this trade secret to Mr. Wolowitz was sometime in December 1961?

A I would say the very first part of December, yes, sir.

Q And you wrote Mr. Wolowitz a letter about that meeting, didn't you? You subsequently wrote him a letter?

A May I see the letter, sir?

Q Yes.

A I do believe I wrote him a letter, but I would like to --

MR. HALL: It is Plaintiff's Exhibit 12 of the Ploeger deposition. Would that be with the deposition that Your Honor has?

THE COURT: You may proceed.

MR. HALL: I have to have the letter, first, to show him.

THE COURT: You haven't got a copy?

MR. HALL: Yes, I have a copy.

THE COURT: Is the letter attached to the deposition?

MR. HALL: I would assume so.

THE COURT: Perhaps, Mr. Hall, you might need a few minutes to locate the exhibits that you wish to cross-examine the witness about.

MR. HALL: No, I have got my copy.

Will you agree that this is Ploeger Exhibit 12 of the deposition?

MR. ROBSON: Yes, I believe it is.

BY MR. HALL:

Q Mr. Ploeger, I show you what has been agreed by Mr. Robson to be Ploeger Exhibit 12 of your deposition and then I would like to read you from your deposition and ask you if you so testified.

THE COURT: What page?

MR. HALL: Page 152.

Q We are referring to this letter:

"Q It makes reference to 'A discussion when you were here' in the letter.

"A That is correct.

"Q Can you tell us, as nearly verbatim as possible, what that discussion was about?

"A The discussion basically --

"Mr. Gonda: May I state that when he says verbatim he means word for word.

"By Mr. Hall:

"Q As nearly word for word as possible, and if you can't give us word for word, summarize it as best you can and as nearly as possible to the way it occurred as you can.

"A Well, trying to be as pertinent in this discussion as possible, in other words, to clarify this discussion, the discussion may very well have been social in some respects, but specifically dealing with this pertinent paragraph here the discussion took the form of a demonstration, a verbal demonstration, a graphical and mechanical demonstration.

"Q So he came up to see you and you had some sort of a new way to make a ribbon and you told him about it; was that what it was?

"A That is correct.

"Q Is that all that happened that you can remember at that time?

"A That is all I remember."

Did you so testify?

A Yes, sir.

Q At that testimony why didn't you say that you asked him to keep it confidential, if indeed you did so request him to keep it confidential?

A I had no reason not to say so. I am sure the record will show that some place in the testimony I definitely indicated to Mr. Wolowitz that he should certainly keep that as a trade secret. That particular thing you just read me, I did answer that way, certainly, but that doesn't mean I didn't say so.

Q Your deposition extended for two days and this happened on the first day, didn't it? You will notice I was reading from the book for July 22nd, 1963.

A Well, was that the transcript of the first day?

Q Yes.

A I will accept that, yes, sir.

Q And it wasn't until the second day, was it, that you brought up this thing about it being confidential?

A Well, again, as I said before, what you asked me was whether or not I made a demonstration and I believe I indicated that I did. You didn't ask me if we had any particular talks. I don't believe your question did entail what did we talk about; I think it dealt specifically, in spirit, with the demonstration that I made, sir.

Q Well, didn't I ask you to tell us as nearly verbatim as possible just what happened, and if you couldn't tell us --

A You said what happened. A happening is usually mechanical procedure, it is not a discussion necessarily, sir. I understood you to mean was a mechanical demonstration made, a graphic demonstration, such as I made with the ink test. But I was not asked about discussions, sir.

Q Now let's look at the question:

"As nearly word for word as possible, and if you can't give us word for word, summarize it as best you can and as nearly as possible to the way it occurred as you can."

Wasn't that the question?

A Evidently that is the question, yes. I understood you to ask me what occurred in regards to the trade secret, and I am just trying to point out that what occurred was demonstrations, yes, sir.

Q Isn't it a fact that all through your dealings with Wolowitz you were freely giving him ideas with no strings attached?

A Well, Mr. Hall, I think, in all fairness, would you please tell me what you mean by freely and how many ideas and so on? That is an awful broad statement.

THE COURT: Well, we will take our usual mid-afternoon recess at this time.

(Recess.)

THE COURT: Before you proceed, Mr. Hall, I want to say a word about schedule.

I presume that you will want to get back to New York tomorrow afternoon?

MR. ROBSON: No, sir, I don't have any problem.

THE COURT: When I say you, some of your associates want to get back to New York tomorrow afternoon?

MR. ROBSON: No, sir. I understand that one of the defendants' witnesses has a problem.

THE COURT: Something was said to me through my Law Clerk that some of the persons connected with the case were observing a religious holiday.

MR. ROBSON: I believe it is a witness of the defendant, if I am not mistaken.

MR. HALL: Mr. Wolowitz and Mrs. Jacobs.

THE COURT: Is he here?

MR. HALL: Yes.

THE COURT: I thought it was some of the New York people that wanted to get back to New York.

MR. ROBSON: No, sir.

THE COURT: Well, then, we can go on all day

tomorrow, if necessary.

MR. HALL: Absolutely.

THE COURT: Then we ought to be able to finish this case.

MR. ROBSON: I hope so.

THE COURT: I thought it was some of your clients, some of your witnesses.

MR. ROBSON: No, sir.

THE COURT: Mr. Wolowitz resides here in this area, does he not?

MR. HALL: Yes, Your Honor.

THE COURT: You may proceed.

BY MR. HALL:

Q Mr. Ploeger, I would like to show you some testimony you gave before, at page 120 of your deposition, and ask you if you didn't so testify.

MR. HALL: Would Your Honor prefer if I asked the question and he read the answer?

THE COURT: I think it is entirely in counsel's discretion. I always like the form, Were you asked the following question and did you give the following answer, and then have counsel read the question and answer to the witness.

Q Mr. Ploeger, were you asked the following questions

at your deposition and did you give the following answers:

"Q You mentioned that Wolowitz approached you and advised you that he was interested in merchandising some product embodying your ribbons. Can you tell us which one of your four companies he approached?

"A I believe, to the best of my knowledge, that at the time of our first visit, that visit dealing with the first approach of Mr. Wolowitz by Mr. Wolowitz, that he approached the Flexene Corp. in the belief that was the corporation, or in essence dealt with Edgcraft Company or the Edgcraft process Corp., again which I am not sure of which one of the two designations it was at that time.

"Q Then all of your dealings with Mr. Wolowitz and with the defendant with respect to these ribbons prior to January '62 were on behalf of Flexene or Edgcraft, is that right?

"A What do you mean by these ribbons?

"Q Let's reword the question. Prior to the formation of Filmon Process Corp. which company in your view was Mr. Wolowitz dealing with?

"A As I said before, we had no business dealings whatsoever or conversations, so he dealt not with us but with people from whom he bought his material. He never dealt with us in any respect. Our meetings were strictly social and that was all. He dealt with none of our corporations on this ribbon, as you pointed out.

"Q When you gave Mr. Wolowitz and/or Spellright information which one of your several companies were you speaking for?

"A I am not sure. I am not sure because of the time element. I am not sure."

Did you so testify?

A Yes, sir.

Q And I start again at the bottom of page 121:

"Prior to the formation of Filmon Process Corp., when Mr. Wolowitz and/or Spellright were having conversations, social or otherwise, and dealing social or otherwise with you, which one of the several companies that you have mentioned were you speaking for?

"A That is a question I can't answer. I can't say that I officially spoke for one or the other. I am not sure."

Did you so testify?

A Yes, sir.

Q Now I would like to turn to page 148 of your deposition:

"Q Was there a time when you and Mr. Wolowitz were on friendly terms?

"A Decidedly so.

"Q Were you freely giving him helpful suggestions as to how to improve his product?

"A Yes, sir.

"Q And you passed along helpful suggestions to him without any strings attached, didn't you?

"A I would think so. Certainly.

"Q I have here a letter which I will ask be marked Ploeger Deposition Exhibit 11 for identification."

MR. HALL: Is it possible to find that letter somewhere in the courtroom? I can't find the exhibits.

THE COURT: I don't know where it is. Perhaps the Clerk knows.

MR. HALL: Would you know where the Exhibits to the deposition are?

THE DEPUTY CLERK: There are none.

THE COURT: The Clerk informs the Court that there were no exhibits filed with the deposition.

It may be the exhibits identified during the deposition were retained by counsel. I am just surmising the possibility.

MR. HALL: No, Your Honor, they were turned over to the Reporter.

THE COURT: They have not been filed, I am informed by the Clerk.

MR. HALL: I think there may be a problem here. The plaintiff asked that these depositions be sealed because they claimed that they contained confidential information, and I am wondering if possibly the exhibits were sealed separately, somehow.

THE COURT: I will inquire of the Clerk, were these depositions sealed?

THE DEPUTY CLERK: Your Honor, at one time there was one deposition which was directed be sealed. However, it was reopened and replaced in the file with the rest of the jacket some two years ago.

THE COURT: The Clerk informs the Court at one time one of the depositions was sealed but a couple of years ago it was unsealed and placed in the regular file; is that

Did you so testify?

A Yes, sir.

Q Now I would like to turn to page 148 of your deposition:

"Q Was there a time when you and Mr. Wolowitz were on friendly terms?

"A Decidedly so.

"Q Were you freely giving him helpful suggestions as to how to improve his product?

"A Yes, sir.

"Q And you passed along helpful suggestions to him without any strings attached, didn't you?

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A Yes, sir.

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"A Decidedly so.

"Q Were you freely giving him helpful suggestions as to how to improve his product?

"A Yes, sir.

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correct, Mr. Haller?

THE DEPUTY CLERK: Yes, sir.

MR. HALL: The Ploeger Jr. deposition exhibits are with the Ploeger Sr. deposition.

THE COURT: You have them?

MR. HALL: Yes.

THE COURT: Very well.

BY MR. HALL:

Q Mr. Ploeger, I show you the document which was marked Exhibit 11.

MR. ROBSON: If Your Honor please, may I look at that letter over Mr. Hall's shoulder? I don't have a copy of it.

THE COURT: You can stand over there, if you wish. Surely.

Q Mr. Ploeger, I show you the letter which was marked Ploeger Jr. Deposition Exhibit 11. Would you look at the letter?

(Pause.)

A Yes, sir, I have looked at the letter.

Q All right. With the letter you sent him a proposed ribbon, didn't you?

A That is correct.

Q Something that you thought was one of your ideas,

is that correct?

A I would think that was one of my ideas, yes.

Q All right. Now let's resume reading your deposition at page 149:

"Q With reference to that letter which has just been marked, does that bear your signature?

A Yes.

"Q" --

A Excuse me. I would like to see the reference to that letter, because I was listening to you.

All right, fine. That is December 5th. All right.

Q So you admit you signed the letter of December 5th, 1961?

A Oh, yes, unquestionably.

Q Then we read on from the deposition and I will ask you if you so testified:

"Q You wrote that letter to Mr. Wolowitz?

"A That is correct.

"Q Was there ever any understanding or arrangement that if he used that suggestion he had to pay you for it?

"A Not to my knowledge. I have no recollection of it.

"Q Was that the same basis on which you submitted all your suggestions to him?

"A I don't recall. If you would be more specific as to suggestions I might be able to give you a better answer, but I don't know, in regard to all of the suggestions that I may have made."

Did you so testify?

A Yes, I certainly did. Yes, sir.

Q Then I would like for you to look at page 12 of your deposition. Actually, the question seems to occur on page 10 and then there is a lot of talk among the lawyers. Speaking of Mr. Wolowitz, the question was:

"What dealings did he have with Filmon Process Corp.?"

Then the answer appears on page 12:

"The Witness: I think I understand the question. In the matter of Filmon Process Corp. being represented by myself in any dealings, the only dealings that Mr. Wolowitz had with Filmon Process Corp. were strictly on a conversational basis, both social and conversational dealing with the Spellright product, which products that I myself had, and so forth. In other words, that

is the extent of the dealings that Spellright had with Filmon Corp."

A That is correct.

Q "By Mr. Hall:

"Q Did Filmon Process Corp. ever make any agreements, either oral or written, with Spellright Corp.?

"A No."

A That is correct, absolutely correct.

Q Mr. Ploeger, you referred to an alleged trade secret that you claim to have disclosed to Mr. Wolowitz in December of 1961. Does your patent 3,086,901, which is Plaintiff's Exhibit 14, disclose those trade secrets?

A Would you repeat the question?

THE COURT: Suppose you read the question.

(The Reporter read the last question.)

A Yes, in part, in part. The spirit of the trade secret is partly imparted in this patent.

Q All right. When did that patent issue, can you look on it and tell us?

A It issued on April 23rd, 1963.

Q Mr. Ploeger, that patent on its face shows that it was issued to the Edgcraft Corp. How does it come about that

you say that Filmon Process Corp. owned the trade secret?

A Mr. Hall, I am not a lawyer but I believe, I believe an assignment, a legal assignment was made from Edgecraft Company to the Filmon Process Corp. at some time between the original assignment and the issuing of the patent. That is my belief. I am not a lawyer and I understand there are assignments made in these respects, but I do believe that the original assignment which was made to the Edgecraft Company was then -- the patent was then assigned, reassigned to the Filmon Company.

Q That would be at a later date, after the patent had already issued, wouldn't it?

A I'm sorry, I don't understand the question.

Q The patent issued to the Edgecraft Company. So the assignment to the Filmon Process Corp. was at a later time, wasn't it?

A I don't know. It's a legal matter. I have no knowledge of this type of law, sir.

Q So, actually, you don't know who owned those trade secrets at any given time, do you?

A Legally speaking, no, sir.

Q Now you and your father operate a number of corporations and partnerships as follows: The Flexene Corp, the

Edgecraft Process Corp., Filmon Process Corp., the Edgecraft Company. How about all those?

A I believe some of them are incorrect that you mentioned. I would like the question read, please.

Q Let's name them one by one. The Flexene Corp.

A That is correct.

Q You and your father own all the stock in Flexene?

A No, we don't.

Q Well, you and your father control the Flexene Corp?

A I don't know if we do or not.

Q But you and your father run the Flexene Corp?

A I don't know what you mean by run, sir.

Q All right. Your father --

A We are an organization of people who all work with their hands. It is a very intimate type of business and I really don't know what you mean by run in this instance.

Q Well, your father is president of the Flexene Corp?

A That is correct.

Q And you are vice-president?

A That is right.

Q And then there is the Edgecraft Process Corp?

A I don't believe that is the correct designation.

Q What is the correct designation?

A I believe it is Edgecraft Process Company, Inc.

Q And your father is president of it?

A That is correct.

Q And you are vice-president?

A That is right.

Q And then there is the Filmon Process Corp?

A That is correct.

Q And your father is president of it?

A That is right.

Q And you are the vice-president?

A That is correct.

Q And then there is the Edgecraft Company?

A That is right.

Q Which is a partnership?

A It is no longer a partnership.

Q It went out of business a long time ago?

A No, it didn't go out of business. One of the partners died.

Q And so the partnership became dissolved?

A Yes. It was a partnership of my mother and father and my mother died.

Q When did she die?

A She died in '63, early in '63.

Q What date?

A I don't offhand recall.

Q Well, can you give us the month?

A I would say the early part of the year. I am not sure. It could have been in March. I believe it was in March, yes.

Q Thank you. Now shortly after your so-called invention came on the market you were successful in getting Eaton Allen to market it under the trade name Clean Shield, is that correct?

A I understand they used it as such, yes, that is correct.

Q It was a nylon typewriter ribbon a half-inch wide with a nylon backing?

A I don't know exactly what your terminology is in regards to typewriter ribbon.

Q Well, at any rate, it lasted on the market only a few months and then Eaton Allen withdrew it, isn't that correct?

A Mr. Hall, again may I say to you that in order to answer that question intelligently would you please define what you mean by typewriter ribbon, because it is a very, very loosely held term in our industry.

Q All right, let's just call it a ribbon. The Eaton

Allen Company sold a ribbon made of your Filmon material?

A They sold a ribbon made of our material, that is correct.

Q It was a half-inch long?

A I don't know. It could have been, yes.

Q And it was the size and length that would fit in a typewriter, wasn't it?

A It could have been put in a typewriter. It could have been put into a computer. There is no way of knowing actually what half-inch tape is going to be used for.

Q Shortly after they put it on the market they took it off the market again, didn't they?

A I have heard that they did, yes.

Q And that was because as the keys hit the film backing the two layers, instead of lying flat against each other, bulked and formed, you might say, a tube instead of a pair of flat ribbons?

A I have no such evidence.

Q You never heard anything like that? You never heard that your ribbon is guilty of this bulking?

A I have heard during its early inception that such a problem did arise, yes; at its early inception.

Q And when it bulked it jammed the guides of the

typewriter, didn't it?

A It may have. It may have, yes.

Q Then as it bulked it became thicker as it wound up on the spool of the typewriter and the typewriter wouldn't reverse itself, is that correct?

A If it happened on a typewriter, I don't know. You are making statements as to what machines they were used on, sir. Again let me just point out that a typewriter ribbon, which is half-inch wide, can be used on a computer. I don't know if it was used on a typewriter or not. We don't have knowledge of where our ribbons basically sometimes are used in regards to what the final application is as to machinery.

Q Do you know a Mr. Nagy down in Philadelphia?

A Yes, I do.

Q He put your ribbon on the market for a typewriter, didn't he?

A I believe he was probably one of the first, yes.

Q And didn't he find out about this bulking after he had sold a few ribbons and then he complained to you about the bulking?

A Well, you might say it was a complaint, but actually what he did do was to perform a very valuable service in discovering for me that there was such a thing as defective film.

I believe the instance that you are referring to dealt specifically with a batch of film that we had received during this infancy production that we were going through where this condition could have arisen, yes, or did arise.

Q Well, as a matter of fact, during the earlier years up to 1963 you had reached a peak of where you were selling \$15,000 worth of this material a year, isn't that correct?

A It may be correct. I am sure the figures indicate. I don't know what the figures are, Mr. Hall.

Q By 1963 your total sales had fallen off to just a little over \$1,000 worth of this material a year?

A That very well may have been, yes.

Q And the biggest customer that you ever had for this material was Spellright?

A It's very conceivable. Yes, it's very possible. I believe the records might show that, yes, that is right.

Q And is Spellright the smallest typewriter ribbon company that you know of?

A I wouldn't think so, no. There are many, many typewriter ribbon companies. I don't know. It's possible. He may be or may not be. I don't know the true facts.

Q During the early stages of your invention didn't

you submit a sample or cause a sample, directly or indirectly, to be submitted to IBM?

A I never -- or I should say I or my companies never directly deal with IBM in regards to supplying them with samples or cloth. I have had discussions with them from a technical viewpoint. I have been called in on certain problems they may have had with all their types of ribbons. But any of our companies have never, to my recollection, supplied IBM directly with any of our products. Anything that goes to IBM as far as I know goes through a middle man, who then sells our manufactured ribbon to IBM.

Q I'd like to hand you Plaintiff's Exhibit 9, which is this ribbon you say was put out by Remington Rand, and I notice that on the box you have marked or there is marked the words U.S. Patent 3,010,559, and I want to ask you whether you put that marking there or whether Remington Rand put that marking there?

A If I put that number on there? Would you repeat that question, please?

Q Did you put that marking there or did Remington Rand put it there?

A Remington Rand put it there, as well as the Filmon and Nylex. In other words, this is all Remington Rand's work.

Q How did it come they put your patent number on the

ribbon?

A Excuse me?

Q How did it come about that --

A Because we have insisted that all inkers use our patent number. It is an inked product.

MR. HALL: Well, let's mark a ribbon Defendants' Exhibit 5 for identification.

(Ribbon marked Defendants' Exhibit No. 5 for identification.)

BY MR. HALL:

Q I hand you this ribbon which has been marked Defendants' Exhibit 5 for identification and ask you if that is a box of the type that Old Town Company used in marketing your ribbon?

A Yes, it is.

Q Do you find your patent number on that box?

A No, I don't. I am familiar with the box.

Q How long did Old Town sell your ribbon?

A I am not sure they ever sold it.

Q Well, how come they have a box?

A Well, printing a box and selling a ribbon are two different things. They may have started a program whereby they wanted to sell the product. They probably printed up their

boxes. Most inkers have their own printing plant. It is a very easy thing for them to go out and print these boxes. And they may for some reason not have gone into the sale of the product. I don't know what the reason was. But I am not aware at all that the ribbon was sold commercially.

MR. HALL: I have another ribbon which I ask be marked Defendants' Exhibit 6 for identification.

(Ribbon marked Defendants' Exhibit
No. 6 for identification.)

BY MR. HALL:

Q I will show you this and ask you if this is the box and container that Mr. Nagy used when he marketed your ribbon?

A Yes, I believe I have seen a container like this.

Q He actually had your ribbon on the market and was selling it, is that correct?

A He had it very, very early.

Q And he continued to sell it after your patent had issued?

A I believe he did, yes.

Q Do you find your patent number on that box?

A No, I don't believe so. I am aware of the box, I have seen it.

Q Now your patent discloses a ribbon which is a half-inch wide or any other suitable width, but at any rate it's all one color as it's shown in the patent. You don't show a two-color ribbon in your patent, do you? I mean your patent in suit.

A Would you show me a copy, sir, and I will just make sure that it doesn't show a two-color ribbon. (Pause)

No, it doesn't show a two-color ribbon.

Q You say that the FAA has used your invention. You didn't tell us exactly, though, what they used so that we could tell whether it was your invention or not. So, could you tell us what it was that you sold to the FAA that you contend embodies your invention?

A Mr. Hall, we did not sell to FAA. I indicated earlier that FAA uses our products. I have no contact with the United States Government or with anyone else directly, in most cases.

Q How did they get it, then?

A They bought it from an established inking company.

Q Are you able to tell us how this FAA ribbon was constructed, so that Judge Holtzoff can decide whether it comes under your patent or not?

A Yes, certainly. Well, let me say this, a sample

of a ribbon of our invention, of the patent in suit, was left with Judge Holtzoff yesterday. It was roughly three-quarters of an inch wide. That ribbon is almost identical, except for the fact that there is ink in it, as to width, is, I believe, the type of ribbon that FAA uses. I believe even possibly it is as much as 200 yards in length.

THE COURT: Nothing was left with the Court. I think a piece of ribbon was handed to the Court and left on the bench.

THE WITNESS: I was referring to the spool.

THE COURT: They were not handed to me personally; they were introduced in evidence.

THE WITNESS: That is the best I could describe it at this time as far as how it looked, except obviously there was no ink in the sample that we presented.

BY MR. HALL:

Q When did the FAA use your invention?

A Mr. Hall, to my best recollection, I became aware of FAA using our invention practically, I would say, at its inception.

Q How long did they continue to use it?

A They are still using it.

THE COURT: I think this might be a good time to

suspend for the day.

I am not attempting to hurry anyone, but just to get an estimate, about how much longer will your cross-examination be?

MR. HALL: An hour.

THE COURT: And you have one more witness, I

believe you said?

MR. ROBSON: I have one more witness on direct,

who will be about 30 to 45 minutes.

THE COURT: And then how long will the defense be?

MR. HALL: We might finish tomorrow afternoon.

THE COURT: I hope we can finish tomorrow, anyway,

with the testimony. I shall be happy to hear an oral summing

up. I always am more benefitted by an oral summing up than by

briefs. Of course, you won't need your respective clients

for the summing up, so if we don't finish tomorrow you can sum

up Thursday morning, if that would be agreeable.

MR. ROBSON: That would be fine.

THE COURT: Is that agreeable to both sides?

MR. HALL: I don't know what you want to do about

this, you will recall about a month ago I appeared before you

as a preliminary matter and asked that a very important case

involving some \$20 million be set for a hearing before Your

Honor at the earliest possible date. I don't know whether you

recall that or not, Illinois Scientific Development v. Honeywell, and my client is extremely anxious that that be heard and it was reset before Judge Sirica on the morning of the 5th, but if we are still going and Your Honor wants us to continue here I could have someone else from my office take care of that.

THE COURT: Yes, I would like to finish this case without interruption, so far as I can.

MR. HALL: All right. Well, I will arrange for somebody else to take care of that motion, then.

THE COURT: That was a motion that you and Mr. Roger Robb were in?

MR. HALL: That is right. You remember it is a question whether the case will be in Minnesota or down here. Judge Nordby has not rendered any decision yet and I was hoping that you would get it and render the decision for the District of Columbia so that we would be represented by our most eminent judge on that point. You remember it was a very difficult and important thing.

THE COURT: Well, you are very flattering. I think I would like to finish this up. Of course, if necessary, you could have that motion continued for a day or two.

MR. HALL: My client would die if I did that.

THE COURT: I see. Very well.

(At 4:00 p.m. trial stood in recess, to reconvene 10:00 a.m., October 4, 1967.)

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,

Plaintiff,

v.

Civil Action 1514-63

SPELLRIGHT CORP.,
WILLIAM H. WOLOWITZ,

Defendants.

Washington, D. C.

October 4, 1967.

The above cause came on for further trial before
THE HONORABLE ALEXANDER HOLTZOFF, United States District
Judge, at 10:00 a.m.

Appearances:

For the Plaintiff:

MORTON S. ROBSON, ESQ.,
EDWARD C. GONDA, ESQ.,
IRVIN A. LAVINE, ESQ.

For the Defendants:

WILLIAM D. HALL, ESQ.

I N D E XWITNESSESDIRECT CROSS REDIRECT RECROSS

PLOEGER, Walter Jr.
(resumed)

327 372 383

JACOBS, Estelle

387 398

SEIDEL, Arthur H.

413 453

EXHIBITSIDENTIF. IN EVIDENCE

Plaintiffs:

16 -

324

17 -

324

18 - List dated July 3, 1963

402

412

19 - Letter Oct 4, 1961 from Mr.
Seidel to Mr. Montague

417

417

20 - Letter Oct 18, 1961 from Mr.
Montague to Mr. Seidel

417

417

Defendants:

7 - Allied Chemical Corp. adver-
tisement

336

336

P R O C E E D I N G S

THE COURT: We will resume the case on trial.

Before we continue with the testimony, Mr. Hall, you called my attention to the fact yesterday that you were scheduled to argue a motion in the motions branch of the court in a rather important case tomorrow morning. I recall that some weeks ago I denied your application to change the date of that motion, so I feel that I ought to try, if I can, to extricate you from that predicament. How long would it take to argue this motion?

MR. HALL: Two hours, but I have arranged for another attorney to get prepared and argue the motion.

THE COURT: I mean if you argued how long would it take?

MR. HALL: Two hours.

THE COURT: As long as that?

MR. HALL: Well, it is scheduled for an hour each way. That is why it's on the long motions calendar.

THE COURT: I was thinking if it was the kind of a motion that could be argued in a half-hour or an hour I would ask Judge Sirica to hear your matter first and excuse you for that time. I didn't realize it was likely to be as long as two hours.

MR. HALL: It is a very complex motion and a very important and complex case. It involves an electronic computer patent that is about that thick.

THE COURT: I realize that you are in a position where you do not want a lengthy continuance. What is the nature of the motion?

MR. HALL: It is a motion to transfer. Two suits were filed on the same date, one a declaratory judgment suit was filed by them against my client in Minnesota.

Your Honor, could I explain one thing. I have arranged for another attorney to argue the motion. He is new in the case, he hasn't seen any of the papers. I would prefer to be there, so if he has a question, I could answer it.

THE COURT: If you prefer to be there you might as well argue the motion yourself.

MR. HALL: No, I can't take the time today to prepare to argue the motion.

THE COURT: I was going to make this suggestion: I can arrange, if agreeable, to have the motion continued for a day or two.

MR. HALL: No, my client would die if I did that.

THE COURT: Even for one day?

MR. HALL: Right.

THE COURT: Well, I am sorry. I think that is a

little bit unreasonable on the part of the client. In other words, I would be very glad, myself, to request the judge sitting in motions court to continue it to Friday. It is set for Thursday, to continue it to Friday, because by that time you would be free from this case. However, if you prefer I shouldn't do it, I shan't.

MR. HALL: I don't think so because I have arranged for another lawyer to do it. I wouldn't even be able to say that he would be available on the other date.

THE COURT: I am willing to do this: I am willing to myself ask to have the case continued for a day because by Friday you will be through with this case. If you don't want me to do it there is nothing else I can do.

MR. HALL: That is right. I think the best thing to do is for us to let it go as it is, and I have arranged for this other lawyer to handle it.

THE COURT: Very well. I don't think I can go any further than just offer to try, myself, to arrange for a day's continuance.

MR. HALL: I thank you for your courtesy but last night I arranged for this other thing.

THE COURT: Very well.

MR. HALL: Your Honor, I would like to make a motion

and that is, I asked opposing counsel this morning if he would be so kind as to go through all of these various exhibits that they have offered and tell us which ones they charge to infringe, so as to narrow down the issues.

THE COURT: Which ones they do what?

MR. HALL: Which ones they charge to infringe and which ones they admit they are not accusing us in this law suit, and which sales or other acts they claim were the false marking, so I can restrict my case from here on out to those things; and he has declined to do it. It would certainly save a lot of time if you would direct him --

THE COURT: I am not quite clear as to what your request is.

MR. HALL: They have put in a lot of different ribbons. They have put in this ribbon; do they charge this ribbon to infringe in this law suit or not?

THE COURT: Do they charge it with what?

MR. HALL: Well, is it one of the ribbons that they have charged us with infringement on.

I would like for him to go through all of the ribbons that he has put in evidence, the four or five that he has got here, and tell us which ones he says that he is relying on as being an infringement.

THE COURT: I think that is a reasonable inquiry.

What do you say about that, Mr. Robson?

MR. ROBSON: I refrained from making any statement on that matter, if Your Honor please, because I believe the testimony was clear and I am not sure that I am prepared --

THE COURT: I understand. Now the Court asks you, because the Court has to know, as to which ribbons, giving their exhibit numbers, you claim are infringements. That is a simple question and a perfectly reasonable question. In fact, the Court would have asked you that question *sua sponte* at some time or another.

MR. ROBSON: I believe it was clear. The witness, Mr. Ploeger, Jr., testified that Exhibit 10 --

THE COURT: I haven't asked you as to who testified to what. I asked you which of these exhibits you charge with being infringements of the patent in suit.

Now if you want to take a few moments and consult with your associates you may do so.

MR. ROBSON: There is no problem, sir. Exhibit 10 and Exhibit 17.

THE COURT: Exhibit 10 and Exhibit 17 are charged with being infringements?

MR. ROBSON: Yes, sir.

THE COURT: And that is all?

MR. ROBSON: That is all that have been introduced, yes.

THE COURT: Very well. May I see them?

MR. ROBSON: Exhibit 17 had not yet been offered, through inadvertence. I would offer it now.

THE COURT: Offer it now, if you wish.

MR. ROBSON: Here is 16.

I am not offering the other one, which was just a demonstration.

MR. HALL: What is 17?

MR. ROBSON: 17 came from you.

(Plaintiff's Exhibits Nos. 16 and 17 for identification were received in evidence.)

MR. ROBSON: Just one slight modification. Exhibit 10 was the box in which the ribbon came in. The ribbon itself is Exhibit 11.

THE COURT: 11 and 17?

MR. ROBSON: Yes, sir.

THE COURT: Very well. I believe you were cross-examining Mr. Ploeger, Mr. Hall, were you not, when we recessed?

MR. HALL: Yes.

MR. ROBSON: If Your Honor please, may I hand up to the Court an original and one copy of our trial brief.

THE COURT: Surely.

MR. ROBSON: I am handing a copy to Mr. Hall.

THE COURT: I think I only need the original.

MR. HALL: Your Honor, I don't think I got a complete answer to my question. There were two parts to it. The second was for them to designate all of the acts of false marking that they thought they had established. You see, at least some of them I gather they don't contend there is anything --

THE COURT: Will you state again what additional information you request?

MR. HALL: The second count of the complaint is for false marking and I would like for them to tell us which acts or --

THE COURT: I assume that the false marking charges relate to and is limited to the leaflets that accompanied these ribbons?

MR. ROBSON: Yes, sir.

MR. HALL: I further gather that their charge of false marking is only limited to the pieces of literature that

were sent with the ribbons that they accuse to infringe, namely, those two exhibits.

THE COURT: That is the extent of the damage, but the cause of action is that leaflet.

MR. ROBSON: Yes, sir.

THE COURT: Now, of course, that statute has an ambiguity in it. It is a statute calling for a penalty of \$500 for every such offense.

I presume there is only one offense because there is only one leaflet. In other words, each copy of the leaflet you don't contend is a separate offense, do you?

MR. ROBSON: As I understand the cases which have interpreted the statute, they do not claim that each ribbon or each marking is a separate offense, but there have been cases holding that each shipment of a group constitutes one offense.

THE COURT: Well, I think we won't take that up at this time because that is on the issue of damages, which we haven't reached.

I understand the false marking charge is limited to the phraseology of the leaflet.

MR. ROBSON: Yes, sir.

THE COURT: Very well. I think that crystallizes

the issue.

MR. HALL: Thank you, Your Honor.

May Mr. Ploeger resume the stand.

WALTER PLOEGER, JR.

resumed the witness stand and was examined and testified further as follows:

(CROSS-EXAMINATION Cont'd)

BY MR. HALL:

Q Yesterday we discussed the meeting in December 1961 between you and Mr. Wolowitz. At that time and prior thereto were you processing your material, namely, the nylon ribbon with the film backing, for the Spellright Company?

A Was the question prior to our meeting? You said prior to?

Q Yes.

THE COURT: Suppose we have the question read.

(The Reporter read the last question.)

A Prior to meeting Mr. Wolowitz we did not manufacture the ribbon for Spellright, no.

Q I am speaking of the meeting in December of 1961. Prior to that time had you been shipping him your nylon ribbon with the nylon backing?

A I am not quite sure, but our records will indicate

it. I don't recall at this time.

Q Suppose I show you a record which may refresh your recollection. I won't mark it as an exhibit unless somebody asks me to.

A Yes, sir, Mr. Hall, I think I have read this.

Q Are you now prepared to say that you were making shipments to Spellright prior to the meeting you had with Mr. Wolowitz in December of 1961?

A I don't recall a meeting. I don't know what meeting of December '61 you are referring to. I don't believe we had a meeting December of '61. I don't recall any such meeting.

Q Well, isn't that the meeting at which you claim to have disclosed some trade secret to him in confidence?

A Well, it may have been in November also. I am not absolutely certain it was early December. It could have been late November, early December. I am not quite sure. It may have been in November also.

Q All right.

A I don't want to pin it down to exactly November --

THE COURT: You have answered the question.

BY MR. HALL:

Q Prior to that meeting had you been shipping your material with the nylon ribbon with the nylon film backing to

the Spellright Company?

A Mr. Hall, the only way I can answer you is to repeat what it says on this shipping ticket. This is a Schwarzenbach-Huber invoice and from what I see here it was delivered to Spellright by the Schwarzenbach-Huber Company.

Q In October?

A Well, one is marked paid -- let's see. Terms, ten -- I don't know when it was shipped here. I see when it was paid, when you paid your bill, but I don't see exactly what date it was. Do you see a date on here, Mr. Hall?

Q Yes.

A I would be happy to -- well, that just says 10-27. All right. What does this mean? 10-24-61, that is what it says. That is the date of the invoice. I don't know if the goods were shipped that date.

Q Are you prepared to say that you have been shipping your material, the nylon ribbon with the nylon film backing, to the Spellright Corp. prior to the beginning of the year 1962?

A The same answer must prevail. The shipment of ribbons was made by Schwarzenbach-Huber to the defendant, Mr. Hall. That is the only way I can answer the question. We do not from our place directly, so to speak -- it was not our cloth. It was shipped to the defendant by Schwarzenbach-Huber.

it was their material.

Q And you mean that it wasn't shipped by you, that the shipping company didn't come to your place of business and get the material and take it away?

A They may possibly, yes. They also may have possibly picked it up from the Schwarzenbach-Huber warehouse. Either case may have prevailed.

Q Did any of the material that you processed for Spellright/^{go}from your place of business to the Schwarzenbach-Huber warehouse before it went to Spellright?

A It's possible that that could have happened, certainly.

Q But you don't know of any that did, do you?

A I am not sure if any did, no. I am not sure. It's very possible.

Q But you do know that you shipped some directly from your place of business to Spellright?

A Mr. Hall, it's very conceivable that on direction of the Schwarzenbach-Huber Company that a shipment of this material was made to Spellright; that is correct. From our plant; right.

Q Are you telling this Court that all of the shipments to the Spellright Company of your material with the nylon film

backing on the nylon ribbon had a label on it similar to Plaintiff's Exhibit 8, with the words U.S. Patent 3,010,559?

A It had such a label affixed to the package, that is correct. All our Filmon material, regardless of where it goes, is supposed to have a label.

THE COURT: Confine yourself to answering the question.

Suppose you read the question and we will get a definite answer.

(The Reporter read the last question.)

THE WITNESS: Every package --

THE COURT: Just answer yes or no.

THE WITNESS: Yes, sir.

BY MR. HALL:

Q The Filmon Process Corp. wasn't formed or incorporated until the year 1962, is that correct?

THE COURT: Mr. Hall, may I make this inquiry. Aren't you now entering the realm of damages?

MR. HALL: No, Your Honor; I am trying to impeach the witness and show that he is not a credible witness.

THE COURT: Well, you have a right to do that. I thought you were trying to establish which goods were marked and which were not. That goes to the issue of damages.

BY MR. HALL:

Q The Filmon Process Corp. was not formed until the year 1962, was it?

A That is correct.

Q Then how does it come about that you had a label with the name Filmon Process Corp. on it that was used in connection with shipments made in 1961?

A May I see that label, sir?

Q What's this?

A May I see the label that you are referring to?

Q Yes.

A May I point out to you, Mr. Hall, that a small gum tape type of label was added to the bottom of this particular label that you have here, for a very good reason, because these labels are now presently being used and have been used since this corporation was in effect. So, you will see that the bottom portion of this label is strictly an additional gum tape label.

THE COURT: I don't think you are answering the question, Mr. Ploeger.

THE WITNESS: Would you repeat the question, please?

THE COURT: Suppose you repeat your question or ask another.

MR. HALL: I will ask another. I forget what my question was.

MR. ROBSON: If Your Honor please, could we have that question reread for the witness?

THE COURT: I am suggesting to Mr. Hall that he either repeat the question or ask another.

MR. HALL: I will ask another.

BY MR. HALL:

Q How many years did you attend Syracuse University?

A One year.

Q And Brooklyn Polytech Institute?

A Oh, during night courses, about roughly a year also.

MR. HALL: May I have the deposition of Mr. Ploeger, Sr.? I am not going to read from this deposition, I just want the exhibit.

Q I have here a document which has been marked Ploeger Jr. Deposition Exhibit No. 13 and I ask you to look at it and tell us what it is.

A This is an Allied Chemical, General Chemical Division, ad, I imagine you would call it, advertisement, ad.

Q And it states that Filmon Process Corp. uses the Allied Chemical Capran brand as the backing for your ribbon, is that correct?

A Well, we can read the whole thing, if you would like. Let me just read it and then I may agree with you.

Mr. Hall, would you, maybe, to save time, pick out where it says that?

THE COURT: Would you read the question, please?

(The Reporter read the last question.)

THE WITNESS: I am not sure, to answer that. If I can read it or if you will show it to me, I would agree with you.

BY MR. HALL:

Q You look at it and see if it doesn't in effect say that.

A Shall I read the whole ad, Mr. Hall?

THE COURT: Don't read it out loud; just read it to yourself.

(Pause.)

A Yes, it seems to say that Capran film is used.

Q And this piece of literature was published by the Allied Chemical Company in a nation-wide magazine?

A I don't know that it was, no.

Q And you had a number of reprints of this page and handed them out to customers, including Mr. Holowitz?

A Only to Mr. Holowitz.

Q I would like to show you your deposition at page 167 and ask you to look at your deposition, first. We won't bother to read from it. Then tell us whether this refreshes your recollection as to whether prior to this deposition this piece of literature, Ploeger Deposition Exhibit 13, had been published in a trade magazine.

THE COURT: Just a moment. Have you offered this in evidence?

MR. HALL: No; this is his own deposition.

THE COURT: I understand, but did you offer that exhibit in evidence? Because I can't consider this examination concerning this exhibit unless it becomes in evidence in this case.

MR. HALL: What is our next number?

THE DEPUTY CLERK: 7.

MR. HALL: I will ask this be marked Defendants' Exhibit 7, and the thing I am asking be marked is Ploeger Deposition Exhibit 13.

THE COURT: Are you offering it in evidence?

MR. HALL: All right, I will offer it.

THE COURT: Have you got a loose copy of it, by any chance?

MR. HALL: No, Your Honor.

MR. ROBSON: We have a loose copy, if Your Honor please.

THE COURT: Thank you.

(Allied Chemical Corp. advertisement marked Defendants' Exhibit No. 7 and received in evidence.)

THE COURT: Now you may proceed.

THE WITNESS: I have read the --

THE COURT: Now you may proceed.

BY MR. HALL:

Q Are you willing to admit that this document, Defendants' Exhibit 7, was published in a trade magazine prior to the time that you gave your deposition in this law suit?

A Mr. Hall, it may have been; it may have been. I am not sure. I think I indicated that in my deposition here.

THE COURT: You say you are not sure. Then that is enough.

THE WITNESS: That was my first answer. I am not sure when it was published exactly, if it was published.

Q But prior to your deposition you had handed a copy to Mr. Wolowitz?

A Oh, yes, that is correct.

Q So, therefore, at least so far as Mr. Wolowitz is

concerned, the material that is in that leaflet was not a trade secret any more, is that correct?

A It all depends on what you consider a trade secret. What do you consider a trade secret?

THE COURT: It is not what defendants' counsel considers a trade secret, it is what the plaintiff's counsel contends was the trade secret that is the crux of that count.

MR. ROBSON: I think that is also a question of law, if Your Honor please.

THE COURT: Well, I understand, but before the Court can decide a question of law the Court has to be informed as to what the plaintiff claims was the trade secret.

Perhaps we might interrupt a moment and inquire of plaintiff's counsel as to what plaintiff's counsel claims was a trade secret.

MR. HALL: Your Honor, perhaps -- oh, you are asking him. I am confused. Excuse me.

THE COURT: It is for the plaintiff to state what he contends.

MR. HALL: I don't think this has anything to do with the trade secrets --

THE COURT: Very well, then I will ask that question later on. You may withhold your answer.

MR. ROBSON: Fine, sir.

BY MR. HALL:

Q Mr. Ploeger, I would like to confront you with page 146 of your deposition and I will ask you if you gave the following testimony. Did you testify in this form:

"Q I say it is your understanding that the defendants purchased their film from the same source that you do.

"A That is my understanding.

"Q Yet you object to telling us who the source is?

"A That is correct."

And then I go on down and ask opposing counsel if he is willing to let him so testify.

Now I would like to also read at pages 74 and 75 of the deposition:

"Q You processed their material to make these samples?

"A That is correct.

"Q You did that prior to March 22, 1961?

"A I am not sure.

"Q Was the film for these samples supplied by Schwarzenbach-Huber?

"A No.

"Q Who supplied that?

"A I think it is a sensitive area that has to do with our trade secrets."

And then over at the top of page 75:

"Q Where did you get the film from that you made the samples from?

"A This again deals with a sensitive area."

Now did you so testify?

A Yes, sir.

Q In other words, during the first day of the taking of your deposition you refused to tell us the source of this film on the ground that it was a trade secret?

THE COURT: Mr. Hall, this speaks for itself.

Q Why is it that you refused to answer and tell us what your source was when the source had been already given to Mr. Wolowitz in that printed leaflet?

A The trade secret aspects still prevail. The source is not so important. It is the material.

Q Well, doesn't the --

THE COURT: As I understand the issues of the second count -- I think I am going to interrupt this cross-examination in view of the turn it is taking and redirect my

question to plaintiff's counsel.

I understood from the reading of the second count and of the direct testimony of this witness that the trade secret consisted of one particular aspect of the process and not of the names of the source of supply.

MR. ROBSON: Your Honor is absolutely correct. The only thing involved is the process of welding down the middle.

THE COURT: Very well.

MR. HALL: Your Honor, the only thing I am bringing this up for is on the question of credibility.

THE COURT: Yes, I know, but the extent of cross-examination as to credibility is within the discretion of the Court and I think we have taken enough time on that.

MR. HALL: All right.

BY MR. HALL:

Q Is it a fact that the ink carrying nylon ribbon that you use in your patented invention must have a special treatment in order to render it absorbent?

A It's possible that such treatment is necessary, yes.

Q Ordinary nylon is not absorbent, is it?

A Absorbent to what, Mr. Hall?

Q Ink.

A Per se, nylon is not. Nylon is not, no.

Q Can you tell us by just looking at a piece of nylon ribbon whether it has had the special treatment that is required to make it absorbent?

A Just by looking at it?

Q Yes.

A Well, what do you mean by looking at it, exactly? I don't know quite what you mean by looking at it.

Q What tests do you have to run on a piece of nylon ribbon to tell if it has had the process which is required to make it absorbent?

A There are many technical tests.

Q Have you made any of them on the ribbon of the defendant that you charge to infringe?

A No, I did not, not the test that I just indicated, no, not the test for finishing, no.

Q When your patented ribbon is used on a typewriter and the key strikes your film backing, does it force some of the ink from the reservoir toward the piece of paper on which you are attempting to write?

A That sounds logical; yes.

Q Well, would you explain this action in a little more detail, the action as you understand it, of course?

A What action was that, please?

Q The forcing of the ink from the reservoir to the surface of the ribbon.

A Well, it's a very simple action in that a type key impacts the ribbon which contains ink and in that exact area the impression is made on the paper and there is release.

Q In connection with your invention some of the ink is stored in the reservoir, is that correct?

MR. ROBSON: If Your Honor please, I don't know what the word reservoir means. I have never heard the word used so far in this case. I don't know what Mr. Hall refers to.

THE COURT: I don't like to have interruptions except for objections.

MR. HALL: All right, I will clarify that for you, Mr. Robson.

BY MR. HALL:

Q Mr. Ploeger, you have used the term in the past that a reservoir is formed between the nylon film and the nylon film backing in your invention, is that correct?

A Yes, sir, that is correct.

Q And that is what we are talking about when we talk about reservoir.

A I understand that, yes.

Q Now my question is, when the type strikes the backing does it force some of the ink out of this reservoir into the writing portion of the ribbon?

A Let me say this: When impact is made against the ribbon ink is forced onto the paper and an impression is made, certainly. That is the only way any printing ribbon works.

Q You mean yours works the same as all the rest in that respect?

A As far as the impact, the key hitting the ribbon is concerned.

Q Is it true, then, that there is no special action involving flowing of ink within your ribbon that doesn't occur in any ordinary ribbon?

A Would you repeat that question, please?

THE COURT: Let's have it read, please.

(The Reporter read the last question.)

A Mr. Hall, I don't quite understand your question. If you would rephrase it, I would appreciate it. It is not too clear.

Q Is it your understanding that when the type key strikes the backing of your ribbon, that the ink flows from one place to another in your ribbon?

A At which time, Mr. Hall? I don't know exactly at which time are we talking now.

Q At the time or immediately thereafter that the type face of the typewriter key hits the backing of your ribbon.

A Well, my answer is similar to what we had testified to earlier, that the theory here is that as soon as ink is removed from that area --and it's a very instantaneous process-- that as soon as the key releases itself from that impact we have this unexplained replenishment of ink in that depleted area. That is the best that I can describe it, Mr. Hall. I can't possibly give you a better answer.

Q Very well, that is what I wanted, to hear your view on that.

Now is it your view that that action is something different from what happens in an ordinary typewriter ribbon when it is struck by the type bar of the typewriter?

A Is it different, did you say?

Q Yes.

A Yes, it is different.

Q In order for this ink to flow back, as you say it does --

A Mr. Hall, may I just say this to you. I mean, just to qualify my last answer. When I say it is different, it is

different in this rapid recovery. Obviously, the reaction on any ribbon is going to be the same. So, please understand when I say it is different I only mean different in its rapidness of replenishment. Just to clarify that answer.

Q Well, you admit there is a replenishment in an ordinary typewriter ribbon, don't you?

A What do you mean again by replenishment? It's a degree. I think that is why we feel we got an invention, because there is this degree.

Q Well, then, do I understand you that if somebody had a ribbon that did not have this replenishment, replenishment action, that he would not be embodying your invention?

A Would you read that question?

THE COURT: Suppose we have the question read.

(The Reporter read the last question.)

A Mr. Hall, I don't understand what you mean "doesn't have this replenishment action." I don't understand your question.

Q You say your ribbon has this replenishment action, don't you?

A A ribbon of my patent does, yes, sir.

Q Now if somebody had a ribbon that did not have this replenishment action would you say that he was embodying your

invention?

A Mr. Hall, I don't know anything about any other ribbons at this particular time. It is a very hard question to answer. I am concerned with my ribbon, I know what that will do in that respect.

THE COURT: I think this is a speculative question.

BY MR. HALL:

Q Have you made any test to determine what kind of ink that Spellright uses in the ribbon which you charge to infringe?

A No; I was not concerned with their ink.

Q As a matter of fact, so far as you know it might be a thick paste.

A I hardly think so.

Q You claim to have purchased a Spellright ribbon from Abraham & Strauss in May or June of 1963, is that true?

A Yes, sir.

Q After you purchased this ribbon how long did you retain it in your possession?

A I am not sure, Mr. Hall. It's a long time ago. I really don't know. I honestly can't answer how long I had it in my possession.

Q Well, was it on the order of a day or a week or a

month or a year?

A Mr. Hall, I honestly cannot answer that question. It's been a long time, I have seen a lot of ribbons since, and honestly I don't know.

Q When you came into the court this week your attorney showed you a ribbon and told you that this was the A&S ribbon, is that right?

A That is right.

Q And you hadn't seen that ribbon for years, had you?

A That is correct.

Q And you had seen all kinds of other ribbons in the meanwhile, hadn't you?

A Right.

Q How are you able to say that that is the A&S ribbon when you have seen so many others in the meanwhile?

A Well, first of all, I believe it was tagged as an exhibit from either the deposition or otherwise, and then I think I was shown the ribbon. In other words, let me just clarify what I just said. I believe, it is my belief that when I was handed that particular sample that it was identified as a former exhibit and already identified as being the ribbon that I bought there.

Does that answer your question?

Q Yes.

A Basically speaking, my first, initial view of it indicated to me that I had purchased it at A&S, yes, sir.

Q But it was not marked as an exhibit during your deposition, was it?

A I don't know if it was or not. I don't recall that. I know many, many exhibits were tagged at my deposition. I completely lost track of how many there were but there were an awful lot.

MR. HALL: Maybe opposing counsel is willing to stipulate that the ribbon which he has identified in the court was not an exhibit at the Ploeger deposition. Are you willing to agree to that?

MR. ROBSON: Which one is that?

MR. HALL: Well, I guess it's your Exhibit 11.

MR. ROBSON: May I see it?

THE COURT: It doesn't bear any markings showing that it was attached to the deposition.

Which exhibit are you referring to?

MR. HALL: The ribbon that he claims to have purchased from Abraham & Strauss.

THE COURT: But which exhibit number?

MR. HALL: I think it's 11, isn't it?

THE COURT: There is no showing or no indication on the exhibit that it was marked or identified at the taking of the deposition.

MR. ROBSON: If Your Honor please, may I have the exhibit?

THE COURT: Yes, indeed.

MR. ROBSON: If Your Honor please, I was not present at the deposition but I am advised by co-counsel, and have been in the preparation of this case, that the identifying tags, which in this case says P-13, identifies this as Plaintiff's Exhibit 13 during the course of a deposition.

THE COURT: It doesn't follow from that that this was marked at the taking of the deposition, Mr. Robson.

MR. ROBSON: The point is that I will not stipulate with Mr. Hall that this was not used.

THE COURT: I think we better move along because I don't think this is very important.

MR. HALL: Could I get one further fact from Mr. Robson, that the marking Deposition Exhibit 13 that appears on the ribbon is from the Wolowitz deposition?

THE COURT: Mr. Hall, so far as the Court is concerned, I think it is immaterial whether this was marked at the taking of the deposition or not.

MR. HALL: Well, we are quite serious in our belief that Mr. Ploeger has switched some things on us in connection with this charge of infringement and we would like to have the opportunity to prove it, that he does not have any basis for saying that that is the --

THE COURT: I understand. My observation was limited to the question of the materiality of its being marked or not marked at the taking of the deposition.

It doesn't show any mark, doesn't bear on its face any marking as of the taking of the deposition because this tag is an anonymous tag. If it was marked at the taking of the deposition by the notary that was taking the deposition he would have either put his initials or some other indication that it was marked at the taking of the deposition. That is the practice among the notaries in this District, Mr. Robson.

MR. ROBSON: May I express, if Your Honor please, my objection to the remarks of counsel? This is the second time now that he has accused the witness of --

THE COURT: Well, of course if this was a jury trial you might be entitled to a mistrial, but those things don't affect the Court.

MR. ROBSON: But I know how the witness must feel hearing himself called a liar.

THE COURT: Those things don't affect me unless they are supported by evidence.

I think perhaps Mr. Robson does have a grievance. I think remarks such as that should not be made in open court.

MR. HALL: I will withdraw the remark, but I was just trying to tell Your Honor why we were pursuing this line of cross-examination. The reason I made the remark was, I thought you had indicated that this line of examination amounted to nothing and I wanted to explain to you that it is important.

THE COURT: In other words, you are not sure that Plaintiff's Exhibit 11 was the one that was actually purchased from Abraham & Strauss?

MR. HALL: We are far from sure of that and we have denied it in our pretrial statement.

THE COURT: Again, doesn't that go to the issue of damages?

MR. HALL: No, because they have to show us what it is that they charge to infringe.

THE COURT: They charge Plaintiff's Exhibits 11 and 17 with being infringing articles. All they have to prove in order to make out a prima facie case of infringement is show a single act of infringement. They claim they have shown

two acts which they contend constitute infringement.

Do you admit, Mr. Hall, that Plaintiff's Exhibit 17 comes from --

MR. HALL: Yes.

THE COURT: Then anything relating to Plaintiff's Exhibit 11 might go to credibility, but so far as a prima facie case is concerned, the Court would have to determine whether Exhibit 17 does or does not infringe the patent, assuming it is valid, of course.

MR. HALL: Yes.

THE COURT: I don't think we ought to spend too much time on this. I am not trying to cut you off, but I do hope you can come to a conclusion fairly promptly.

MR. HALL: All right. I am going to limit myself to the hour that I promised and if I have any further --

THE COURT: I never hold counsel strictly to a prognostication of time because they are apt to be erroneous.

MR. HALL: If I have any further matters I will call Mr. Ploeger as my witness.

I want to get these religious people off today.

THE COURT: Mr. Wolcwitz is affected by that. Anyone else?

MR. HALL: Mr. Wolcwitz has said that he will be

here tomorrow, but Mrs. Jacobs --

THE COURT: I thought it was Mr. Wolowitz who wouldn't be available.

MR. HALL: Mrs. Jacobs is very insistent that she can't come tomorrow, so I am going to have her on this afternoon, if that is all right with you.

THE COURT: How long will the testimony take?

MR. HALL: A half-hour.

THE COURT: I want to be sure that we get through with the testimony of any witness that can't be here tomorrow.

MR. HALL: That is right. We are going to do that.

THE COURT: Even if we take them out of order.

MR. HALL: That is what I hoped Your Honor would say.

BY MR. HALL:

Q Mr. Ploeger, I show you your deposition at page 29 and I think it would be well, before I ask you a question, if you would read pages 28 and 29 of your deposition before I ask the questions, and maybe we can speed things up that way.

A Mr. Hall, is that starting from the second paragraph?

Q Yes.

(Pause.)

A I will say already I don't know what this exhibit is. I would like to point out it doesn't make any sense to me.

THE COURT: Just a moment. Just read those two pages and then wait until a question is asked.

THE WITNESS: I see.

(Pause.)

THE WITNESS: Mr. Hall, I have quickly glanced --

THE COURT: Just a moment. Just read it to yourself and then wait until a question is asked.

THE WITNESS: Yes, sir.

MR. HALL: Mr. Gonda, could we agree that Ploeger Deposition Exhibit 3 that is referred to there in the deposition is the ribbon that you charge to infringe?

MR. ROBSON: If Your Honor please, I don't think it is proper for counsel to stipulate on the witness' testimony.

THE COURT: Just a moment. My practice is to permit counsel to interrupt only for the purpose of making an objection and then stating it in legalistic phraseology so that the witness would not understand what the objection is.

MR. ROBSON: Mr. Hall has asked for a stipulation. I am not objecting.

THE COURT: I don't permit any interference with cross-examination except for the purpose of noting an objection, because the Court has to bear in mind that some of the questions go not to issues of fact but to credibility.

Well, we will take our usual mid-morning recess at this time.

(Recess.)

THE COURT: You may proceed, Mr. Hall.

BY MR. HALL:

Q Mr. Floeger, I show you your deposition at page 28 and I ask you if you cannot agree that the ribbon that was marked Floeger Deposition Exhibit 3 is the ribbon that is charged to infringe? And I show you the last question and answer on the page:

"In other words, you have drawn a picture of the ribbon that you charge to infringe, and you have attached a sample of it to that piece of paper.

"A That is correct."

Did you so testify?

A That is correct.

Q So you are willing to agree that Floeger Deposition Exhibit 3 is the ribbon which you charge to infringe?

A Mr. Hall, I can't agree unless I see the diagram or the exhibit.

(Pause.)

A No, sir, would you just please reread that question?

Q "Q In other words, you have drawn a picture

of the ribbon that you charge to infringe, and you have attached a sample of it to that piece of paper?

"A That is correct."

A That is right. . .

Q I would like for you to look at page 277 of your deposition and at the same time look at Ploeger Deposition Exhibit 15, and I ask you does it infringe your Patent No. 3,010,559, and you say:

"A It doesn't appear to."

And then I go on and I say:

"Q Very well. Is there any feature of your Patent No. 3,010,559 which, in your view, was novel, at the time you filed the application which is embodied in the ribbon of Ploeger Jr. Deposition Exhibit No. 15 for identification?

"A Would you kindly repeat the number of that patent?

"(Question read.)

"The Witness: There doesn't appear to be one."

Did you so testify?

A The testimony that I gave is correct, yes.

Q And I have correctly read it?

A In regards to reading it, I imagine you did, yes.

I assume you read it correctly. I did not follow you in your reading, no.

Q Well, it was right in front of you at the time I read it.

A It's a little difficult to --

Q Well, let's read it again.

A Mr. Hall, may I just ask you are you discussing an exhibit here right now? I don't follow this.

THE COURT: Just a moment. Wait until a question is asked you.

Now, Mr. Hall, you ask a question.

BY MR. HALL:

Q Mr. Ploeger, you have before you Ploeger Deposition Exhibit 15 for identification?

A Yes. That is what is troubling me, Mr. Hall. I don't understand what --

THE COURT: Just a moment. Read the question, and you listen to the question.

(The Reporter read the last question.)

THE COURT: Now finish your question.

Q Don't you?

THE COURT: Yes or no.

A Yes, it appears to be an exhibit, yes.

Q And I want to read from your deposition about that

Q Now I want to turn back to page 274 of your deposition -- really 273, where first Deposition Exhibit 15 was marked as an exhibit:

"Q Did you ever see a ribbon like that before?

"Mr. Gonda: By 'like that,' I presume is intended to mean Exhibit No. 15.

"Mr. Hall: Right.

"The Witness: Would you clarify what you mean by 'like'?

"By Mr. Hall:

"Q Well, have you ever seen a ribbon identical with that before, identical in construction?

"A In construction, yes, it appears to be constructed similarly.

"Mr. Gonda: The question was 'identical.'

"The Witness: The construction appears to be identical with Exhibits Nos. 7 and 3, and there is one other exhibit here, 14."

Have I read it correctly?

A May I just say this to you, sir. You may have read it correctly up to a point, but the very next statement I wish you would read that. I think it would be fair to me if you

would read Mr. Gonda's statement there.

Q "Mr. Gonda: The witness here is testifying in a manner which is obviously incorrect."

THE COURT: I don't think comments of counsel should be read, Mr. Hall.

MR. HALL: All right. Well, he asked me to read it.

THE COURT: I know, but I think you have a right to ask the witness were you asked the following question or did you give the following answer, or words to that effect.

THE WITNESS: Mr. Hall -- I'm sorry, Your Honor.

THE COURT: But I think any colloquy of counsel should be omitted.

And may I again say to the witness when the correct answer is yes or no, just answer yes or no and put a period after the answer.

THE WITNESS: I will try to do that, Your Honor.

BY MR. HALL:

Q Well, Mr. Ploeger, the portions of your deposition from pages 273 and 274 that I read, I read them correctly, is that right?

A You did read them correctly, yes, sir.

Q And let's get back and refresh our minds that Exhibit 3 that was referred to there on page 274 is the ribbon

which you charge to infringe?

A I'm sorry; there are so many exhibits, Mr. Hall. Exhibit 3 is now which one?

Q All right; let's look back at your deposition, page 28, where we first marked Exhibit 3 and then you admitted that that was the ribbon which you are charging to infringe, is that correct?

A May I just ask you if Exhibit 3 represents that sketch that we had before? Is that the one?

Q Let's read what you said about Exhibit 3 again.

A Now I know where Exhibit 3 is. Let's read that again.

Q Let's get this straight. You have Ploeger Deposition Exhibit 3 before you right now, don't you?

A That is correct.

Q And on page 28 we are talking about that exhibit, aren't we?

A Yes, sir.

Q And speaking of that exhibit I asked you this question:

"Q In other words, you have drawn a picture of the ribbon that you charge to infringe, and you have attached a sample of it to that piece of paper?"

"A That is correct."

A That is correct.

Q I'd like to read from page 43 of your deposition and I ask you if you testified in accordance with what I am about to read:

"Q Do you consider yourself familiar with all facets of the manufacturing of printing ribbons?

"A To the extent of their slitting; I am not familiar with inking, and of course printing ribbons or inking ribbons -- I am familiar with the slitting of these ribbons.

"Q And that is all?

"A That is right, on the basis of inking, we probably wouldn't know how to go about it. We are not concerned with inking ribbons. We are cutting these ribbons, primarily cutting."

Now did I read it correctly?

A You read it correctly.

Q Is that a true statement, that you are not familiar with how to ink ribbons and that if you were asked you probably wouldn't know how to go about it?

A Would you repeat that question, please?

(The Reporter read the last question.)

A Mr. Hall, I am not concerned with the process of

inking ribbons; that is correct.

Q I would like to show you page 57 of your deposition and I will read to you from that page and I want you to tell us whether you testified in accordance with the material that I am reading. We will start back up here at line 3 to start the context, but the main material I am interested in is near the bottom of the page:

"Q Woven nylon, such as you used for the inked portion of your ribbon --

"A The question is not clear.

"Q Would it be a correct statement to say that nylon per se is not particularly absorbent?

"A When you say absorbent, again you will have to clarify what you mean by absorbent. Absorbent to what?

"Q Would you clarify it?

"Mr. Gonda: He clarified it. Are you asking him to read your mind? I don't understand.

"By Mr. Hall:

"Q Is it particularly absorbent to ink?

"A I don't know. I am not a textile engineer, and I don't know. Again the question could be very highly technical and I don't know if it is or not, as

such. I am going to help you along in this by trying to break down the fiber from the woven material, so if you want to ask me, from that point on, the fiber itself or the woven material, ask me the question from that."

THE COURT: Well, the whole answer is, I don't know. That is what it amounts to.

BY MR. HALL:

Q Did you so testify?

A I so testified, yes.

Q Now I have one very final point and then I am going to be through with my cross-examination.

Mr. Ploeger, I want to show you page 4-A of the pretrial order in this case and the part that I am going to show you is plaintiff's contentions --

THE COURT: I don't think the witness should be examined concerning the contents of the pretrial order. Pretrial orders are prepared by counsel and I don't think that witnesses should be cross-examined concerning them, unless they join in signing the pretrial order. Of course they don't in this jurisdiction. Just the same as I don't think it is proper to examine a party concerning his pleading, unless counsel practices in a jurisdiction where the party

signs the pleading.

MR. HALL: All right. I will get at the same matter in another way.

BY MR. HALL:

Q Mr. Ploeger, would this be a correct statement of the alleged trade secret that you claim to have disclosed to Mr. Wolowitz in the latter part of the year 1961 --

THE COURT: What page of the pretrial order are you referring to?

MR. HALL: Page 4-A. You see where it says Count 3, Trade Secret.

THE COURT: Yes, I have it.

MR. HALL: The second sentence is the one I am going to read.

Q Mr. Ploeger, I want to read to you a statement and I want to ask you if this is the alleged trade secret that you claim to have disclosed to Mr. Wolowitz in 1961:

"This involved making two ribbons as per the patent in suit, placing them over one another with the film layers contacting each other, then cutting all the layers with a hot knife."

A Mr. Hall, I believe it would probably be a legal technical question whether or not that --

THE COURT: No, no, that is a factual question, what your trade secret was.

THE WITNESS: The trade secret --

THE COURT: Just a moment.

I think that is a proper question. It is not a legal question.

THE WITNESS: I will be happy to answer it. Would you please re-read it?

THE COURT: Suppose we have the question read.

MR. HALL: Could I show it to him and let him study it?

THE COURT: No; let's have it read.

(The Reporter read the last question.)

THE WITNESS: I believe that would apply, yes, sir.

BY MR. HALL:

Q Well, now, Mr. Ploeger, your patent in suit doesn't have any correction material on it, does it?

A The patent in suit does not have any correction material on it, no.

MR. HALL: Your Honor, may I give sort of an oral showing here while I ask the question?

He says that he places two ribbons like his patent in suit one on top of the other, with the pieces of film

touching each other.

BY MR. HALL:

Q Now does that mean that you would place the two ribbons just like the two showings of figure 4 that I have before you?

A What I have done is to take two separate entities and put them side by side.

Q Well, would you lay the one on top of the other about like I have it here?

A I don't know if you would characterize it as exactly in that manner.

Mr. Hall, let me just say this. The manner in which it is fastened is an unobvious type of thing due to the trade secret itself. It is very hard to say -- I can't answer --

THE COURT: Just a moment. I think you have to confine yourself to answering questions, and if anything else should be brought out, your counsel can take care of that on redirect.

Q Mr. Ploeger, if we put two ribbons as per the patent in suit, one on top of the other, with the film portions contacting each other, it would be essentially as I am holding--

A I am not sure that you are correct. I am not

sure that you are correct.

Q All right. Then will you show me how --

A You are showing me two pieces of paper, it is not film and cloth.

Q You say you take two ribbons as per the patent in suit and lay them on top of each other. Could you take these two copies of your patent and pretend that each one of them is a ribbon and show us how you would lay the one on top of the other?

A You want me to describe ribbons of the patent in the suit, is that correct, so I understand you properly?

THE COURT: Just what is your question, Mr. Hall?

MR. HALL: I want him to show us how they place the one ribbon over the other.

THE COURT: I don't see how he can do it by using the patents. He would have to have the ribbons in order to put one on the other.

MR. HALL: Do you have that roll of ribbon that was around here the other day?

BY MR. HALL:

Q Mr. Ploeger, would you object if I cut two pieces off of this so that you could lay one on top of the other and show the Judge the way that this alleged trade secret would

be carried out?

A The trade secret involves a heated knife, Mr. T. I. I can't possibly -- it will serve no purpose to employ a demonstration without my machinery.

Q Well, I am not asking you to make the demonstration. I am just asking you to show us how you lay the one ribbon on top of the other. Can't you do that if I give you two pieces of ribbon?

A Oh, certainly.

Q Can I cut two pieces off of here?

A Well, I think so. Sure.

Q All right. Now let's lay these two pieces on top of each other in accordance with the trade secret as it was described to you --

A I have described this procedure earlier and what I simply stated was to have a layer of fabric, nylon fabric, and a layer of film laid out in such a manner as to have them over-lying one another, with the film portion facing up. Then we have another strip of film, we unwind another strip of film, nylon film, and over-lie that on the first layer of film. Then we roll off a layer of nylon fabric and lay it on top. So if we look at it we have a condition which gives us one part of the possibility.

Now you might also say that you can reverse it, but it would be ineffective.

So, in other words, as we testified earlier, the trade secret involves the films facing --

THE COURT: You are going beyond the question. You have answered the question. You were asked to do something and not to give a long explanation.

BY MR. HALL:

Q If these two ribbons that were laid on top of each other conform to the patent in suit they would both be inked, wouldn't they?

THE COURT: I think that is a question for the Court to determine, as to what the patent means.

Q Now, Mr. Ploeger, there is one final question that I have for you. How do you come out with a ribbon like the Spellright ribbon that's got correction material on it if you perform the process just as you have described?

A I don't understand that question, Mr. Hall.

THE COURT: Well, would you like to have it read?

THE WITNESS: I heard it, sir. I don't understand it.

THE COURT: Suppose we have it read.

(The Reporter read the last question.)

THE WITNESS: Again, "How do you come out," I don't understand that, sir. Would you please rephrase it? What do you mean by, "How do you come out with"? I don't know what you mean.

BY MR. HALL:

Q Well, if you perform this process that you have described do you come out with the Spellright ribbon that's got correction material on it?

A Exactly as I showed before?

Q Exactly as we have described up to now.

A It's possible that you might; surely.

Q How? There is no correction material to start with.

A Well, you may have substituted the fabric, you may have impregnated the fabric with the correction solution.

THE COURT: I think it is for the Court to determine --

THE WITNESS: There are solutions --

THE COURT: Just a moment.

It is for the Court to determine what constitutes infringement and what does not.

MR. HALL: Well, that is true. The only thing I was bringing out, that in their pretrial statement they say our ribbon was made by this method, and I was just pointing

out that that is impossible.

THE COURT: That is for the Court to determine, you know.

MR. HALL: All right. No further questions.

MR. ROBSON: Would Your Honor bear with me for just a moment?

THE COURT: Take whatever time you need. There is no necessity for haste.

(Pause.)

REDIRECT EXAMINATION

BY MR. ROBSON:

Q Mr. Ploger, on cross-examination your attention was called to request for answer to Interrogatory No. 36 and your answer to that interrogatory. I would like you to look at the request and the answer and specifically the sentence which says, "Yes, the thing sold is a ribbon," et cetera, and then I would like to ask you a question.

(Pause.)

A Yes, Mr. Robson.

Q When you said yes, the thing sold, et cetera, by whom was the thing sold to which you were referring?

A The ribbons that were processed by us were sold by, to name one, Schwarzenbach-Huber, and then of course

ultimately by inking concerns.

Q To whom were you referring when you used the things were sold?

A I believe I was referring to the middle man, namely, the cloth supplier or the raw tape supplier, the un-inked tape supplier.

Q Did you or the plaintiff corporation or any corporation with which you were associated ever sell the ribbon involved in the patent in suit?

A Not a completed inked typewriter ribbon, no, or business machine ribbon; never.

Q Did you ever have occasion to package for sale to any person the ribbon in suit?

A No, we never sold a ready packaged little ribbon for machines, no, sir.

Q When you said in answer to Interrogatory 36, "No steps as such were taken by the plaintiff to market the patented ribbon with the patent number," what did you mean?

A I meant that we never sold little packaged spools of either typewriter ribbons or business machine ribbons. That is what I meant.

Q Did you mean by that to imply that other people may have but you did not because you did not sell, is that correct?

A I am not in that business, that is correct.

Q Is it your testimony, however, that on the packages which emanated from your concern, the plaintiff, there was a label affixed?

A Oh, yes, there was.

MR. ROBSON: May I have that label?

BY MR. ROBSON:

Q You were asked on cross-examination how it was, if you claim that you used this label on all packages which left your company, you had the name Filmon Process Corp. on here. Before you completed your answer the question was withdrawn.

I would like to ask you again to tell us what appears underneath the gummed label which says Filmon Process Corp.?

A Affixed to the original label, which was printed before the Filmon Process Corp. came into being, plaintiff corporation had small, little gum tape labels printed up to save the original labels. So that we just pasted a new label onto the old label.

Q What is the legend that appears under that gummed label?

A Filmon Process Corp., 653-659 Eleventh Avenue, New

York 36, N. Y.

Q What is underneath that gummed label, what was covered up by that gummed label?

A Edgecraft Process Company.

Q Edgecraft Process Company?

A That is correct.

Q And is Edgecraft Process Company the company that was processing the Filmon ribbon prior to --

A That is correct.

Q -- the formation of Filmon Corp.?

A That is correct.

Q So that at all times from the inception of the use of this patented process -- withdraw that.

At all times when you processed the ribbon involved in the patent the label in your hands, which has been marked as an exhibit, was affixed to the wrapper which went out from your company, is that correct?

A That is correct.

Q You were asked on cross-examination why it was that you had never, in answers to your interrogatories, advised the defendant that this label was affixed to products which emanated from your company. I would like to call your attention to answers to interrogatories dated November 1963 and

I ask you whether you recall having submitted answers to these interrogatories?

A Yes, sir.

Q And I ask you whether the interrogatories, which are Answers 62-R, 62-S and 62-T, are the answers to the questions contained -- they are answers to questions contained in a request for answers to interrogatories served on November 14, 1963, are they not?

MR. HALL: Your Honor, I object to this. They are talking about interrogatories other than the ones we are relying on. They can't pick out some other interrogatory we asked them and start talking about that.

THE COURT: Yes, they can pick out other answers which qualify or explain the matter concerning which you interrogated the witness on cross-examination.

MR. HALL: All right.

THE COURT: I think this is proper redirect.

MR. ROBSON: If Your Honor please, for the purpose of expedition I will not refer to the details of these interrogatories now.

THE COURT: You better tell me what is in them, what you rely on.

MR. ROBSON: Let me read them to the Court; they

are very brief.

THE COURT: Very well.

MR. ROBSON: Interrogatory 62-R asks:

"With reference to plaintiff's answer to defendants' Interrogatory 26 and more particularly that portion reading, 'In particular, the industry is very small and no other product marked patented except the product referring to the patent in suit,' state what investigation or attempt was made to find products marked patented prior to the signing of this statement.

"Answer - From past experience in the trade and from discussions with persons in the trade, no other products marked patented ever came to its attention. At trade shows such as the Business Manufacturers Supply Show, no such product marked patented was ever observed. None of the material processed by the plaintiff for third parties, except material referring to the patent in suit, was ever marked patented.

"Question 62-S - With reference to the statement, 'In particular, the industry is very small and no other product marked patented except

the product referring to the patent in suit, state what products embodying the alleged patent in suit have been marked patented. State in each case whether or not the product was inked, also in each --"

THE COURT: Suppose you summarize what it says without reading it in extenso.

MR. ROBSON: Possibly if I read the answers the questions will be fairly obvious.

THE COURT: Well, is it long?

MR. ROBSON: No, the answers are very short:

"Answer S - Inked ribbon originated from the plaintiff and the defendant was marked patented. The marking patented or similar information was applied to an over-wrap for the product or on literature shipped with the product. The plaintiff has used the terminology that uninked ribbons originating from the plaintiff are patented when inked.

"Answer T - The plaintiff has used a rubber stamp which is part of a make-up kit in marking patented which has been in its possession for many years. By nature of the make-up kit the information

printed may be varied as desired. Packaging materials or labels associated therewith for the inked ribbons originating from the plaintiff have been marked in a manner to indicate that they were patented products. The plaintiff does not know when the printing was first performed and by whom."

THE COURT: Very well, you may proceed.

BY MR. ROBSON:

Q On cross-examination you were asked some questions about the bulking which occurred in some of the ribbons processed by your company. Were any steps taken by your company to reduce the bulking? Withdraw that.

Do you know what caused the bulking?

A Yes, we had a pretty good idea.

Q What caused the bulking?

A It was defective film, heavy defective film. And in many instances also it wasn't even the ribbon's fault, it was a case where the customer had even inadvertently put the ribbon in backwards or something to that effect. In other words, the machines were at fault also at that time. You see, people were not --I would like to just qualify it-- were not used to our new product and they sometimes spooled it

incorrectly; but that has been ironed out.

Q Have you corrected that defect?

A Yes.

Q Are your ribbons being used in typewriters today?

A Yes, sir.

Q Are they being used today in high-speed automatic printing machines?

A Yes, they are.

Q Did you ever receive a complaint of bulking from Mr. Wolowitz or the Spellright Corp.?

A He had never indicated to me that such a problem bothered him, no.

Q In your testimony on cross-examination you stated that your sales, or you admitted that your sales fell off in 1963. Do you know why your sales fell off in 1963?

A Well, first of all, I lost Mr. Wolowitz' business. That is the first thing.

Q Were there any other reasons?

A I can guess at some. I have personal --

Q I don't want you to guess.

A I mean I have a pretty good idea. I think it was this litigation that is just holding us back. A young company, we just can't get started here.

Q I would like you to look at the last question starting on page 277 of your deposition and the answer to that question, and at the same time I would like you to look at Exhibit No. 15 which was referred to in that question.

A Would you kindly repeat what I am supposed to do? I lost -- I don't believe that I have Exhibit 15 here, even. Oh, 15, yes, right.

Q This is Deposition Exhibit 15 I am referring to now and the last question on page 277.

A May I just read it?

Q Yes.

(Pause.)

A What is your question?

Q I didn't ask any yet. Have you read it?

A Yes, I believe I have it now.

Q Now looking at Exhibit 15 will you tell me whether that exhibit, the black portion of it, consists of a nylon fabric?

A Yes, it does.

Q And is there attached to that nylon fabric a nylon film?

A No, there isn't, not on this one here.

MR. ROBSON: I withdraw the question on that, then.

I was not aware of what that exhibit was, apparently. It was something other than what I thought it was.

THE COURT: Very well. May I call the attention of counsel to the fact that Deposition Exhibit 15 is not in evidence. I know both of you gentlemen have questioned the witness concerning it but neither one of you has offered it in evidence.

MR. ROBSON: I am not interested in having it offered in evidence.

THE COURT: Very well, then, don't offer it in evidence if you are not interested.

BY MR. ROBSON:

Q You were read certain questions and answers on page 43 relating to your familiarity with the manufacture of printing ribbons or the process of inking ribbons.

A Yes, sir.

Q In connection with your processing of ribbons for printing purposes have you had occasion to test the ink absorbency and the ink capacity --

THE COURT: He has already testified to that on direct examination and, in fact, he did it right here in this courtroom.

MR. ROBSON: Thank you, sir.

Q Now on page 57 and 58 you were asked and answered

certain questions which were read to you earlier about the absorbency of nylon fiber or filament. Is there a difference between the absorbency of nylon fiber or filament and nylon fabric which is woven with nylon fiber and filament?

A Do you mean a difference in absorbency of ink?

Q Yes.

A Yes, there is a difference, certainly.

Q Is nylon fabric which is woven with nylon fiber absorbent?

A That is relatively absorbent, yes.

MR. ROBSON: Would Your Honor bear with me for one moment? There are just two documents I want to introduce and then I will be finished.

THE COURT: Take whatever time you need.

MR. ROBSON: We have had to move our offices into hotel rooms. (Pause.)

If Your Honor please, I won't hold the Court up any further. I just wanted to introduce a couple of documents. I will introduce them at a subsequent time when I locate them.

THE COURT: Surely.

MR. ROBSON: I have no further questions of the witness.

MR. HALL: I can complete mine before the noon recess.

RECROSS-EXAMINATION

BY MR. HALL:

Q Mr. Ploeger, this sticker, Exhibit 2, has your patent number on it, doesn't it?

THE COURT: Well, it speaks for itself.

Q The number of the patent is what these interrogatories asked for.

Now I would like to show you this new interrogatory that Mr. Robson read and the answer to which he read, and I want to ask you if you weren't asked this question and if you didn't give the answer:

"Question S - With reference to the statement, 'In particular the industry is very small and no other product marked patented except the product referring to the patent in suit,' state what products embodying the alleged patent in suit have been marked patented. State in each case whether or not the product was inked. Also in each case whether the marking was on the product itself or on the spool on which it was wound or on the box or where else the marking was located. Further, in each case state any other words or numbers that are associated with the word patented, as for

example, the patent number and whether or not it referred to patented when inked or the like."

Now in your answer did you give any statement to the effect that the patent number was marked --

THE COURT: I think the answer speaks for itself and you can offer it in evidence as an admission, if you wish.

BY MR. HALL:

Q All right, I would like to read you the answer.

THE COURT: No, you may just offer it in evidence.

MR. HALL: May I read it to Your Honor?

THE COURT: No, I will read it to myself.

What interrogatory number is it?

MR. HALL: 62-S.

THE COURT: Very well, I will read it. Let it be considered in evidence.

Q And then Interrogatory 36, Mr. Ploeger, I would like to get back to it again.

THE COURT: No, we have had enough questions on 36 from both sides.

MR. HALL: Could I ask just one?

THE COURT: I will read it, if necessary. I have read it.

MR. HALL: I know, but there is one little thing in

the record. I am not asking him about the interrogatory, I am asking him about a word in it.

THE COURT: Very well.

BY MR. HALL:

Q The interrogatory starts out and it says:

"Has any owner of the patent in suit made, used or sold anything under the patent or authorized anyone else to make, use or sell anything under the patent in suit."

Now what I am asking you is, who did you consider the owners of the patent to be at the time you answered this interrogatory?

THE COURT: I don't think that is material, Mr. Hall, whom he considered the owner to be. This happens in every trial, we reach the region of minutiae.

MR. HALL: No further questions.

THE COURT: You may step down.

Now, gentlemen, I want to take out of order when we convene after lunch any witnesses who can't be here tomorrow. If they are defense witnesses, your putting them on will not waive your rights to make any motion to dismiss.

MR. HALL: We will have one such witness.

THE COURT: You have only one.

And have you any such witness?

MR. ROBSON: We do not, sir.

THE COURT: Very well. Then at the opening of the afternoon session I would like to have you call that witness.

(At 12:30 p.m. trial stood in recess,
to reconvene 1:45 p.m.)

- - - -

AFTERNOON SESSION

THE COURT: You may put on your witness out of order.

ESTELLE JACOBS

called as a witness by Defendants, having been duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. HALL:

Q Would you state your name, age, and occupation?

THE COURT: You don't have to ask the lady her age.

THE WITNESS: Thank you.

A My name is Estelle Jacobs. I am a housewife. My husband is a dentist. And I am a sales director for Spellright Corp.

Q How long have you been sales director for Spellright Corp.?

A Since its inception.

Q Who is the president of the corporation?

A Mr. William H. Wolowitz.

Q Are you any relation to him?

A Yes, I am. I am his sister.

Q Mrs. Jacobs, I hand you a ribbon which has been marked Plaintiff's Exhibit 7-B and I ask you if you have ever seen a ribbon like this before?

A Yes, I have seen a ribbon like this before.

Q We are not asking you for intimate details of the ribbon, but did Spellright sell ribbons that looked generally like that ribbon?

A Yes, we did.

Q Over what period of time?

A Well, from the very beginning of our business through up until about three years ago, I imagine.

Q I hand you a little printed leaflet marked Plaintiff's Exhibit 7-A and ask you if you have ever seen one like this before?

A Yes, I have.

Q Did you have anything to do with getting this little printed leaflet prepared and put out by the Spellright Company?

A Yes, I did.

Q Tell us what part you played in it.

A Well, I contacted Kaufman Associates, which is an advertising firm with whom we deal --Mr. Kaufman is on our board of directors-- and I felt that we needed something other than a little mimeographed instruction sheet to promote our ribbon, and so he had designed -- this is our trade-mark which he had designed (indicating), and therefore I gave him information concerning our ribbon and asked him to put it in advertising form that would be attractive and very briefly show what our ribbon did, how to install it in the typewriter, and this is what he came up with.

Q You said he is on your board of directors. Over what period of time was he on the board of directors?

A I think he has been on our board of directors since its inception.

Q You mean he is still on the board?

A I think he is.

Q When you asked him to prepare this printed thing did you in any way mention the word patent or patented or anything of the kind?

A No, I did not.

Q You are a college graduate, are you?

A Yes, I am.

Q What did you major in?

A Math and science; not the new math.

Q Then after you graduated what occupation did you have?

A I taught school in the District schools in Washington.

Q Did you ever have any contact with patents or patent lawyers or things like that before you asked this insert be written?

A No, I didn't. Just "patent pending," whoever he is.

Q Well, after this leaflet got written and printed with the word patented in it, was there any discussion of this word around the Spellright Corp. that you can recall?

A No. In fact, I didn't even -- it's on the back, and all I was concerned with was if the instructions were proper, if the guarantee was on it; and the first time it came to my attention was when this suit brought it to my attention.

Q So far as you know or have any reason to believe, did you or any other person on behalf of Spellright Corp. ever invite the attention of any customer to this word patented on the literature?

A No, we did not.

Q Where was Mr. Wolowitz at the time this piece of literature was printed?

A In the hospital, unfortunately.

Q Now after this piece of literature was printed -- I will withdraw that question.

Mrs. Jacobs, I refer you to Defendants' Exhibit 4, which is a page from a published magazine, International Management of November 1962, and I ask you if you have ever seen that before?

A Yes, I have.

Q Does that contain a description of the Spellright ribbon in it?

A Yes, it does.

Q Would you read that portion of the description which pertains to the backing?

A Well, the --

THE COURT: The document speaks for itself. You have a right to examine concerning it but it is not necessary to trouble her to read it out loud. It is a matter of argument. Is there anything there about the patent?

MR. HALL: Oh, yes; not the word patented, but it tells how the backing on our ribbon was.

THE COURT: But the word patented is not there.

MR. HALL: No.

THE COURT: I thought not.

THE WITNESS: Do you want me to read this?

THE COURT: No.

BY MR. HALL:

Q Then I will ask you this question. Does this piece of literature refresh your recollection as to how the backing on the ribbon was at the time that these leaflets were printed?

MR. ROBSON: I object to that question on the ground the witness hasn't indicated her recollection needs refreshing.

THE COURT: As to what?

MR. HALL: As to how the backing on the ribbon.

THE COURT: What is your objection?

MR. ROBSON: The witness hasn't indicated that her recollection is in any way impaired or that she doesn't recall anything.

THE COURT: Technically you are right, she didn't say that she could not remember or anything of that sort. Therefore, there is no showing that her recollection has to be refreshed.

Q Can you tell us what the backing on the Spellright ribbon was like at the time that piece of literature, Exhibit

7-A, was written?

A Well, the backing was like the backing on Exhibit 7-B.

Q Well, how far across the back side of the ribbon did the Scotch tape go?

A Well, I don't know anything about the manufacture of the ribbon but it goes all the way from the bottom to the top on this ribbon.

Q Well, how was it on the ribbons that were being sold at the time that that piece of literature, 7-A, was written?

A Well, this is the ribbon that was being sold while this literature, 7-A, was written.

Q All right. Well, again I am not going to ask you for the intimate details of the ribbons, but I will show you Plaintiff's Exhibit 17 and ask you if Spellright ever had a ribbon that looked to the naked eye, to the untrained eye, generally similar to this ribbon?

A Yes.

Q Now what was the regular line of Spellright's ribbons like? Which ribbons were they selling to most of their customers and which of those ribbons were being sold to most of the customers?

A At what time?

Q Well, at the period, say, six months before the filing of this suit and a few months afterward.

A I believe it would have been one that looked like this, and we were also selling ones that looked like this.

Q Well, were the regular line ribbons made with material that was gotten from the Schwarzenbach-Huber Company?

A Yes.

Q Were there some other ribbons, other than the regular line of ribbons, that were put in boxes and supplied to some customers?

A We were always making experimental ribbons. That was a little department all by itself. And we had a group of customers and people who field tested our ribbons for us and every once in a while we would put a few in with our regular run of ribbons in order to get a reaction on a prototype of something we may or may not have ever gone into production on.

Q Now what, if anything, was put in the box with these experimental ribbons that went out?

MR. ROBSON: I object to that because there has been no testimony about experimental ribbons having gone out.

THE COURT: If the witness understands the question she may answer. Of course there may be a question as to what

is experimental, but the witness may answer in her own way and you can probe that on cross-examination if you wish.

THE WITNESS: Well, as I said, we had field testers, customers of ours who had used our ribbon, and we wanted -- we were trying out different types of ribbons which were not in our main run and when we would send these ribbons out to our customers --

THE COURT: I think you have gotten beyond the confines of the question.

Will you read the question?

(The Reporter read the question as follows:

"Now what, if anything, was put in the box with these experimental ribbons that went out?")

THE WITNESS: We would put in a little mimeographed instruction sheet as to how to install the ribbon on the typewriter.

BY MR. HALL:

Q You have that printed leaflet there, Exhibit 7-A. That is the one that you said Mr. Kaufman printed. Was that put in the boxes with these experimental ribbons?

A No, these went in the boxes with our regular production run ribbons.

Q Why is it that with the experimental ribbons you

put in this other mimeographed sheet instead of the printed piece?

A Because this little mimeographed sheet has our guarantee, et cetera, et cetera, on it and it was our regular production run; whereas the experimental ribbons we wanted reaction to from the customers and all we gave them was instructions as to how to put it in their typewriter.

Q I believe that when you held that up to the Judge you said "this mimeographed piece."

A No, I said the printed one went into --

THE COURT: That is 7-A.

THE WITNESS: 7-A, yes, went into our regular production run.

BY MR. HALL:

Q Now in your capacity as sales manager did there come a time when some letters went out from the attorney for the plaintiff to your customers?

A Yes, there came a time.

Q Well, tell us in your position as sales manager what effect that had on the operations of your company.

MR. ROBSON: I am going to object to that as completely irrelevant.

THE COURT: I don't see what is the relevancy of

that. What is the relevancy of that, Mr. Hall?

MR. HALL: Your Honor, these letters that plaintiff sent out to all of our customers practically destroyed our business and we contend that they knew it and they --

THE COURT: That may be so. My question, though, is what relevancy does it have to the issues of this action.

MR. HALL: Well, the cases that I cited to you have said that when circular letters of that character go out the plaintiff is in court with unclean hands, and if they have circular letters which threaten suit when no suit was actually intended the plaintiff is in court with unclean hands.

THE COURT: This suit had already been filed when these letters went out?

MR. HALL: Yes. The same was true in connection with that Seventh Circuit Court of Appeals case that I cited to you. In fact --

THE COURT: I took a dim view of these letters once before, as you recall, but I was under the impression that there was no suit pending at the time and that this was just interrorem. But if suit is pending, I think the situation is a little different.

MR. HALL: Well, a suit was pending at the time of the circularization that the Seventh Circuit Court of Appeals

referred to.

THE COURT: Well, I am not going to follow it, then. That is not binding on me.

I may take a dim view of the letters but I am not going to go as far as to say that that constitutes unclean hands. I think I would have preferred to have not seen the letters go out, but I don't think I am going to hold that that constitutes unclean hands. To brand a party as having unclean hands is pretty drastic and I think the courts ought to be very cautious before they go that far.

MR. HALL: I have no further questions for Mrs. Jacobs.

THE COURT: Have you any cross-examination?

MR. ROBSON: Yes, sir.

THE COURT: You may proceed.

CROSS-EXAMINATION

BY MR. ROBSON:

Q Mrs. Jacobs, you have before you, do you not, Exhibit 17?

A Yes, I do.

Q I believe you testified that you have seen ribbons similar to that, at least so far as you can tell they are similar to that, which were sold by the Spellright Corp., is

that correct?

A Yes.

Q Is that the ribbon which you testified earlier was the one which the most or the largest volume of was sold?

A I can't say that this is the ribbon by looking at it. I couldn't tell by looking at this ribbon whether it came from that production or not.

Q But let me ask you this, then. Is that one of the ribbons of which a large volume was sold?

A We sold ribbons that were this color, black and white and with a backing on the top and the bottom.

Q It looked just like that?

A It looked like it. I couldn't tell you whether this is from that run or not. I don't know if anybody could.

Q You sold a large volume of that ribbon, is that correct?

A We sold a large volume of both ribbons.

Q Yes. Now the ribbon that is No. 17, the one with the blue and white, that is not an experimental ribbon, is it?

A I couldn't tell you. I didn't make it and I don't know how the ribbons are made, so I couldn't tell you if it was experimental or not.

Q Incidentally, do you have with you a copy of the

mimeographed instructions which Spellright Corp. sends out to its customers when it sends out experimental ribbons?

A I don't have one with me but I can certainly send you one.

Q Incidentally, when was Spellright Corp. formed?

A I believe in 1961.

Q It was in May 1961, was it not?

A Yes.

Q Do you have any knowledge whatsoever about the nature of the experimental ribbons with which you enclosed the mimeographed instructions?

A What do you mean nature?

Q How they were constructed, what they looked like, anything at all?

A Mr. Wolowitz, Mr. Farrell, and maybe one or two other people ran their own little experimental department away from our regular production run. They would --

THE COURT: No, no; the question calls for a yes or no answer.

THE WITNESS: No, I don't know.

BY MR. ROBSON:

Q When you sent experimental ribbons, who told you that they were experimental? Was it Mr. Wolowitz?

A Or Mr. Farrell.

Q Who is Mr. Farrell?

A Mr. Farrell worked with Mr. Wolowitz in the manufacturing of the ribbon.

Q Was he an officer of the corporation?

A I believe at the time he was.

Q When you said experimental ribbons do you recall how many ribbons you sent to each ultimate recipient?

A We would send one to a person.

Q Just one?

A At a time.

Q Did you ever send 900 experimental ribbons to anybody?

A No, I did not.

Q Did you ever send as many as three dozen ribbons to anyone as an experimental ribbon?

A Not to any person.

Q To any one store?

A Maybe we may have sent that many to one of our larger customers.

Q Do you know whether Pomroy's in Wilkesbarre, Pennsylvania, was one of your larger customers?

A No, they were not.

MR. ROBSON: May we mark that?

(List dated July 3, 1963 marked
Plaintiff's Exhibit No. 18 for
identification.)

BY MR. ROBSON:

Q Mrs. Jacobs, I show you a document which has been
marked Plaintiff's Exhibit 18 for identification and I ask you
whether you have ever seen that document before?

A Yes, I have.

Q Did you prepare the information which appears on
that document for Mr. Hall or for Mr. Wolowitz?

A Yes, I did, for Mr. Wolowitz.

Q The document refers to a Mark II ribbon, does it
not, up at the top, I believe?

A Yes.

Q And do you know what a Mark II ribbon is, can you
tell us?

A Well, all that I know, as opposed to our regular
production run, anything that was an experimental ribbon was,
for all intents and purposes, a Mark II.

THE COURT: Would you read the question?

Would you follow the question, please?

(The Reporter read the last question.)

THE WITNESS: An experimental ribbon.

BY MR. ROBSON:

Q Any experimental ribbon is called a Mark II ribbon?

A At this time, I guess it was.

Q When was that compiled, do you recall, Exhibit 16?

A The date on here is July 3rd, 1963.

Q And as of July 3rd, 1963 you called all experimental ribbons Mark II ribbons, is that correct?

THE COURT: How is all this relevant, Mr. Robson?

MR. ROBSON: If Your Honor please, it is relevant to establish the extent of the use of this ribbon and to establish that it was not an experimental ribbon.

This list was given to us by counsel for the --

THE COURT: But how is that relevant at this stage of the litigation? Doesn't that go to the issue of damages?

MR. ROBSON: No, sir, it goes to the question of whether or not these were experimental ribbons.

THE COURT: Well, suppose they were or suppose they weren't. What difference does that make so far as the issues of validity and infringement are concerned?

MR. ROBSON: One of the defendants' defenses is, these ribbons did not infringe because they were merely experimental.

THE COURT: They were sold to people. Therefore,

they are not experimental.

MR. ROBSON: If that is Your Honor's ruling, then I don't have to ask any further questions on that subject.

THE COURT: Anything that was sold on the market is not experimental; not in a technical sense, certainly.

BY MR. ROBSON:

Q Incidentally, that list indicates that 900 dozen --

THE COURT: You know, if a person says as an experiment I am going to sell 100 articles, well, it may be experimental in a business sense, it is not experimental in a legal sense.

MR. ROBSON: I will withdraw that last question.

Q Incidentally, are you still the sales director of Spellright?

A Yes.

Q And is it still in business?

A Yes, it is.

Q It is still selling Spellright ribbons?

A Yes, it is.

Q Calling your attention to the leaflet which has been shown to you, I believe it's Exhibit 7-A or 7-B, is that correct?

A 7-A.

Q You say you gave the information to Mr. Kaufman or someone from his firm, for inclusion in that leaflet. Did anybody else give Mr. Kaufman information for inclusion in that leaflet?

A No, I worked with Mr. Kaufman's office.

Q Do you know if he got any information from Mr. Wolowitz?

A No, I don't think he did.

Q Do you know if he got any information from his attendance at meetings of the board of directors?

A Whether he got? You would have to ask Mr. Kaufman that.

Q You don't know whether he got any at that time or not?

A You mean whether someone told him?

The only time this particular leaflet was discussed was in Mr. Kaufman's offices between him and me.

Q Do you recall what information it was that you requested of Mr. Kaufman that he include in such a leaflet? What did you tell him you wanted in there, in general terms?

A An instruction as to how the ribbon worked, how to install it in their machine, a guarantee, and any kind of advertising material that he as an advertising man would feel

would be attractive.

Q In other words, you gave him carte blanche to say anything he wanted to about the product that he thought was a good advertising pitch?

A Yes.

Q And when the product came back in finished form you never bothered to look at the other side of it, you just looked at the instructions, is that correct?

A I am sure I read the whole thing; you know, glanced over it, but I didn't minutely go down word for word. I read it all.

Q Well, did you go down it minutely enough to see the word patented there?

A Of course I saw the word patented.

Q When you got it back from Mr. Kaufman?

A Of course.

Q And did you ask Mr. Kaufman where he got that word from?

A I wouldn't ask Mr. Kaufman where he got the word from. He made up the literature and it didn't strike me one way or the other. I knew that we had applied for a patent on the ribbon somewhere along the line.

Q You also knew that no patent had been issued,

didn't you?

A I don't know about issues or what have you. I know that this was -- that a patent had been applied for. At board meetings and so forth patents were discussed. But I didn't tell Mr. Kaufman to put the words down. Those were his words.

Q That was his idea?

A His words. It came from his office.

Q Do you have any idea what patent he was referring to?

A No, I didn't think about it when I read it.

Q Did Mr. Wolowitz ever see that leaflet, do you think?

A I am sure he saw it after it was printed.

Q You say Mr. Wolowitz was in the hospital when this leaflet was printed. When was the leaflet printed, can you tell me?

A Well, I know I worked on it with Mr. Kaufman's office February and March of '62, I think. It's a long time back, but I know that would have been about the time, and I think we finally had them sometime in March or April.

Q When was Mr. Wolowitz in the hospital?

A He was in the hospital in March of 1962.

Q Do you recall how long he was in the hospital?

A Several weeks.

Q Do you recall the exact dates?

A No, I wouldn't recall, but I am sure the hospital record is somewhere.

Q You have no idea?

A The exact dates?

Q Yes.

A I can't even remember exact dates when I was in the hospital.

Q Is it possible that he was in the hospital in April 1962?

A I know he went in sometime in March. Whether he was in through April I couldn't tell you. I am sure there are some records someplace to tell you when he went in and out.

Q Now do you recall a time when the Spellright Corp. began to receive a new type of inking ribbon that was processed by Filmon Process Corp.?

A I never heard of Filmon Processing Corp., or whatever it is, until after this suit. I was in the sales department. I only heard of Schwarzenbach-Huber, was the name that I heard of.

Q When did you first hear of the name Schwarzenbach-Huber?

A You mean the dates?

Q Approximately, yes.

THE COURT: Mr. Robson, is this within the scope of the direct examination?

MR. ROBSON: She was asked about the source of material that went into these things and she said that --

THE COURT: Is it relevant to the issues of the action?

MR. ROBSON: I think so.

THE COURT: How?

MR. ROBSON: Well, the material that came from Schwarzenbach-Huber Corp. was the material that went into the ribbon which we claim infringes, and I am attempting to ascertain when that started and when it terminated.

THE COURT: Very well.

MR. ROBSON: I don't intend to go very far with this.

THE COURT: Very well.

THE WITNESS: Now what is the question?

BY MR. ROBSON:

Q Do you recall when you first started obtaining material from Schwarzenbach-Huber?

A I imagine sometime in 1952. I couldn't tell you. Our records would show when we started ordering them.

THE COURT: Very well.

MR. ROBSON: I would like to offer in evidence Exhibit 18.

THE COURT: Very well, let it be admitted. Just what is it?

MR. ROBSON: That is the list that the witness just identified as having been prepared by her.

THE COURT: Do you have an objection?

MR. HALL: No, except he spoke erroneously about it. He said that it said there were 900 dozen ribbons there, and it counts up to 90.

THE COURT: All I have to do now is determine whether it is admissible under the rules of evidence.

MR. HALL: I don't object.

MR. ROBSON: I started to ask a question and then withdrew it, so there is nothing on the record about that.

MR. HALL: 90 dozen is about 1,000 ribbons.

MR. ROBSON: I misspoke. There are about 200 ribbons mentioned on that list.

THE COURT: Let it be admitted.

(Plaintiff's Exhibit No. 18 for identification was received in evidence.)

MR. HALL: No questions.

THE COURT: You may step down.

Has the plaintiff rested?

Is there any other witness who will be unable to be here tomorrow?

MR. HALL: No.

THE COURT: Then let the plaintiff finish its case.

MR. ROBSON: The plaintiff calls Arthur H. Seidel.

ARTHUR H. SEIDEL

called as a witness by Plaintiff, having been duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. ROBSON:

Q What is your full name, please?

A Arthur Harris Seidel.

Q Are you an attorney, sir?

A Yes, I am a member of the bar of this Court as well as a member of the bars of the States of Pennsylvania and New York.

THE COURT: I suggest you ask the witness' address. We always do here.

Q Would you give us your address, please?

A 5125 Winfield Avenue, Philadelphia, Pennsylvania.

Q Would you state briefly your educational background?

THE COURT: He is a member of the bar. That is enough.

MR. ROBSON: Maybe I should explain, Your Honor, I intend to qualify him as an expert on patent law and chemistry.

THE COURT: Then suppose you ask him questions pertaining to that only; make them a little more specific.

BY MR. ROBSON:

Q Would you state your educational background with respect to your relationship with the fields of chemistry and patent law?

A In chemistry I graduated from the College of the City of New York in 1942 with a Bachelor of Science Degree in chemistry. I received a Master's Degree from the University of Michigan in 1943. My master's thesis dealt with the use of thermoplastics for preserving zoological specimens and involved the cutting of thermoplastics into fine films.

After the war I instructed for a year at the University of Iowa in chemistry while working on a Ph.D.

I have been educated continuously since then, since I represent a number of chemical companies, including --

THE COURT: Do you practice patent law, sir?

THE WITNESS: Yes, sir.

THE COURT: Well, I think that is enough.

How long have you been a patent lawyer?

THE WITNESS: I was admitted to practice before the Patent Office in 1947, Your Honor.

THE COURT: How long have you practiced patent law?

THE WITNESS: Since 1947.

BY MR. ROBSON:

Q You have before you, do you not, a copy of the patent in suit, Mr. Seidel?

A Yes, sir, I do.

Q And are you the attorney who prepared the patent application in connection with that patent?

A Yes, I am.

Q And was the application patented by your associate, Mr. Edward Gonda, at the Patent Office?

A Yes, Mr. Gonda, who was an associate of mine up until 1964, prosecuted this application. He has been my partner since 1964. This patent issued in November '61, so he would have prosecuted it for a period of about two years. He joined me in the beginning of 1960.

Q And is your firm the firm which prepared the law suit in this action?

A Yes, it is.

Q When did you first hear of Mr. Wolowitz and the Spellright Corp., if you can recall?

A In 1961, in October, I received a request --

THE COURT: All you are asked for is the date.

THE WITNESS: I'm sorry, Your Honor. October 1961.

BY MR. ROBSON:

Q What occurred in October 1961?

A I received a request from my client, Mr. Walter Ploeger, Jr., to contact an attorney named Homer Montague regarding a client of his, the Spellright Corp., who wished to enter into some sort of license in respect to the patent which was about to issue on the patent application which issued as the patent in suit.

Q And did you take any steps pursuant to that request from your client?

A Yes, sir, I wrote Mr. Montague a letter.

THE COURT: You wrote to whom?

THE WITNESS: Mr. Montague, the attorney for Spellright.

Q Did you receive a reply from Mr. Montague in response to your letter?

A Yes, sir, I did. His reply, I believe, is dated October 18, 1961.

MR. ROBSON: May we mark -- counsel has already seen them.

THE COURT: Don't waste time on formal proof.

MR. ROBSON: Counsel has already seen them, Your Honor.

MR. HALL: No objection.

THE COURT: In this courtroom we don't consume time on formal proof of documents. After all, that is for moot court practice.

MR. ROBSON: Unfortunately, all judges are not so understanding of the problems of trying a case.

THE COURT: Are you offering these in evidence?

MR. ROBSON: Yes, I am offering them in evidence.

THE COURT: Let them be admitted.

(Letter of Oct. 4, 1961 from Mr.

Seidel to Mr. Montague marked Plaintiff's Exhibit No. 19 and received in evidence;

Letter of Oct. 18, 1961 from Mr.

Montague to Mr. Seidel marked Plaintiff's Exhibit No. 20 and received in evidence.)

THE COURT: Will you suspend a moment while I read

these exhibits. (Pause.)

Very well, you may proceed.

BY MR. ROBSON:

Q The letter of October 4th refers to a patent application of your client, Serial No. 813,300. Is that the application for the patent in suit?

A Yes, it is.

Q Subsequent to the receipt of the letter from Mr. Montague dated October 18th were any further steps taken by you with respect to either licensing the Spellright Corp. to use that patent or with respect to obtaining a license for the Spellright Corp. to use its patent?

A No, I had no further contact with the Spellright Corp. or any of its agents or attorneys until September 1962.

Q Did you have any conversation with anybody with respect to licensing agreements after that letter of October 18?

A Yes, I had a conversation with my client, Mr. Walter Ploeger, Jr.

Q Was that conversation with respect to the preparation of any licensing agreement?

A No, it was simply a letter from Mr. Ploeger stating -- it was a conversation and then a letter from him stating his views on the subject matter. But I was never

authorized by him to prepare any license agreement with the Spellright Corp.

Q When next did you either see or hear from or hear about Mr. Wolowitz or the Spellright Corp.?

A Well, I had a meeting with Mr. Wolowitz and Mr. Montague in my office on September 19th, 1962.

Q And who arranged for that meeting, if you know?

A I did not arrange it. Any knowledge I would have would be hearsay, but I believe Mr. Ploeger and Mr. Wolowitz arranged it.

Q Who was present at that meeting?

A Representing Spellright there was present Mr. William Wolowitz and his patent attorney, Mr. Homer Montague, and representing Filmon Process at that meeting was myself, Mr. Walter Ploeger, Jr., Mr. William Brunner, and Mr. Zacre Loozis.

Q And who was the last named individual?

A The last named individual was the accountant for Filmon Process Corp.

Q Would you tell the Court, to the best of your recollection, what was said at that meeting and by whom it was said?

A Well, the meeting started at about 5:30 or quarter

to 6 in my office. I didn't know anything about the subject matter of --

THE COURT: No, the question is, what was said and by whom.

THE WITNESS: Sorry, Your Honor. You are absolutely correct.

There was a fair degree of discussion between Mr. Wolowitz, Mr. Montague, and myself, and Mr. Ploeger. I endeavored to ascertain from Mr. Montague whether Mr. Wolowitz had any issued patents on a combination typewriter ribbon and correcting device. I was advised by Mr. Montague that there were no issued patents to Mr. Wolowitz on this construction. I asked Mr. Montague whether there were any allowed claims in any patent applications on this construction and he advised me there were not.

MR. HALL: I move to strike this as hearsay. He is trying to quote Mr. Montague as to whether there were any allowed claims or anything of the kind.

Now, the records of the Patent Office show there were allowed claims.

THE COURT: But that does not make the testimony inadmissible. It may be erroneous but not inadmissible.

MR. HALL: This is hearsay.

THE COURT: Oh, no, this is not hearsay. I take it that what was said at that conversation is not proof of the facts contained in the conversation but proof of the negotiations.

MR. ROBSON: Yes, sir; in addition to which the defendant was present during that conversation.

THE COURT: That doesn't affect the matter.

You are not introducing this as proof of the facts mentioned in the conversation?

MR. ROBSON: No, sir, we are not attempting to prove the facts.

THE COURT: Then it is not hearsay. Objection overruled.

THE WITNESS: After this discussion between Mr. Montague and myself, Mr. Wolowitz asked Mr. Ploeger and myself whether Spellright could obtain an exclusive license for the field of combination typewriter ribbons and self-correcting ribbons in respect to the patent in suit. Mr. Ploeger advised Mr. Wolowitz, in my presence, that he could not give anyone an exclusive license.

Subsequent to this we went to dinner and there further discussions ensued. Mr. Wolowitz reiterated his request for an exclusive license and again Mr. Ploeger

rejected it and again that was in my presence.

Then Mr. Wolowitz said, I would like to buy the patent outright. I remember Mr. Loozis' comment, That will take a lot of money. And Mr. Wolowitz said money was no consideration.

THE COURT: What was that?

THE WITNESS: Mr. Loozis, the accountant, said that would take a lot of money. Mr. Wolowitz said money was no consideration. But again Mr. Ploeger rejected Mr. Wolowitz' offer to purchase the patent. And then Mr. Wolowitz said, in my presence, I am going to infringe the patent and I am going to break the patent. And I said to Mr. Wolowitz, If you infringe this patent, sir, we shall sue you.

Notwithstanding this we had some very pleasant conversation. If I am asked to include all the conversation I must say that I spoke at some length with Mr. Montague over mutual friends in common. He and I have both been patent attorneys for a fair length of time and we matched notes on people we knew and that sort of thing.

BY MR. ROBSON:

Q When did you first -- withdraw that.

Is that the sum and substance of the conversation as you best recall it?

A Yes, it is, sir.

Q When did you become aware of any of the facts which led to the institution by you of this law suit?

A In the latter part of May I received a telephone call --

THE COURT: Of what year?

THE WITNESS: In the latter part of May 1963 I received a telephone call from Mr. Walter Ploeger, Jr., in which he advised me that he thought that the patent in suit was being infringed by Spellright Corp.

I advised him that before any suit could be started we would have to establish infringement and that to do this he would have to make a purchase of an infringing ribbon. Sometime thereafter --

THE COURT: I think you have answered the question.

BY MR. ROBSON:

Q Did you thereafter receive a further communication from Mr. Ploeger with respect to the facts giving rise to this law suit?

A Yes, sir, I did.

Q And when was that?

A In the first week in June of 1963.

Q What occurred at that time?

A Mr. Ploeger advised me that he had purchased --and on this my recollection is not exactly exact; I knew he purchased one, but I don't remember whether he purchased several-- but he advised me that he purchased at least one ribbon from Abraham & Strauss, a department store in New York, which he said infringed his patent.

MR. HALL: I move to strike this as hearsay.

THE COURT: Motion granted.

BY MR. ROESON:

Q Did Mr. Ploeger thereafter deliver to you an article, a ribbon?

A Yes, he did.

Q And is that the ribbon which was identified as Exhibit 10 in this case?

A I believe it's Exhibit 11.

Q Exhibit 11. Excuse me.

A To the best of my knowledge and belief, it is.

Q How soon after this telephone conversation was that ribbon delivered to you?

A It was either one day or two days later. I don't recall that at this moment.

Q Did you subject that ribbon to any tests?

A I examined that ribbon very thoroughly.

Q Would you describe as briefly as you can the examination?

MR. HALL: Your Honor, I object to this unless it's proved that that is our ribbon, because there is no proof of that and while he says that Exhibit 11 is the same thing Mr. Ploeger sent to him, I think the record will show -- if I could examine the witness I think I could prove that he hasn't seen it for years, and there have been all kinds of these ribbons around here. This ribbon has not been in their possession, in the possession of his firm, during all this time.

THE COURT: Let me see Exhibit 11. That was identified by Mr. Ploeger.

MR. ROBSON: Yes, sir.

THE COURT: As what?

MR. ROBSON: As the ribbon which he purchased in Abraham & Strauss and which was contained in the box which is Exhibit No. 10.

MR. HALL: I don't think Mr. Ploeger testified to that. I think he said that the ribbon had been out of his hands for years.

THE COURT: He testified to that too.

I am not now passing upon the probative value of the testimony. All I am passing on is the question whether

there is a chain of possession, prima facie evidence of a chain of possession.

When did you test this ribbon, Mr. Seidel?

THE WITNESS: The first week in June 1963, Your Honor.

THE COURT: How can you tell that this is the same ribbon as the one that you tested?

THE WITNESS: We cut off lengths of the ribbon, and I have been advised, Your Honor, by my partner that this is the ribbon. I can't testify on firsthand knowledge --

THE COURT: You did not mark it in any way? It wasn't marked in any way?

MR. ROBSON: Marked by whom, Your Honor?

THE COURT: Well, by the witness.

MR. ROBSON: Not by this witness, no, sir.

THE WITNESS: No, it was not marked by me, Your Honor.

THE COURT: Well, was there a mark on it which enables you to identify it?

I have in mind, Mr. Robson, the type of evidence of continuity of possession which you no doubt offered in many a criminal case and there is never any difficulty there because the persons concerned always put their initials or their marks

on the article.

Well, there is no evidence that he tested Plaintiff's Exhibit 11. He testified that he tested a ribbon handed to him by Mr. Ploeger.

MR. ROBSON: That is correct.

THE COURT: Mr. Ploeger testified that he bought that at Abraham & Strauss. Did he testify that he handed it to Mr. Seidel?

MR. ROBSON: Yes, he did.

MR. HALL: I don't think Mr. Ploeger said he ever turned this over --

THE COURT: Well, I am going to take the testimony. I shall take it as not necessarily relating to Plaintiff's Exhibit 11 but to a ribbon which the witness says was handed to him by Mr. Ploeger which Mr. Ploeger said to this witness he had bought at Abraham & Strauss.

That is a pretty weak proof of a chain of possession, as you know.

MR. ROBSON: I think I may be able to tighten it up with one more witness after this.

THE COURT: Very well. It may prove to be unimportant. You may proceed.

MR. ROBSON: I believe I had asked you a question.

THE COURT: I think the question was something as to whether he had tested the ribbon.

BY MR. ROBSON:

Q What were the tests?

A Could I have the ribbon? Perhaps I could show you with my fingers what was done.

(The ribbon was handed to the witness.)

A I am very familiar with the --

THE COURT: The question is what did you do to test it.

THE WITNESS: Well, we snipped off sections of the ribbon and then I split the ribbon that had been snipped off.

This one is already broken, Your Honor, so it won't be necessary to split it. In my right hand is the correction portion, which has the blue backing on one side and the white correction masking material --

THE COURT: I don't think the witness needs it, and I do. Suppose you get it for me. He can explain it without holding it but I can't follow the explanation unless I have it.

Now proceed, Mr. Seidel.

THE WITNESS: Yes, Your Honor. When the ribbon is

split it consists of two parts.

Your Honor, may I ask the Court's indulgence? I could point this out on the chart.

THE COURT: Surely. You can go to the chart.

THE WITNESS: Your Honor, the ribbon was split at this point here, which is the center point between the two charts; this is one chart and this is the other.

THE COURT: That chart doesn't help the Court very much because it is too enlarged.

I have before me the actual ribbon.

THE WITNESS: Well, the side that is on this panel of the chart, Your Honor, is the side that has the camouflage--

THE COURT: I think you better go back to the witness chair because that diagram does not help the Court. There are things on that diagram that are not visible except through a microscope. If it was a diagram that just enlarged what I had before me it would be helpful. I think you understand.

THE WITNESS: Yes, I do, Your Honor.

There are two parts to the ribbon when it is split.

THE COURT: When you say split, do you split it longitudinally?

THE WITNESS: Yes, when split longitudinally. One

part, Your Honor, is colored blue and white and that includes the camouflage or the correcting material. The other part, Your Honor, is the typewriter ribbon per se.

I addressed my attention to the typewriter ribbon per se, the part other than the part which is white and blue.

THE COURT: In other words, the black part.

THE WITNESS: That is correct, Your Honor.

I ran a micrometer on the inked portion of the black part and I got a reading of about two and a half mils, as near as I can recall it, two and a half thousandths of an inch. I know of my own knowledge that in 1963 when I did this there was no other material commercially available in a woven fabric of that thickness other than nylon.

Nylon, Your Honor, can be pulled -- it's made by extruding it through a drawn spinnerette, but it can be pulled to a much finer degree of fineness than any other filament. Silk is very fine, but one cannot get a silk fiber that is as fine as a nylon fiber.

This is an exceedingly thin ribbon, two mils, three mils; I have forgotten the exact order. In any event, that degree of fineness is not available in silk.

THE COURT: I think you are going off on a tangent. Tell just what you did to test the ribbon.

THE WITNESS: Then I examined the manner in which the film portion -- the inked ribbon consists of a fabric which is a woven fabric, the warp and the woof, Your Honor, and then an impervious transparent film. I examined the manner in which the film was joined to the fabric, and it was joined only at the extreme edges by a weld.

If the fabric was nylon, Your Honor, there is virtually no other material that can be readily welded to nylon other than itself.

Now if I could digress here I could establish how I knew it was a weld and how I knew that this particular ribbon was not one of my client's manufacture. May I have the Court's indulgence on that?

BY MR. ROBSON:

Q Is this in answer to the question?

A Yes, this is in answer to the question.

We have in our office a binocular microscope which has a 45 power lens. It actually has three lenses but the most powerful one is 45 power.

I had been advised by my client, Mr. Ploeger, that every ribbon which he had ever cut and which was delivered to Spellright had been cut by the hot knife method, in which a hot knife comes down and contacts first the film and then the

fabric. When this material is cut and fused in this manner there will be a shiny surface at the point of the film where the knife first contacts it, due to the fusion.

The typewriter printing portion which I examined under the binocular microscope had a shiny surface on the fabric side. Therefore, it was quite clear to me --and I have been in Mr. Ploeger's installation where he does this cutting and fusing-- that it had been cut by the knife hitting the fabric first and then the film. That meant it had not been processed by Mr. Ploeger's company or any of the companies with which he is related.

MR. HALL: Your Honor, I move to strike that portion of his answer where he quoted Mr. Ploeger. He said that Mr. Ploeger told him he had never cut anything other than from the fabric into the film.

THE COURT: What Mr. Ploeger said to the witness would be admissible as an admission against interest.

MR. HALL: If I wanted to rely on it, it would be.

THE COURT: Oh, Mr. Ploeger. I was thinking of Mr. Wolowitz.

Objection sustained.

THE WITNESS: I pulled the film and the fabric apart to satisfy myself that it was a weld.

I examined the woven fabric to see that it was

absorbent to ink, and it certainly held ink.

I tested to see whether it was pliable, and I satisfied myself that the film was not one of the other films that were then commercially available, such as mylar.

Mylar, for example, is sold in these thin films but it will not stretch. If you pull on mylar it won't stretch. That enables mylar to be used for magnetic tapes. I know of my own knowledge that one cannot weld a mylar to nylon fabric, and I dismissed it as being mylar. I also dismissed it as being polyethylene, which is another common film.

I have had a great deal of experience, Your Honor, in the welding of polyethylene. We represent a client who does a lot of that.

I satisfied myself, based on my experience and, as I say, I have written a large number of cases on nylon patent applications and once brought a suit in respect to it, that this was a nylon film welded to a nylon fabric.

BY MR. ROBSON:

Q Do you recall any other test or examination which you made on the product?

A We ran both the fabric and the film through a micrometer. I consulted with Mr. Ploeger. I don't recall the time we did this, but we made a visual examination in

which we made a thread count so that we could identify the particular nylon fabric.

Q Do you recall examining for the purpose of ascertaining whether there was any bleeding from one side to the other?

A Oh, yes. The thing that interested me about the construction that I examined was that it was of relatively poor quality. The weld at the center was bad, it tended to split. The workmanship on it was bad. The film, in particular, was somewhat puckered. The reason why it was puckered was, at least in my opinion, was that when it was welded the humidity conditions were not appropriate.

I compared it with materials which Mr. Ploeger had welded and the quality of the construction was far below the materials which Mr. Ploeger had welded.

Q I take it it was your conclusion as a result of these examinations that this ribbon had not been -- the printing portion had not been manufactured by the plaintiff?

A Yes, that was my conclusion.

MR. HALL: That I think is objectionable. How would he know that?

THE COURT: He is testifying as a patent expert but I think even so, that is beyond the scope of his expertise.

MR. ROBSON: He is also testifying as an expert in chemistry.

THE COURT: Yes, I know, but I don't think it is within the expertise of a chemist to express an opinion as to what manufacturer manufactures a particular chemical.

I think we will take our usual mid-afternoon recess at this time.

(Recess.)

THE COURT: Mr. Robson, will you refresh my recollection as to just what Plaintiff's Exhibit 17 represents?

MR. ROBSON: Plaintiff's Exhibit 17 is a ribbon which was delivered to the plaintiffs at a deposition, by the defendants, as one of the ribbons which is similar to the ribbon purchased in A&S, one of the ribbons sold by the defendant.

THE COURT: There wasn't any testimony about 17, was there?

MR. ROBSON: There was no testimony about 17, Your Honor.

THE COURT: That is the reason I can't find anything about it in my notes.

MR. ROBSON: You are absolutely right. 17 will tie up with the exhibit which I just introduced through --

THE COURT: Just a moment. What was 17, what is it?

MR. ROBSON: That is the ribbon.

THE COURT: But what is it?

MR. ROBSON: It was a ribbon delivered to the plaintiffs at one of the depositions as a ribbon which was sold by the defendants.

And Exhibit 18 is a list of the stores to which Exhibit 17 was sent.

THE COURT: Do you claim that 17 is an infringement?

MR. ROBSON: Yes, sir.

THE COURT: Why don't you confine your test to 17, because I think there is grave doubt about 11. I think your proof of continuity of possession is weak on 11 and if your proof of infringement was based solely on 11, I would be strongly inclined to hold that there is no proof of infringement because there is insufficient identification of the fact that No. 11 came from the defendants.

MR. ROBSON: I think Your Honor is correct and I hope to try to tie that one up a little tighter.

Unfortunately, this witness has not examined that exhibit, Exhibit 17. Mr. Ploeger --

THE COURT: I see. The trouble with 11 is that your clients didn't seal No. 11 and put an identifying mark on it.

MR. ROBSON: Enough was done so that I think I can satisfy Your Honor of the chain of possession through one more witness.

THE COURT: Well, you haven't rested your case, but certainly there is no proof so far that No. 11 was the ribbon purchased by Mr. Ploeger from Abraham & Strauss Department Store because there are too many gaps in the chain of possession. Moreover, there is not sufficient proof that even if it was purchased at Abraham & Strauss Department Store -- in fact, there is no proof at all, that it was manufactured by the defendant.

MR. ROBSON: That is correct.

THE COURT: I think you are wasting time when you are giving testimony concerning 11. In fact, I am going to exclude any further testimony concerning 11, in the interest of saving time, unless you first prove continuity of possession.

MR. ROBSON: I wonder if I could have Exhibit 17 so I could let the witness testify about it.

THE COURT: Very well.

THE WITNESS: Can I testify from Exhibit 17?

THE COURT: I am sure that if your clients had your guiding hand at that time they would prove continuity of possession.

MR. ROBSON: We would have initialed everything in sight, Your Honor.

THE WITNESS: Your Honor, I wish I had been a criminal lawyer before I had been a patent attorney, so this would never have happened.

THE COURT: You may proceed.

BY MR. ROBSON:

Q Mr. Seidel, you have in your possession now Exhibit 17. I ask you whether you can determine by visual examination of Exhibit 17 whether it is constructed in the same manner as the product covered by the patent in suit?

A I wonder if I could have -- yes, I can. I can certainly make that determination.

Q Do you need any equipment to assist you?

A Yes, I would like to check --

THE COURT: We are not going to devote court time to that, Mr. Robson, if the witness has to take time out to make any test.

THE WITNESS: It will take me five seconds, Your Honor.

MR. ROBSON: I believe he wants some sort of a glass.

THE WITNESS: I want a micrometer.

THE COURT: Very well.

(Pause.)

THE WITNESS: Yes.

THE COURT: Now I want to be sure there is no misunderstanding. Plaintiff's Exhibit 17 is admittedly a ribbon sold by the defendants?

MR. HALL: That is right.

THE COURT: Very well.

MR. HALL: Your Honor, I want to correct that. We sold such ribbons, but then at a later date, when they asked us for a specimen, we got Exhibit 17 from the factory. It was one that had been --

THE COURT: 17 was a sample of what you were selling?

MR. HALL: You see -- yes, what you are saying is correct.

THE COURT: I want to pinpoint it. Do you stipulate that 17 was identical with what the defendant was selling?

MR. HALL: Right; that is the correct way to say it.

THE WITNESS: Your Honor, I am satisfied --

MR. ROBSON: I haven't asked a question yet.

BY MR. ROBSON:

Q On the basis of the examination you have just conducted can you say whether or not that ribbon is a ribbon

identical with the product covered by the patent in suit?

A Yes, I can.

Q And what is your statement?

A My statement is that this Plaintiff's Exhibit 17 clearly infringes claim 1 of the patent in suit.

THE COURT: Well, that is what the Court has to decide, not the witness.

THE WITNESS: You are absolutely correct, Your Honor.

THE COURT: You are a witness, not counsel, Mr. Seidel.

I think you can ask the witness to describe the structure, just as he did with Exhibit 11, and then the Court will decide whether that is an infringement.

BY MR. ROBSON:

Q Will you compare the structure of the Exhibit 17 with claim 1 of the patent?

A Yes, I will, Mr. Robson.

Exhibit 17 consists of a combination printing ribbon and self-correcting ribbon with a weld running longitudinally down the center --

THE COURT: You are not getting daily copy here, so I have to get this. And I am not suggesting that you should get daily copy, but I am suggesting that that is a

reason for going slowly.

MR. ROBSON: We tried to get daily copy but, unfortunately, there aren't enough reporters available.

THE COURT: I wouldn't put you to that expense.

Read the answer as far as it has gone, please.

(The Reporter read the answer as follows:

"Exhibit 17 consists of a combination printing ribbon and self-correcting ribbon with a weld running longitudinally down the center --")

THE COURT: Very well.

THE WITNESS: -- which separates the printing portion and the self-correcting portion into two halves.

Directing my attention to --

THE COURT: Don't direct your attention to anything; just describe this structure.

THE WITNESS: The printing portion consists of a strip of flexible, pliable and absorbent woven nylon. Now, I am satisfied that it is absorbent because it retains ink and when I press it the ink runs off on my fingers --

THE COURT: Don't go so fast. It is just useless to go so fast with all that technical matter.

I think you better order overnight a transcript of this answer because this is very vital.

Now proceed.

THE WITNESS: Could you read as far as --

THE COURT: No, you proceed. The only person who can ask the Reporter to read anything is the Court.

THE WITNESS: The printing portion comprises a flexible, pliable, it's both flexible and pliable absorbent woven nylon. I know it's absorbent because there is ink on it which, when I squeeze it between my fingers, as I am doing thusly, is discharged onto my fingers and colors them.

There is an elongated strip of a flexible, and I am flexing it, pliable, and I am plying it, imperforate, and it is clearly imperforate because the ink doesn't come through it when I press on it from above --

THE COURT: Please don't give us reasons. First describe the structure. And don't tell us what you are doing, just describe the structure. We want you to describe the structure.

THE WITNESS: It's an absorbent woven nylon. There is an elongated strip of flexible, pliable, imperforate, ink impervious nylon film, with both of these strips being in juxtaposed or facing relationship along their entire length. These two strips are welded together only along their extreme edges, both of the strips making up the printing ribbon of the same width, and with the absorbent woven nylon impregnated

with ink.

THE COURT: Can't you give us a brief description of it?

THE WITNESS: Yes, Your Honor.

THE COURT: I think the witness isn't prepared. You have taken the witness by surprise, Mr. Robson.

MR. ROBSON: Unfortunately, Your Honor, the worst witnesses in the world are fellow attorneys, as much as I love them.

THE COURT: You are absolutely right. But he is also a chemist.

MR. ROBSON: Yes, he is, but an attorney first.

THE COURT: Frankly, I have lost track of the answer.

THE WITNESS: To answer your question briefly, Your Honor, there are two strips --

THE COURT: You gave a perfectly simple description of Exhibit 11. Now why can't you give us as simple a description of Exhibit 17?

And I am not going to waste any more time. I am going to tell the witness to come back tomorrow and go on to something else so that he can prepare his answer, unless he can give it briefly now. I don't think it is fair to the Court

and to other litigants who are waiting to be heard.

THE WITNESS: Briefly, Your Honor, there are two strips, each of the same width. One strip is woven with warp threads running lengthwise and woof threads running sidewise, and the other strip is an impervious film, and these two strips are joined by welding only along their extreme edges and the woven strip is impregnated with ink.

Now I can further describe their properties --

BY MR. ROBSON:

Q That is a description of the article, I believe.
In your opinion is the article --

THE COURT: Just a moment. Has he finished the answer?

MR. ROBSON: I think so.

THE COURT: Have you finished the answer?

THE WITNESS: Yes, Your Honor.

THE COURT: Read the last answer.

(The Reporter read the last answer.)

THE COURT: Are they alongside of each other or on top of each other?

THE WITNESS: They are on top of each other, Your Honor. And I would like to add one additional thing to my answer, in my opinion both of these strips are nylon.

THE COURT: Very well.

BY MR. ROBSON:

Q Mr. Seidel, one further question. With respect to Exhibit 11, that is, the ribbon which you testified having received from Mr. Ploeger, Jr. --

THE COURT: Just a moment before you go on.

Did you say both strips are nylon, one on top of the other?

THE WITNESS: Yes.

THE COURT: And they are welded together?

THE WITNESS: Yes.

THE COURT: All the way along?

THE WITNESS: All the way along their extreme edges, Your Honor.

THE COURT: All the way their entire width, or not?

THE WITNESS: The entire width.

THE COURT: The entire length and the entire width?

THE WITNESS: They are welded along the entire length of the two strips, but they are only welded at the extreme edges.

Q With respect to Exhibit 11, which has been identified herein -- withdraw that.

You testified to having received a ribbon from Mr.

it has been called, doesn't extend all the way across, does it? Is it limited to backing up only the printing ribbon, or does it extend to the correcting ribbon?

THE WITNESS: Well, there is a weld, Your Honor, between the film and the ink impregnated ribbon at the center. You see, this ribbon is a half-inch wide.

THE COURT: Yes, I understand. But back of the printing ribbon is another layer of nylon, is there not?

THE WITNESS: Yes, there are two layers; the printing ribbon is an ink impregnated ribbon and a layer of impervious nylon film.

THE COURT: Yes. My question was --perhaps it wasn't very clear-- does that back film, if I may call it that, extend all the way across both the printing ribbon and the self-correcting ribbon, or only across the printing ribbon?

THE WITNESS: Well, this is a very -- can I answer this without a yes or no, because I have to explain it, Your Honor.

THE COURT: Surely.

THE WITNESS: There is a film across the correcting part of the ribbon and there is a film across the printing part of the ribbon and the two are joined together by a weld. So, if you include the weld which separates the two, there is

a film across the whole half-inch face.

THE COURT: What I want to know is whether the film extends only half of the entire structure, that is, only across the printing section, or across both the printing section and the self-correcting section.

THE WITNESS: There are two films, Your Honor. There is a film which extends only across the printing section, and that is welded to the edge of the film which extends across the correcting section. So, these two films are joined together --

THE COURT: You mean each half of the ribbon has a separate film back of it?

THE WITNESS: Yes, there is a weld in the middle.

Now it is a question of semantics whether when you weld two things together --

THE COURT: But my question is so simple. Does the back film extend over the entire --

There are two halves to this ribbon; one is the printing half, and the correcting half, is that correct?

THE WITNESS: That is correct.

THE COURT: There is a film back of it.

THE WITNESS: That is correct.

THE COURT: There are three possibilities. One is

that there is a film only wide enough to be back of the printing ribbon, there is a possibility there is a separate film back of each of the two halves, and there is a possibility there is a single film wide enough to back up both halves. Now which is it?

THE WITNESS: It's number two, and the two films are welded together at the center.

THE COURT: In other words, each of the two halves has a separate film to back it up?

THE WITNESS: That is correct.

THE COURT: And the two films are welded together?

THE WITNESS: Together at edge-to-edge relationship.

My two fingers are each film --

THE COURT: You mean there are three welds, then, is that it, one at each edge of the ribbon and one in the center -- I mean of the entire ribbon?

MR. ROBSON: I believe what happens is the weld which is at the middle edge of the printing ribbon is the same weld which connects the film edge of the connecting ribbon. It serves two purposes.

THE COURT: There are two halves to the ribbon?

THE WITNESS: Yes, Your Honor.

THE COURT: And each one has a separate film back of it?

THE WITNESS: That is correct.

THE COURT: And there is a weld at the top edge and the bottom edge and in the center, is that correct?

THE WITNESS: Well, I can't be absolutely certain as to whether there is a weld at the bottom edge because I don't know whether the correction material is welded to the film at the bottom edge.

THE COURT: But, anyway, that part of the film which backs up the printing ribbon is welded at its top and its bottom, is that it?

THE WITNESS: That is correct, Your Honor.

BY MR. ROBSON:

Q Just one last question. I show you Exhibit 10 and ask you whether that is the box in which the ribbon was placed which you received from Mr. Ploeger in June 1963?

A The best I can answer this is it appears to be. It has Abraham & Strauss on it. If it came from our office --and I gave this box to Mr. Gonda-- it would appear to be. But I certainly didn't mark it and I can't swear for a certainty.

MR. ROBSON: I have no further questions at this time.

THE COURT: Mr. Hall. Well, I do want to ask one question before you start your cross-examination.

Mr. Seidel, the back layer, what I call the back

layer or you call the film that backs up the printing ribbon, I want to be sure, does the weld extend the entire width of the film or is it limited to the edges?

THE WITNESS: The weld is only at the edges, Your Honor.

THE COURT: I see. Very well.

THE WITNESS: Only at the edges.

THE COURT: You may proceed, Mr. Hall.

MR. ROBSON: There was one more question, if Your Honor please, just one more thing I wanted to get into the record. May we mark this book? Perhaps without marking the book we can --

BY MR. ROBSON:

Q Let me show you a book entitled Man Made Fibers by R. W. Moncreef and I ask you whether that is a recognized authority on the subject of man made fibers?

A Yes, this is considered to be a classic in the field.

Q And does that book contain any statements about properties of nylon which are material to the issues in this action? I direct your attention to page 323.

THE COURT: Mr. Robson, I don't think that is admissible on direct examination. It is proper to question the witness concerning books on cross-examination to test his

credibility, but a book is not evidence.

BY MR. ROBSON:

Q Are you familiar, Mr. Seidel, with the properties of nylon fabric?

A Yes, I am.

Q And can you tell us whether, if ink is placed in nylon fabric, in ordinary nylon fabric, it will spread during rest periods, that is, periods when it is not being used, from worn to unworn parts, as rapidly as cotton or silk?

A No, it will not. This has been one of the failings of --

THE COURT: You have answered the question.

THE WITNESS: I'm sorry.

Q Did you make a search at any time in the Patent Office to ascertain whether or not there were on file any patents owned by either William H. Wolowitz or the Spellright Corp.?

A Yes.

Q When did you make that search?

THE COURT: How is that relevant?

MR. ROBSON: I hope to establish -- it is relevant to establish that at the time of the use of the inserts with the identification Patented Construction there were no patents

outstanding for either --

THE COURT: They don't claim that there was.

MR. ROBSON: I didn't get that -- if they so stipulate, I will drop the question.

THE COURT: In any event, that might be good rebuttal, if necessary.

MR. ROBSON: All right, then I have no further questions.

THE COURT: Mr. Hall.

CROSS-EXAMINATION

BY MR. HALL:

Q Mr. Seidel, you were the attorney that filed this suit, were you?

A Yes, I was.

Q And you continued as attorney at least up to the pretrial conference?

A No, I did not. I took no active part in the suit. I turned it over to Mr. Gonda because I felt that since I was going to testify in this case he should handle it.

Q And your partner has been the attorney from then on up till now, and he is right here at the counsel table?

A He has been one of the attorneys.

Q You are the attorney who prosecuted the application

for patent in suit?

A As I said, I wrote the patent application. Mr. Gonda and I worked on the prosecution of it.

Q I'd like to refer to page 27 of the file wrapper, which is Plaintiff's Exhibit 1.

MR. HALL: I have extra Xerox copies.

THE COURT: I have the file wrapper here.

BY MR. HALL:

Q Mr. Seidel, is that your signature at the bottom of the page?

A Yes, it is.

THE COURT: What page?

MR. HALL: 27.

Q I would like to read the remarks that appear immediately above your signature and ask you if the statement in these remarks is correct from the scientific or technical standpoint:

"Claim 15 has been added because there are materials, as indicated in the specification (first sentence of second paragraph of page 4) other than nylon which may be fused to the impervious nylon film, and which may perform satisfactorily in the present invention."

Is that a correct statement?

quoted from page 27 uses the words may, may be fused, and which may perform satisfactorily.

I don't know of every material in the world and there may very well be such materials, and claim 2 was added for that purpose.

The only materials I know in which you can fuse the two together with both of them being melted at the point of fusion is nylon to nylon.

THE COURT: I don't think you are answering the question, Mr. Seidel.

MR. HALL: Could I withdraw the question and rephrase it? I think I can shorten this up.

THE COURT: Yes.

BY MR. HALL:

Q Mr. Seidel, would you look at the first sentence of the second paragraph of page 4 and tell us what materials are listed there other than nylon?

A Well, it calls for a flexible, pliable and absorbent material, which includes a large number of materials, and it gives specific examples such as a woven strip of cotton, silk, and then it lists nylon. These are exemplary of flexible, pliable and absorbent material.

Q Then when you said on page 27 that claim 15 has

been added because there are materials as indicated in the specification other than nylon, you were undoubtedly referring to cotton and silk, weren't you?

A Oh, no, no. You can't melt cotton and you can't melt silk. Now if you talk about fusing --

THE COURT: Just a moment. Please confine yourself to answering questions. You are a witness, not counsel.

THE WITNESS: Yes, sir.

No, I was not referring to the cotton or silk if by the thrust of your question you mean melting the two together.

THE COURT: Will you read the question, please?

(The Reporter read the last question.)

THE COURT: Now the question calls for a yes or no answer.

THE WITNESS: The answer is no.

THE COURT: We have had great difficulty all through this trial with people who don't know the word yes and don't know the word no.

THE WITNESS: The answer to that is no.

BY MR. HALL:

Q What materials were you referring to that are indicated in the specification at the first sentence of the second

the ribbon 10 of the present invention, the edges 14a of the impervious strip 14 are shown to be fused to the edges 12a of the absorbent strip 12, if the absorbent strip 12 is made of a fusible material, the edges 12a of the absorbent strip 12 may be fused to the edges 14a of the impervious strip 14."

Now did you write that sentence?

A Yes, sir, I did.

Q You say if the absorbent strip is made of a fusible material the situation is a little different. Now what could the absorbent strip be made of other than a fusible material and still work?

A In the present claims the case as originally filed intended to cover a much broader area than the present claims covered. The present claim 1 calls for both the film and the fabric --

THE COURT: I don't think you are answering the question at all.

THE WITNESS: Would you mind rereading the question?
I'm sorry, Your Honor.

THE COURT: I think we better --

MR. HALL: I will end my cross-examination.

THE COURT: Very well.

MR. HALL: No further cross-examination.

THE COURT: No redirect?

MR. ROBSON: No redirect, Your Honor.

THE COURT: Very well, you may step down.

Do you rest?

MR. ROBSON: I will have to call that one witness who will have to testify to two answers just to show the chain of title, and that is all. Then I will rest.

THE COURT: The reason I asked the question was because you said you had only one more witness.

How long will the defendant take? I am not trying to hurry you, I am just trying to get an estimate.

MR. HALL: I hope I can finish sometime tomorrow afternoon. We will cut it down just as short as we can.

THE COURT: Then I want you gentlemen to be ready to make your summing up arguments as soon as both sides rest.

I am saying this to you, Mr. Robson, because you are from another jurisdiction. I don't take briefs after the case is finished, I decide most cases at the end of the trial, or argument if it is a motion, and I don't recess for several days for summing up arguments. I like to have cases go on just as they go on with a jury trial. I thought I would

apprise you because in many districts they do things differently.

MR. ROBSON: I am glad you told me that. I think it is a good procedure. It is not used in the Southern District, although I think it is a wonderful procedure. It will save my digestion for several days.

THE COURT: I think it eliminates one of the big sources of law's delays.

(At 4:00 p.m. trial stood in recess,
to reconvene 10:00 a.m., October 5, 1967.)

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,

Plaintiff,

v.

SPELLRIGHT CORP.,
WILLIAM H. WOLOWITZ,

Defendants.

Civil Action 1514-63

Washington, D. C.

October 5, 1967.

The above cause came on for further trial before
THE HONORABLE ALEXANDER HOLTZOFF, United States District
Judge, at 10:00 a.m.

Appearances:

For the Plaintiffs:

MORTON S. ROBSON, ESQ.,
EDWARD C. GONDA, ESQ.,
IRVIN A. LAVINE, ESQ.

For the Defendants:

WILLIAM D. HALL, ESQ.

- - -

I N D E X

<u>WITNESSES</u>	<u>DIRECT</u>	<u>CROSS</u>	<u>REDIRECT</u>	<u>RECROSS</u>
GONDA, Edward C.	464	468		
GEIGER, Joseph A.	477	488		
NORTON, Robert A.	495	524	570	576
FARRELL, Harry H.	578	590		

<u>EXHIBITS:</u>	<u>IDENTIF.</u>	<u>IN EVIDENCE</u>
Defendants:		
8 - Copy of German Patent 966,174	478	478
9 - Translation of German Patent 966,174	478	478
10- Copies of patents to Stark, Francis, Markes, and German patent and translation	494	494
11-Copies of patent references cited by Patent Office	494	494
12- Letter of Dec. 18, 1961 from Mr. Ploeger to Mr. Wolowitz	586	

P R O C E E D I N G S

THE COURT: You may proceed, Mr. Robson.

MR. ROBSON: May I call Edward Gonda.

EDWARD C. GONDA

called as a witness by Plaintiff, having been duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. ROBSON:

Q What is your full name?

A Edward C. Gonda.

Q Are you an attorney admitted to practice in the State of Pennsylvania, Mr. Gonda?

A Yes.

Q And do you practice patent law in partnership with Mr. Seidel who testified here yesterday?

A Yes.

Q And have you been associated with Mr. Seidel in the prosecution of the action in suit here today?

A Yes.

Q In connection with the prosecution of that suit did you receive from Mr. Seidel at any time a ribbon and a box in which that ribbon was contained?

A Yes.

Q When was that?

A The early part of July 1963.

Q And was that a box which had been obtained from -- withdraw that.

What did you do with the box and with the ribbon when you received it?

A I kept it until March of 1964.

Q And where did you keep it?

A I kept it in the lower righthand drawer of my desk.

Q And what happened to that, what did you do with it in March 1964?

A I produced it at the deposition of Mr. Wolowitz, handed it to the court reporter and had it marked as an exhibit; the box and the ribbon were separately marked.

Q At the time you handed it to the court reporter did you place any marking on it in your handwriting?

A I placed white tags on the halves of the ribbon. The box I did not put any marking of my own handwriting at the time I handed it to the court reporter. Subsequent to marking by the court reporter there was a mark on the box.

Q And do you know what mark you put on the label on the ribbon, the tag on the ribbon?

A No. 13.

Q And do you know what mark was placed on the box by

the court reporter?

A 14, I believe.

Q I show you what have been marked here as Exhibits 10 and 11, 10 being a box and 11 a ribbon, and I call your attention to the penciled notation on 10 P-14, and to the tag with the penciled notation on 11 P-13, and I ask you whether those notations were placed on --

THE COURT: What are you showing to the witness?

MR. ROBSON: Exhibits 10 and 11, Your Honor, the box and the ribbon.

THE COURT: Plaintiff's exhibits?

MR. ROBSON: Plaintiff's exhibits.

BY MR. ROBSON:

Q Were those notations placed on those articles at the time of the deposition of Mr. Wolowitz in March 1964?

A Yes.

Q And were those articles then delivered to the court reporter?

A Yes.

Q For filing with the Court Clerk?

A Yes.

Q And when did you next see those articles?

A I retrieved them the first day of trial.

Q From the Court Clerk?

A Yes.

Q And did you then deliver them to me?

A Yes.

MR. ROBSON: No further questions, if Your Honor please.

THE COURT: In order not to consume time unnecessarily, of course you have a right to offer this evidence to show continuity of possession, but this is the ribbon which you contend was purchased from Abraham & Strauss.

MR. ROBSON: Yes, sir.

THE COURT: Very well. There is no proof here that Abraham & Strauss got it directly or indirectly from the defendant. They might have gotten it from somebody else, from some other manufacturer.

MR. ROBSON: That is correct, but the proof does establish that A&S did have it for sale, that the defendant did sell to A&S --

THE COURT: Let's assume that you establish continuity of possession from Abraham & Strauss down to this courtroom for Plaintiff's Exhibits 10 and 11. There is still a big gap. There has been no proof here that Abraham & Strauss purchased this article from the defendant, either

directly or indirectly. In other words, there is no proof that Plaintiff's 10 and 11 were manufactured by the defendant and unless you prove that, it seems to me it just a waste of time to show continuity of possession.

MR. ROBSON: I agree with Your Honor and it would be my position that that proof is established circumstantially by two facts: One, that the box is in all respects identical with the other boxes manufactured by the defendant and that the ribbon is; and number two, the exhibit which was introduced yesterday, Exhibit 18, which the witness Estelle Jacobs testified contained a list of stores to which ribbons were shipped, includes A&S as one of the stores which received Spellright ribbons.

THE COURT: Was this Exhibit 18 produced from the defendants' custody?

MR. ROBSON: Yes, sir, it was handed to us by counsel for the defendant.

THE COURT: Very well. Proceed in your own way.

MR. HALL: I will be very brief.

CROSS-EXAMINATION

BY MR. HALL:

Q Mr. Gonda, shortly after this suit was filed Mr. Seidel wrote letters to some of the stores asking that they

send in additional ribbons to your firm, is that true?

MR. ROBSON: I object to this as improper cross-examination.

THE COURT: I think that is outside of the scope of the direct examination.

MR. HALL: I want to show that their firm had a whole lot of ribbons around the place. They went on a campaign to try to get ribbons, so how do they know --

THE COURT: I think we are going a little far afield. I will sustain the objection.

MR. HALL: No further questions.

THE COURT: You may step down.

MR. ROBSON: At this time, if Your Honor please, the plaintiff rests.

THE COURT: Very well. Mr. Hall.

MR. HALL: Your Honor, I would like to move to dismiss the false marking charge on the ground that they have failed to make out a prima facie case. Indeed, they have proved by their own words that there was no false marking.

THE COURT: Which count is your motion directed to?

MR. HALL: Count 2, the false marking charge.

And I also move to dismiss the third cause of action relating to the trade secrets.

Now as for the false marking charge, the pretrial

order states their alleged case.

I'm sorry, Your Honor, if I fumble a little today, but I went home yesterday evening to get ready for today and the fellow that is going to argue that motion was unprepared and I had to spend a long time with him and I was up way late trying to get ready.

But, at any rate, if you will examine the pretrial order there is a grave question whether the pretrial order even states a prima facie case. It does not even say that any patented marking was done without the consent of the patent owner, which is a requirement of the statute. As you recall, the statute specifically says, who without consent of the patent owner.

Now I asked the Reporter to type up for me the testimony of Mr. Ploeger with respect to this charge, with respect to his alleged authorization. Can I hand these to Your Honor.

Now if you will look at the first sheet that you just read, that is what he testified to on the first day of the trial. That was a cart blanche authorization to use the word patented with anything that allegedly involved his invention. So if we accept his testimony --and I am not saying that ultimately we accept it-- but at any rate, for

the purposes of a motion to dismiss I am bound to accept what he had to say, as I understand the law, if you accept his testimony on the first day he said, Yes, go ahead, put the marking on.

Then the second day there was a highly leading question in which opposing counsel apparently is trying to close up the loophole left in the first day. But all that first question on the second page is, is Mr. Ploeger's mental attitude, because if you look at the second question on the second page, where counsel asked Mr. Ploeger just what he told Mr. Wolowitz, he says, If you use my invention you can mark it patented.

Now just how he can come in then and say this was done without his authorization -- as I would understand the law unless he made a reservation at the time he authorized the alleged marking, unless he reserved the right to rescind it, he could not rescind it. That is to say, if I tell somebody you can go ahead and mark my patent number on your device and I have no reservation to retreat or retract, then I don't think that I have the right to ever retract it because the man prints his literature, he is tooled up and he is going.

THE COURT: This is all part of the same conversation; this isn't a later retraction.

MR. HALL: That is right; but I mean there would be no room for retraction.

There was some suggestion later on that after the September meeting they asked him did he authorize it in September and he said no, he didn't authorize it in September, but he didn't say he retracted his prior authorization.

THE COURT: I presume that what the plaintiff's position is, so I infer from this testimony, that they did give permission to use those words on articles manufactured by the defendant provided they came from the plaintiff, but that they didn't authorize the defendant to use those words on infringing articles. I presume that is the position.

MR. HALL: Well, that is their position but that is not what they say.

THE COURT: Well, you know, I think the testimony, you are quite right, is ambiguous; but as a practical matter if I grant your motion you would not have the benefit of Mr. Kaufman's testimony and the testimony of Mrs. Jacobs because they were offered out of order as part of your case and the motion you are now making is as of the close of the plaintiff's case.

MR. HALL: That is right.

THE COURT: Now as I say, if I grant your motion at this time you will not have the benefit of the testimony

of those two witnesses.

It seems to me that the way this case has developed -- after all, a motion at the close of the plaintiff's case in a non-jury trial is, to some extent, addressed to the discretion of the Court in that even if the motion is technically well founded the Court has a right to prefer to take the entire testimony and reserve the matter until the end of the case.

I think it would be in the interest of justice as well as in the interest of sound and efficient judicial administration for me not to pass upon the motion at this time so that I would have the benefit of the entire testimony.

MR. HALL: Now may I make --

THE COURT: So, I am inclined to deny it without prejudice.

MR. HALL: May I make my motion with respect to their third cause of action?

THE COURT: Yes, surely.

MR. HALL: And you can act upon it or not, as you please. Of course you will.

In the first place, there is a serious question of title in connection with that cause of action. They claim that Mr. Ploeger, Jr. said something about Mr. Wolowitz to

hold something in confidence. Then later they claim that Spellright used this. But Mr. Ploeger is not the plaintiff. He alleges that he assigned this thing to the Edgecraft Company and that a patent issued to the Edgecraft Company. Indeed, the patent to the Edgecraft Company issued in April of 1966, before the ribbon was allegedly purchased from Abraham & Strauss. So, presumably at the time of the alleged infraction Edgecraft Company owned the right.

THE COURT: Just what is your point about that, Mr. Hall?

MR. HALL: Well, the plaintiff in this case is the Filmon Process Corp. I maintain that they have not shown that Filmon Process Corp. has a right to maintain a suit on this --

THE COURT: The trade secret.

MR. HALL: The trade secret, even if they do have a good cause of action otherwise, because Filmon does not have title. And that is a legal matter.

Mr. Ploeger claims to have conceived the trade secret and bound Mr. Wolowitz by a contract of some kind.

THE COURT: When was the Filmon Corp. organized, if you will refresh my recollection?

MR. HALL: He said it was organized in 1962, but

there was no assignment to it in 1962. The assignment to it is at some indefinite future date. It could have been the day before yesterday, for all the record shows. There is no showing that at the time of the alleged infraction the Filmon Process Corp. owned the trade secret right, and the Supreme Court has held in an exact similar situation -- in fact, I have got the citation here but I can't find it due to my confusion last night, but I can find it in a few minutes but I don't have it right at the tip of my fingers, but the Supreme Court has held the assignment of a patent does not carry with it, unless expressly stated in the assignment, any infractions or infringements or causes of action that accrued prior to the assignment.

In other words, if I assign you my patent, that does not carry with it any cause of action I had prior to the time I assigned it unless I expressly so state in the assignment.

So, there is nothing in this record that says that Mr. Ploeger, Jr. expressly told the Filmon Process Corp., either orally or in writing, that he was assigning to them a cause of action that had accrued in his behalf. So, therefore, the Filmon Process Corp. does not have title to that trade secret.

THE COURT: I suppose it all depends upon the organization minutes of the Filmon Corp.

I think there is a great deal of merit in your point, but I would rather decide the case on the merits, Mr. Hall.

I am going to deny the motion without prejudice.

MR. HALL: Mr. Geiger, would you take the witness stand.

MR. ROBSON: If Your Honor please, could I just point one fact out to the Court. The patent application for the trade-mark secret was filed on April 16th, I believe it was, 1962, by Walter Ploeger, Jr., assignor to --

THE COURT: Trade-mark application for a trade secret?

MR. ROBSON: No, the patent application on the process which was the subject of the trade-mark secret we allege.

THE COURT: You don't mean trade-mark secret.

MR. ROBSON: The trade secret. That application was filed in April 1962 and at that time Walter Ploeger was the inventor and Filmon Process Corp. was the patentee.

THE COURT: That application is not before the Court, is it?

MR. ROBSON: No, sir, it is not, but I don't know where Mr. Hall got the information that Filmon did not own the trade-mark secret at the time that it was infringed.

THE COURT: Well, we will proceed.

JOSEPH A. GEIGER

called as a witness by Defendants, having been duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. HALL:

Q Would you state your name and age?

A My name is Joseph Anthony Geiger, G-e-i-g-e-r.

MR. HALL: Your Honor, I am going to offer this witness as an expert translator to translate the German patent and I will state his qualifications with a leading question such as you suggested.

THE COURT: Perhaps we can shorten this. Perhaps the other side will stipulate that the translation is accurate.

MR. ROBSON: Unfortunately, there are about three or four crucial words about which there is some difference. Other than those, we will concede the translation.

MR. HALL: Well, he says they are crucial words. They have refused in the past to accept our translation.

THE COURT: Of course the German patent is not in

evidence yet. May I make this suggestion to shorten matters: Suppose you offer it in evidence at this time and we will have Mr. Robson state which words he questions the translation of.

MR. HALL: I have here a certified copy of the German patent and I ask that it be marked Defendants' Exhibit 8 for identification and I offer it in evidence.

THE COURT: Let it be admitted.

(Copy of German Patent 966,174

marked Defendants' Exhibit No. 8

and received in evidence.)

THE COURT: The translation is attached to it, is it not?

MR. HALL: No, I haven't offered the translation yet, but I will.

I have here our proposed translation, with a copy of the drawings attached, and I ask that it be marked Defendants' Exhibit 9 for identification and I offer it in evidence.

THE COURT: Let it be admitted.

(Translation of German Patent

966,174 marked Defendants' Exhibit

No. 9 and received in evidence.)

THE COURT: Now just what words do you question, Mr. Robson?

MR. ROBSON: On the first page of the translation, the fourth line from the bottom, the second word from the left is "bonding" in the translation.

THE COURT: What word?

MR. ROBSON: The word "bonding", the second word from the left on the fourth line from the bottom.

THE COURT: "Bonding"?

MR. ROBSON: Yes. We contend that that word should be pasting or gluing.

THE COURT: Now what else?

MR. ROBSON: On the second page of the translation, the sixth line from the bottom and the second line from the bottom, again the word "bonding" should be pasting or gluing.

THE COURT: On the second page --

MR. ROBSON: Second line from the bottom, it's the second word again from the end, from the left on the second line. Also, on the sixth line from the bottom on that page, fifth word from the right.

THE COURT: I see it. And the same thing in the claims?

MR. ROBSON: The same thing is true several other

places. On the second line --

THE COURT: Anyway, wherever the word bonding occurs you think it ought to be pasting or gluing?

MR. ROBSON: Yes.

THE COURT: Very well.

MR. ROBSON: Now there are two or three other words.

On page three the paragraph numbered 1 says, "The thermoplastic film is melted into." We contend that the word "into" should be "onto."

THE COURT: Onto?

MR. ROBSON: Yes, sir.

In the second full sentence in the paragraph numbered 2 appears the word "welded." It says, "The three are firmly welded." We contend that that should be "melted."

I believe that is it.

THE COURT: Mr. Hall, are you willing to accept those corrections?

MR. HALL: No.

THE COURT: Very well, you may proceed.

BY MR. HALL:

Q Mr. Geiger, I will state your qualifications and ask you if these are correct: You were born in Austria, a German speaking area of Austria; your native tongue is German?

A Yes.

Q You went to highschool and college in Austria; you received the degree of Bachelor of Science in Mechanical Engineering?

A Yes.

Q All going to school in schools where the native tongue was German?

A Yes.

Q And then you worked 13 years in Europe as a research engineer, four of these years being with textile machinery, and during that time you were still dealing with the German language, the business that you were in was done in German?

A Part of this is correct, part of it is not. Out of the 13 years of engineering experience which I have, six of them are in this country as a research engineer.

Q But the rest is in Europe?

A The rest is in Europe, partially in French speaking country and partially in German speaking country.

Q Your experience with a textile company was in a business using the German language?

A Correct.

Q And then you came to the United States. And how

long have you been here?

A For six years.

Q And you are working on your doctor's degree?

A That is correct.

Q Now did you take the translation which is -- tell us how you came about to make this translation.

A I have been engaged by Mr. Hall to do some translation work for a patent trial, a different patent trial, and in between I was handed --

THE COURT: You were asked how you came to make this translation. I presume you made it at somebody's request, is that it?

THE WITNESS: That is correct.

THE COURT: At whose request?

THE WITNESS: At Mr. Hall's request I translated a copy of this German patent.

THE COURT: Well, that is enough.

BY MR. HALL:

Q At the time you made this translation did you know that any suit or controversy was involved?

A Not with respect to this patent.

Q And did you know what the issues were in connection with this suit at that time?

A Yes.

Q You went to highschool and college in Austria; you received the degree of Bachelor of Science in Mechanical Engineering?

A Yes.

Q All going to school in schools where the native tongue was German?

A Yes.

Q And then you worked 13 years in Europe as a research engineer, four of these years being with textile machinery, and during that time you were still dealing with the German language, the business that you were in was done in German?

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THE WITNESS: That is correct.

THE COURT: At whose request?

THE WITNESS: At Mr. Hall's request I translated a copy of this German patent.

THE COURT: Well, that is enough.

BY MR. HALL:

Q At the time you made this translation did you know that any suit or controversy was involved?

A Not with respect to this patent.

Q And did you know what the issues were in connection with this suit at that time?

A No; and I did not see the Ploeger patent, either.

THE COURT: You have answered the question. The answer is no, and then stop.

BY MR. HALL:

Q Had you seen the Ploeger patent at the time you made this translation?

A No, I had not.

Q Now would you take up these particular words which Mr. Robson has refused to agree to in your translation and tell us your views with respect to the correct translation of those words?

A The translation states the "thermoplastic bonding" and this is being objected to as should evidently mean thermoplastic pasting or gluing. Now to all of my knowledge, there is no such thing as thermoplastic pasting or thermoplastic gluing because thermoplasticity in itself means melting by addition of heat. Now --

MR. ROBSON: If Your Honor please, I am not sure now whether the witness is testifying -- I object to this on the ground that he is now testifying not as a translator but as a --

THE COURT: He is also an engineer. I will overrule the objection.

THE WITNESS: Besides that, the word of bonding is generic enough to include pasting or gluing. So, it is not that the word bonding can be wrong. The word pasting or gluing would mean something different in German.

BY MR. HALL:

Q Well, now what -- the English word that precedes the word "bonding" is "thermoplastic." What is the German word that precedes the word "bonding" in the original German text?

A I read it and it reads "thermoplastisches," which evidently is the same word in root and even in sound.

Q From your knowledge what does the word "thermo," what does the part "thermo" of the word "thermoplastic" mean?

A It means related to heat.

Q And what does the "plastic" half of the word "thermoplastic" mean?

A The "plastic" half means that from a solid state it becomes a soft state, increasingly soft state.

Q As you heat it?

A As more heat is added to the material.

Q So, reading it out of the original German, do you have any doubt but what the words that you have translated being "thermoplastic bonding" refer to a heating of the

material to soften it so it would stick to the other material?

A That is exactly the meaning of these words.

Q Now go on to the objection that they make to your translation on page 3, where you use the word "into." You translated it, "The thermoplastic film is melted into the borders of the ink-carrying tissue," and they want you to say that "The thermoplastic film is melted onto the borders of the ink-carrying tissue."

Would you tell us, Mr. Geiger, whether the correct translation is "into" or "onto"?

A I cannot see any difference because if you melt something onto a tissue, necessarily it goes into.

Q Well, but relying on your German --

MR. ROBSON: I object to that answer and move to have it stricken as not responsive.

THE COURT: Objection overruled. This is not a jury trial, this is a non-jury trial.

BY MR. HALL:

Q Could you tell us from reading the original German whether this means, to an engineer, that it is melted into the borders or whether it is melted onto the borders?

A The German word literally translated means melting down.

THE COURT: The literal translation is what?

THE WITNESS: Melting down, melting down of a thermoplastic film onto or into the borders of the ink-carrying tissue.

BY MR. HALL:

Q Well, the next part of your translation which they challenge is the word "welded" in paragraph 2. Now have you had any experience as a translator in connection with welding?

A Oh, yes.

Q And you were a translator in a patent infringement suit before Judge Austin in Chicago, were you?

A Yes, I was.

Q And Judge Austin accepted your translation as against the opponent's translation?

A That is correct.

MR. ROBSON: If Your Honor please --

THE COURT: Well, it shortens matters.

Q And that was a case involving welds?

A That is correct.

Q Would you tell us whether your translation which resulted in the use of the word "welded" is a correct translation?

A I maintain the translation as being correctly

translated welding. It might also be fusing, which is equivalent.

THE COURT: What does Mr. Robson contend should be the translation of that word?

MR. HALL: I think he says it should be melted, as I remember what he said.

THE COURT: What did you contend that should be?

MR. ROBSON: I believe I said melt. We would also accept fusing.

THE COURT: You contend the word should be melting instead of welding.

MR. ROBSON: Yes, sir, and we would also accept fusing.

THE COURT: Well, there isn't much difference, then, is there?

MR. HALL: They say there is no difference.

THE COURT: Are you willing to accept fusing, Mr. Hall?

MR. HALL: I would prefer to ask Mr. Geiger; he knows the German better than I do.

THE WITNESS: The definition of welding is joining by local fusion, Your Honor.

THE COURT: Well, I suppose fusing is a more

generic term than either melting or welding, is it not?

MR. ROBSON: Yes, sir; I believe fusing involves the heating of a thermoplastic --

THE COURT: I say fusing is a more generic term than either melting or welding.

MR. ROBSON: Yes, sir.

MR. HALL: You may cross-examine.

MR. ROBSON: I'm sorry, may I have the witness' name again?

THE COURT: Geiger.

CROSS-EXAMINATION

BY MR. ROBSON:

Q Mr. Geiger, I don't really believe we are that far apart, but let's see.

You have translated as "thermoplastic bonding" or "bonding" the word "Verkleben," is that correct?

A That is correct.

Q Is it not true that the word Verkleben's primary usage is pasting or gluing?

A No, I have to disagree. That is the word Kleben. When you write it Verkleben it means different things.

Q May I read to you from a German dictionary. Are you familiar with Cassell's -- the New Cassell's German

Dictionary?

A Yes, I am.

Q May I read to you the definition contained in that dictionary of Verkleben and ask you if you disagree with it:

"Verkleben - Plaster up, glue, lute, cement, paste over, gum up, stick together; apply a plaster."

Do you agree with that definition?

A That may perfectly be correct.

THE COURT: What was your answer?

THE WITNESS: That may be correct.

BY MR. ROBSON:

Q Let me ask you --and possibly this will solve the problem; I am not sure we are really in dispute-- as an engineer can you tell me whether it is not correct that among the various methods of gluing substances or pasting substances together is a method called thermoplastic gluing or fusing or bonding, in which a thermoplastic substance is melted so that it, itself, becomes the adhesive which causes it to stick to another substance; is that correct?

A I am not sure whether I have understood your question, Counsel. If you meant that the thermoplastic material was a third material --

Q No; let me repeat it or let me ask it this way --

THE COURT: Would you like to have it read?

MR. ROBSON: No, I think possibly I better rephrase my question.

BY MR. ROBSON:

Q Normally when you glue two substances together you apply some sort of adhesive between them so that they stick, is that correct?

A Correct.

Q Now is it not true that when one of the two substances is a thermoplastic the melting or softening of the thermoplastic enables you to use the substance itself to accomplish the adhesion so that you don't need a third adhesive, is that correct?

A That is correct, but you would no longer call it gluing.

Q But is that what you mean by thermoplastic bonding, the melting of one substance so that the thermoplastic material when softened in effect becomes the glue or the adhesive?

THE COURT: In other words, you have no third substance to act as the glue, is that it?

MR. ROBSON: Yes, sir.

Q Is that what you mean?

A It may be by melting just one of the two parts or

Dictionary?

A Yes, I am.

Q May I read to you the definition contained in that dictionary of Verkleben and ask you if you disagree with it:

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THE COURT: In other words, you have no third substance to act as the glue, is that it?

MR. ROBSON: Yes, sir.

Q Is that what you mean?

A It may be by melting just one of the two parts or

both. The word thermoplastic bonding does not imply any choice between just one or both. It may be both. Both parts may be melting while they join or one part may be melting while they join.

Q When both parts are melted and joined isn't there a different term to describe it? In English the term welding?

A The term welding has not until very recently been used in other things than metals. The term welding for plastics is very recent; and you can open any dictionary you find when you want to look up welding, you will find it as defining fusion of metals. Now only recently has the term welding come into use in plastics and before that it was just simply fusion.

Q Whether it's recent or not, is it not a fact that the term welding is used to describe a process in which both materials are melted into each other?

A That is correct.

Q And is it not true that there is a German word for welding?

A That is correct too.

Q And that word is Schweißen, is it not?

A That is correct.

Q The word Schweißen is not used in this patent which

you translated, is it?

A For the reasons I said.

Q Whatever the reasons, it is not used, is it?

A It is not used.

Q We are only left with one word and that is the word "auf" which you have translated "into" and the word "auf" really means "onto," does it not?

A Yes.

THE COURT: Just what difference do you have in mind between into or onto?

The word into, of course, is often mis-used. For instance, I notice that of late years lawyers have gotten into the habit of offering matters into evidence instead of in evidence. The word into is misused.

But what difference do you have in mind between onto and into?

MR. ROBSON: When something is fused onto, it's merely melted and it becomes an adhesive process whereby one surface adheres to the other without any inter-relationship of the two materials. When it melts into, the materials become combined.

THE COURT: You mean it becomes a single material?

MR. ROBSON: It becomes a single material. And

the significant difference, we contend, between our patent and the German patent is that the German patent did just that, it melted one material onto the other so that they adhered. Our patent welds or fuses both materials into each other so they form a cohesive unit.

And I believe we are now in general understanding as to the meaning of these terms.

THE COURT: Very well. Anything further?

MR. HALL: No further questions.

Before Mr. Norton begins to testify I will offer in evidence copies of the patents to Stark, 1,953,316; Francis, 2,657,157; Markes, 2,699,244; and attached to all this is a copy of the German patent and the translation; and I ask this be marked Defendants' Exhibit 10 for identification and I offer it in evidence.

MR. ROBSON: Would you repeat those names again?

MR. HALL: Those are exactly the same references --

MR. ROBSON: Could you repeat the names again, please?

MR. HALL: They are the same ones attached --

MR. ROBSON: I don't have the names in front of me.

MR. HALL: Stark, Francis, Markes, and the German patent.

(Copies of patents to Stark, Francis, Markes, and German patent and translation thereof, marked Defendants' Exhibit No. 10 and received in evidence.)

MR. HALL: I will ask that there be marked Defendants' Exhibit 11 copies of the patents which were cited by the Examiner. This exhibit does not include the Francis patent because it is already in Defendants' Exhibit 10. I offer Defendants' Exhibit 11 in evidence.

(Copies of patent references cited by Patent Office marked Defendants' Exhibit No. 11 and received in evidence.)

THE COURT: Mr. Hall, I notice you have two different groups of prior art patents, one Exhibit 10 and the other Exhibit 11, and I notice that Exhibit 11 includes references cited by the Patent Office.

MR. HALL: They are the references cited by the Patent Office.

THE COURT: Yes. Now do I correctly infer, then, that those that comprise Exhibit 10 were not cited by the Patent Office?

MR. HALL: One of them was, the remainder was not.

THE COURT: Which one was?

MR. HALL: The Francis patent was cited by the Patent Office.

We are offering the patents of book 11 which were cited by the Patent Office, other than Francis, to show the Patent Office didn't make a very good search and didn't find anything comparable to the patents we are relying on. We are not mainly relying on those patents for anticipation, although we reserve the right to refer to them if need be.

ROBERT A. NORTON

called as a witness by Defendants, having been duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. HALL:

Q Mr. Norton, would you state your name, age, and occupation?

A My name is Robert Aimes Norton; my age is 71 years; and I am a patent attorney, a member of the bar of the District of Columbia and of New York State.

Q Would you state your education and experience and, in particular, any education that you had in Germany?

A From 1907 to 1914 my family was living in Germany and I went to the German schools there. I learned to speak and read German fluently and I still read German with exactly

the same facility as English.

A few weeks before the First World War my family returned to the United States, and I entered Yale College, from which I finally graduated as an organic chemist. I majored in organic chemistry.

During the First World War I served for a little over a year in the Chemical Warfare Service and worked in the research laboratories producing war gases and new processes for making them.

At the end of the war I returned to Yale Law School and obtained my law degree from them in 1921.

I then entered the Patent Office as an Assistant Examiner and I handled the class of organic chemistry. That was Class 260, which is now spread over a number of divisions.

After serving in the Patent Office I went with, successively, two firms of patent attorneys in New York City and the cases that I handled with them were primarily but not exclusively chemical.

In 1927 I went to Pittsburgh and formed the patent department of the Selden Company, who manufactured catalysts and the substance Phthalic Anhydride, which is a raw material for a number of resins. The Selden Company was purchased by the American Cyanamid Company and in 1932 I moved down to

New York, in their patent department, and remained there for about 30 years, being the head of one of the groups of patent attorneys in their department. My group handled, among other things, organic chemicals, dye-stuffs, and the like. While the American Cyanamid Company did not themselves produce any nylon, they were very much concerned with developing dyes and dyeing processes for dyeing nylon, and as a result I learned a great deal about nylon from the inventors and also, of course, from further reading.

In 1959, just short of mandatory retirement, I resigned from American Cyanamid Company and formed the patent department for the Barnes Engineering Company in Stamford, Connecticut. At the beginning there was not enough work for me fulltime so I had about 20 percent of my time devoted to private clients. Among those private clients was some work for the Remington Rand Company and it involved several cases on typewriter ribbons and transfer sheets such as carbon paper.

About two years ago the work slacked off at the Barnes patent department and I suggested that they make my assistant the head of the department because he was a younger man and it meant something to him, and this was done; and while I still do work as a consultant for Barnes Engineering and they give me an office there, most of my time is for my

private clients, which includes American Cyanamid.

And in the last year I acquired a client and prepared a number of cases on processes for making the raw materials for one kind of nylon and of course had to study further into the chemistry of nylon and its physical properties.

Q Did you mention that at one time you were the Examiner in the Patent Office in charge of all organic chemical cases?

A That is correct.

Q Have you read the Ploeger patent in suit, 3,010,559?

A I have.

Q Have you also read its file wrapper?

A Yes, I have read the file wrapper.

Q Have you studied the German patent, both in the original German and in the translation?

A I have. I read it first in German and then the translation. Since I handle the two languages with equal facility, that is my general practice, to read it first in the original.

Q Let's start with the Ploeger patent. If you would turn with me to column 1, line 61, it is said:

" . . . there is shown in the drawings a form which is presently preferred."

Now would you explain to the Court what is shown

in the drawings, this form that is presently preferred?

A The drawings all relate to the same kind of a ribbon. Figure 4 is the one that shows the points that I am going to bring out most clearly.

Figure 4 is a cross-section and shows a backing of flexible material, which may be nylon and which is numbered 14, that has been melted down or fused at the two edges of the woven ribbon which is shown at 10 and 12.

The drawing shows that the film or sheet 14 has softened and melted and flowed in and around some of the threads of the woven ribbon and has surrounded them and, therefore, has fused the film 14 to the ribbon.

THE COURT: Is this a longitudinal or a cross-section?

THE WITNESS: Figure 4 is a cross-section through the ribbon.

THE COURT: Not a longitudinal section?

THE WITNESS: No, it is a cut through, and it is along the lines 4 of figure 2, and if Your Honor will turn to figure 2 you will see that this shows that the section was made across the ribbon.

THE COURT: Then figure 4 would be a very much enlarged cross-section, would it not?

THE WITNESS: Yes, it is also enlarged. I forgot to say that. But it is not a longitudinal section as the section line shows it is sectioned across the ribbon.

BY MR. HALL:

Q Now would you point out where in the patent it says the type of material that is used for the ink carrying tissue 12 of the device of figure 4?

A In column 2 it states that the ribbon may be of various materials. I am referring particularly to lines 8 and 9. It says that the ribbon is woven, a woven strip of cotton, silk, or nylon.

Q How long have cotton, silk and nylon been used in typewriter ribbons, to your knowledge?

A Well, cotton and silk have been used for a great many years, almost since the beginning.

When nylon came in it was at first a little difficult to make a ribbon out of it because the ink wouldn't stick, but they were able to change the surface so that it would. And in later years, starting in the 1940s, nylon typewriter ribbons have been used increasingly because they are stronger and they wear better and, while they are not quite as fine as silk, they are considerably finer than cotton and give a good impression.

So, I would say that nowadays nylon is a very

common material to use for typewriter ribbons. Cotton and silk are still used, but I would say that silk is not used to as large an extent because it is considerably more expensive and is used only when very fine reproduction warrants the additional expense.

Q Would you say that prior to the filing date of this patent cotton, silk and nylon were the three most common materials used in typewriter ribbons?

A That is correct.

Q Now I would like for you to go down to line 26 of the same column where it says:

"Although in the illustrated embodiment of the ribbon 10 of the present invention, the edges 14a of the impervious strip 14 are shown to be fused to the edges 12a of the absorbent strip 12, if the absorbent strip 12 is made of a fusible material, the edges 12a of the absorbent strip 12 may be fused to the edges 14a of the impervious strip 14."

Now I ask you which of the three materials, cotton, silk and nylon, would he be referring to when he said, "if the absorbent strip is made of a fusible material"?

A He could only be referring to nylon because neither

cotton nor silk are thermoplastics. If you heat them you merely destroy them. Nylon, however, can be heated and softened and then set again on cooling, as is true of all thermoplastics.

So he was referring to nylon in those sentences which you have just read.

Q All right. Now let's go back to the first half of the sentence before we read the word "if," where it says, "Although in the illustrated embodiment of the ribbon 10 of the present invention, the edges 14a of the impervious strip 14 are shown to be fused to the edges 12a of the absorbent strip 12," just down to that point. What would the materials that he is referring to there be?

A They could have been cotton and silk. They might have been nylon if the heat of fusing was sufficiently low so that the inked ribbon --which contains some moisture in the ink and therefore would absorb heat more slowly-- was not fused. But cotton and silk would certainly have been shown here because they cannot be fused.

THE COURT: What is the meaning of the word "impervious" as used in that sentence?

THE WITNESS: That is the film backing 14, which is a continuous sheet and which is impervious to the ink of

the ribbon and therefore it can't go back through the sheet.

THE COURT: I was wondering what it was impervious to.

THE WITNESS: That is what it is.

BY MR. HALL:

Q Now in that sentence I read it used the words, and I quote, "illustrated embodiment." What is the illustrated embodiment?

A The illustrated embodiment in the drawings, as I have stated before, is one in which the impervious film is fused and it has run into or between some of the threads on the edges of the printing ribbon, but the threads themselves are not shown as having been melted or fused.

Q Now I would like to ask you --

MR. HALL: At this time I would ask the Court to take judicial notice of the Rules of Practice of the United States Patent Office in patent cases as of the date that Mr. Ploeger filed his application.

Q And I have here a set of those rules and I wonder if you would first read Rules 81 and 83 to the Court.

A This is the Rules of Practice that issued in 1955 and were, therefore, in force when this application was filed. 81 states:

"Drawings Required - The applicant for a patent is required by statute to furnish a drawing of his invention whenever the nature of the case admits of it. This drawing must be filed with the application. Illustrations facilitating an understanding of the invention (for example, flow sheets in the case of processes and diagrammatic views) may also be furnished in the same manner as drawings and may be required by the Office when considered necessary or desirable."

And below this there is a reference to 35 U. S. Code Section 113, Drawings, where the statutory basis for this rule is to be found.

THE COURT: I don't think you have to go into that. The Court is familiar with the fact that drawings are required.

MR. HALL: Well, I know, but --

BY MR. HALL:

Q You haven't read Rule 83, have you?

A 83, which refers to content of drawings, says:

"The drawing must show every feature of the invention specified in the claims. When the invention consists of an improvement on an old machine the drawing must, when possible, exhibit

in one or more views the improved portion itself disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith."

Q Now, I am mainly interested in that passage where it says the drawing must illustrate every feature of the invention claimed.

Now, I am asking you if there is anything in the drawing of the Ploeger patent which shows that both the ribbon and the film were melted and welded together?

A No, there is not. As I have stated before, figure 4 shows that only the edges of the impervious film 14 were melted, not the threads of the inked ribbon.

Q And is that the way you read this sentence that we read once before, and I will quote it again:

"Although in the illustrated embodiment of the ribbon 10 of the present invention, the edges 14a of the impervious strip 14 are shown to be fused to the edges 12a of the absorbent strip 12, if the absorbent strip 12 is made of a fusible material, the edges 12a of the absorbent strip 12 may be fused to the edges 14a of the impervious strip 14."

Is that what you rely on to say that the drawing does not show the embodiment wherein the ribbon itself is melted and welded to the film in the drawings?

A Well, that is further evidence, but the drawing itself very clearly shows that the threads themselves are not melted. However, this statement strengthens the fact that the drawings show the preferred form in which only the impervious strip is melted. This sentence appears to describe a possible alternative, but that alternative is not illustrated in the drawings.

THE COURT: Does figure 4 show that the two strips are welded together?

THE WITNESS: I would say that the term welded might be a little bit inappropriate because that means that both things have been melted together.

Here in the drawing it very clearly shows that only the material of strip 14 has been melted.

I would think a terminology of fusing or bonding would be a more suitable term because it is my understanding that welding means that both materials must have been melted, and that is definitely not the case in figure 4.

BY MR. HALL:

Q Is there anything in the patent, in the Ploeger

patent, which says that both materials are raised to the melting point at the time of fusion?

A No, I don't find that, because in the sentence which you read a moment ago on column 2, lines 26 to 32, it refers to the film strip itself being melted onto the edge of the absorbent strip. There is no definite statement that both are melted at the same time.

THE COURT: I observe that the term used in the specification and the claims is fused, rather than welded.

MR. HALL: That is right.

THE COURT: Which is a more generic term.

MR. HALL: Probably. And that is just what I was coming to, Your Honor.

BY MR. HALL:

Q I would like for you, Mr. Norton, to turn to page 27 of the file wrapper of the Ploeger application. Would you read the remarks of the attorney?

A These are the remarks in a supplemental amendment which added what is now claim 2 of the patent, and the remarks read as follows:

"Claim 15 has been added because there are materials, as indicated in the specification (first sentence of second paragraph of page 4) other than

nylon which may be fused to the impervious nylon film, and which may perform satisfactorily in the present invention.

"Accordingly, reconsideration and allowance of each of the claims now present in the subject application is respectfully solicited."

Q Now would you look back to the first sentence of paragraph 4 of the specification and tell us what material he was talking about when he said that there were materials other than nylon which may be fused to the impervious nylon film?

A That reads, "A woven strip of cotton, silk or nylon," and those are the materials which appear to be referred to on page 27. That is the same language that was read from the patent but, of course, in the printed patent it occurs at a different line.

Q Well, I asked you what -- you see, the attorney said that there were materials other than nylon referred to in the specification and which may perform satisfactorily, and I was asking you what were those materials other than nylon.

A I beg your pardon. I misunderstood you.

There are no materials other than nylon described

on page 4 which could be fused onto the impervious material because the other two materials, cotton and silk, cannot be melted on, they are not fusible.

Q But the nylon can be melted into the cotton and silk?

A That is correct.

Q And so that is what he is referring to when he says in his remarks that there are other materials which may perform satisfactorily in the present invention?

A I --

MR. ROBSON: If Your Honor please, I object to the witness testifying as to what the attorney referred to. He may indicate what his opinion is but I doubt that he knows what the attorney was referring to.

THE COURT: The form of the question is somewhat subject to criticism. However, I will overrule the objection.

You may answer.

THE WITNESS: The sentence is, in a way, a little confusing because it refers to materials other than nylon which may be fused and then it says and they may perform satisfactorily.

Now there are no other fusible materials for the ribbon described in the Ploeger patent. There are described

silk and cotton, which may perform satisfactorily, but they could not be fused onto the film.

So it is not quite clear that he is referring to them because they are not fusible.

THE COURT: Well, we will take our usual mid-morning recess at this time.

(Recess.)

THE COURT: You may proceed, Mr. Hall.

BY MR. HALL:

Q Mr. Norton, when nylon came on the market did it start becoming a substitute for other materials such as cotton and silk?

A When nylon was first developed, which was in the '30s, it came on the market just at about the beginning of the Second World War. It was originally intended to be a substitute for silk and wool, rather than cotton, because its chemical nature was somewhat similar and it was much more expensive than cotton and, therefore, would not be competitive particularly in the cotton field; but it was of great interest to have something that would be better than silk and wool.

THE COURT: Wasn't it known at first as artificial silk?

THE WITNESS: No. The artificial silk term was

VOLUME III

IN THE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA

Appeal No. 21527

FILMON PROCESS CORPORATION,
Appellant,

v.

SPELLRIGHT CORPORATION, *et al.,*
Appellee.

JOINT APPENDIX

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA

United States Court of Appeals
for the District of Columbia Circuit

FILED FEB 19 1968

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Five of the Counterclaim
- 7 Motion To Dismiss Count II of Complaint
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- 9 Pretrial Order Dated December 19, 1966
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15 File wrapper of Letters Patent 3,010,559;
pages 7, 8, 13, 27, 40, 41, 47-55 (plaintiff's
exhibit one)

16 Defendant's Exhibits

1 - Kaufman invoice to Spellright dated
March 31, 1962

2 - Kaufman invoice to Spellright dated
September 30, 1961

3 - Publicity release published November, 1962

12 - Letter from Mr. Ploeger to Mr. Wolowitz
dated December 18, 1961

14 - Letter from Mr. Hall to Mr. Lavine dated
June 27, 1963

17 United States Patents

Stark	1,953,316	April 3, 1934
Phelps	2,044,630	June 16, 1936
Francis	2,657,157	October 27, 1953
Murphy	2,728,439	December 27, 1955
Ploeger	3,010,559	November 28, 1961
Ploeger	3,274,039	September 20, 1966
Markes	2,699,244	January 11, 1955

18 Foreign Patents

German - Gruendel 966,174 June 27, 1957

(with translation - Def. Exh. 9)

British - Wolowitz 961,108 June 17, 1964

19 Opinion of Judge Holtzoff dated October 9, 1967

20 Final Judgment dated October 20, 1967

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22 Order dated November 29, 1967 extending time
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TESTIMONY OF WITNESSES

Walter Ploeger, Jr.	108-244; 252-386; 686-698
Henry J. Kauffman	244-261
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originally first applied to the viscose rayon, which is a cellulose thing, back about the early 1900s. That was rayon.

THE COURT: That was rayon.

THE WITNESS: And that was called artificial silk. I have never heard nylon called artificial silk, though it may have been.

BY MR. HALL:

Q At any rate, prior to nylon, silk was a very common substance for such things as womens stockings?

A Yes. That was the first big use of nylon and it was so much better than the silk in the stockings that it soon took over almost all of the market.

Q And people began widely researching and experimenting to apply nylon to as many different uses as possible, is that correct?

A That is correct. The nylon fibers were applied to a great many other materials, such as ropes for boats. It is much stronger than any other material. And then further research was carried on in making nylon in the form of sheets or thicker materials, for blanks for gears that would be quiet and in many cases would not require lubrication.

They did a great deal of work to try to find a wide field of use for nylon.

Q Well, now, would you compare the Ploeger patent with the German patent?

A I would like to preface this by stating that what had been tried before, there were problems in the inked ribbon for typewriters and it had also been proposed to have an impervious sheet of a different kind of material, the material being cellophane, which is similar chemically to cotton, and that these were not satisfactory.

So, Ploeger and the German patent, inventor of the German patent, started out to solve the same problem; that is to say, to have a typewriter ribbon with a thin, tough impervious film back of it, and they both approached the solution in the same way. They both decided that it would be best to have the impervious thermoplastic film fused or bonded to the edges only of the typewriter ribbon.

In other words, the solution of the problems led both of them to substantially the same structure.

Q Based on the translation, and particularly Arabic No. 1 on page 3, it says:

"The thermoplastic film is melted into the borders of the ink-carrying tissue."

Now can you tell us what is meant by the words thermoplastic film? And in doing that you need not rely only

on Mr. Geiger's translation but you may explain it from the original German, if you wish.

MR. ROBSON: If Your Honor please, I object to that. The translation is now in evidence as the --

THE COURT: Well, both the German original text and the translation are in evidence.

MR. ROBSON: Yes, sir, but apparently what Mr. Hall has just suggested to the witness is that the witness may substitute his own translation if it disagrees with Mr. Geiger's.

THE COURT: The question permits the witness to refer to the German original as well as to the translation. Now, of course, technically -- well, not technically, but actually the English language prevails in the courts of the United States, except in New Mexico where you can have Spanish. So, I suppose technically the witness must rely on the translation.

MR. HALL: All right.

THE COURT: I wish I could be of help but I don't know German. I was wishing that this German patent were a French or Italian patent instead and then maybe I could help counsel.

BY MR. HALL: ~~CONFIDENTIAL~~

Q Would you tell us what a thermoplastic film is?

A Yes. There are two kinds of synthetic plastics, two broad groups: The thermoplastics which can be melted, softened, even turned into a viscous liquid if you heat them enough, and then they set again to a solid when they cool, and this can be repeated. This is the characteristic of a thermoplastic.

There are other plastics which, when they are first heated, will soften, but then they will set or cure into a form in which they cannot again be re-melted.

I can bring this out on a homely illustration. If you take unvulcanized rubber, this is a true thermoplastic. You can soften it if you heat it, and it will set up again when it cools. Once you vulcanize it with sulfur, which creates chemical cross-links between the long chains of the rubber molecules, you then have transformed it into a material which is no longer thermoplastic because, as you know, if you heat vulcanized rubber you can destroy it and get a bad smell, but it will not ruse down and set up again.

That is the big difference between the two classes of plastics. The thermoplastics can be reheated and re-set indefinitely and --

THE COURT: What is the name of the other class?

THE WITNESS: They usually refer to them as

thermosetting or sometimes as curable resins. I prefer thermosetting; I think it is a more apt word.

BY MR. HALL:

Q Which is nylon, a thermoplastic or a thermosetting?

A Nylon is a true thermoplastic and it is one of the earliest synthetic thermoplastics that were developed.

Q Is it one of the most common thermoplastics?

A It is very common. If you are talking in tonnage, there are some other thermoplastics developed since then which are cheaper which may sell in larger tonnage, but nylon is sold in very large quantities for a very large number of uses.

Q Now you have explained this Arabic No. 1 method of the German patent.

I wonder if we could now explain the Arabic No. 2 section, which is on page 3 of the German patent? And I will give you some pieces of paper that may be of help to you in showing the Judge what the German inventor is talking about in this second paragraph.

A The first paragraph related to the same kind of material as appears in the Ploeger patent and that is shown in figures 1 and 2 of the German patent.

Now figures 3 and 4 show another way of fastening

or fusing or bonding the edges.

If we take these two pieces of paper here and we represented the edged film by the white sheet and the impervious thermoplastic film by the yellow sheet, the German stated that another way of fusing or bonding the edges only was to place narrow strips of fusible material on the edges. Then all of these fusible materials were heated together and formed a single structure at the extreme edges. It is a structure that I would consider in English would be most aptly called a welded structure.

Whereas, the figures 1 and 2 in the Ploeger patent is not a true weld, there has been a fusing and bonding of the two together but not what I would call a true weld.

Q Now there was some controversy about the word weld as it occurred in the original German text. Do you have any comments, based on your knowledge of German, as to whether or not the word welded is correctly used in this translation?

A Yes, I have. Opposing counsel referred to a German dictionary and gave a word for welding of metals. In German this is known as Verschwiessen or Schwiessen. Literally this means a wetting together. This is the common term in German for welding metals.

When they are doing a similar thing with plastics

it is not always the same term used and sometimes it is called a melting together, that is, both of the fusible materials are melted and they are melted together. And it is this terminology which was used in the German patent.

This is not an improper term for welding of plastics, although it is not the German term for welding of metals. They make a distinction. In English we do not make a distinction.

To complete that answer, I would, therefore, say that the translation of No. 2 as the three being firmly welded together under heat is not an improper English term.

Q Is there anything said in this German patent, either directly or by implication, that the inventor has some paste or adhesive in addition to the thermoplastic bonding?

A There is no statement anywhere in the German patent of pasting or gluing, if now we use gluing in its normal sense where you add a material between two surfaces. There is no such statement, there is no such inference. They refer to the thermoplastic fusing but they do not refer to applying any glue or paste or other material between the two surfaces.

Q What have you to say with respect to the obviousness

or non-obviousness of the use of nylon as the fabric material of the German patent? And I want you to give your answer as of the early part of 1959, prior to the time that Mr. Ploeger filed his application.

MR. ROBSON: If Your Honor please, I object to the question on the ground that, as worded, it is an improper question. It asks the witness what he has to say, and I really don't know what that is asking him.

THE COURT: Well, I will overrule the objection. There being no jury here, I think we can be a little more informal.

MR. ROBSON: My problem is, I don't know what the question means.

THE COURT: That is up to the witness. If the witness understands it, that is sufficient. If he doesn't, he can say so.

THE WITNESS: In 1959 anyone reading the German patent and also being acquainted with some of these other patents which were publications prior to 1959, would be led to use a typical thermoplastic for the impervious film. Nylon being one of the best known of such thermoplastics and being known to be tough and strong and flexible, would, naturally, occur to anyone thinking what thermoplastic should

would have made the same answer that I did with respect to '59. Back in 1930, I wouldn't.

Q Let's speak about the Francis patent for the moment.

MR. HALL: Does Your Honor have a copy of this patent? If not, I can give you one. We had a copy attached to our trial brief.

THE COURT: I have it here.

THE WITNESS: Mr. Hall, I find I didn't bring my copy of Francis with me.

Thank you.

BY MR. HALL:

Q Do you find reference in the Francis patent to a nylon film backing --

THE COURT: Which patent are you referring to?

MR. HALL: The Francis patent. If you are having difficulty finding it, I can hand you another copy.

THE COURT: I have it here.

Q Do you find, Mr. Norton, reference to a nylon film backing for a typewriter ribbon in Francis?

A Yes, I do. On column 2, in lines 51 and 52, among a number of polymers they refer to condensation products from di-basic acids and di-amines --

THE COURT: I am afraid I don't follow this. Where

is that?

THE WITNESS: That is on the second column of the Francis patent, the second column, and I was reading from lines 51 and 52.

THE COURT: Yes.

THE WITNESS: As I said before, and I am reading, it was formed from di-basic acids and di-amines (nylon tape). This is an accurate chemical definition of one of the most common types of nylons which are made from di-amines and di-basic acids. They are referred to as condensation products because in the formation of the material water is given off and in such cases the chemist refers to this as a condensation product.

BY MR. HALL:

Q Could you look at figure 3 of the Francis patent, or figure 4, and explain to the Judge very briefly just what that figure illustrates?

A In figure 3 they show an impervious film which is numbered 5, on a fabric, the threads of which are shown, for example, at 44. This fabric is impregnated with the typewriter ink and the whole fabric is attached to the impervious backing by cementing or gluing. It is attached all the way across, not just at the edges.

Q Now it says in the patent at column 3, line 71, that there is a "preformed film 5." Is that the backing you are talking about?

A That is the impervious film, and this is simply saying that it is made before the product is made and not at the same time that it is made. It is beforehand.

Q Is that film further described in the specification in column 2, starting at line 31, where it says, "The preformed film may be made of any thermoplastic film-forming material such as synthetic resins," and so forth?

A That is the preformed film which is referred to in the third column and is also the one numbered figure 3, as I previously stated.

Further down in the same paragraph on column 2, where they list a number of thermoplastic materials, occurs the reference to the condensation products of di-basic acids and di-amines nylon tape, about which I have just testified.

Q Mr. Norton, you have already testified as to your views of the obviousness of using nylon as the ribbon material on the German patent. I want to read some testimony that Mr. Seidel gave yesterday:

"If the fabric was nylon, Your Honor, there is virtually no other material that can be welded

to nylon other than itself.

Now if Mr. Seidel's testimony is true and the ribbon material was of nylon, what would you expect the backing to be in the German patent?

A Well, if the fabric were nylon in the German patent and the first method, that is, this Arabic 1, where the film is melted down into or onto the fabric, I would expect that it would produce either a fused edge such as is shown in figure 4 of the Ploeger patent, or if the heat was applied sufficiently and for long enough it might also fuse the threads of the nylon and in that case I think it might properly be referred to as a weld.

Q Now, Mr. Norton, do you find anything in the Ploeger patent about the use of hot knives in the making of the product?

A I did not find any such reference in the Ploeger patent.

Q Does the patent tell how one goes about to fuse the film to the ribbon?

A No, it simply refers to them being sealed or fused, and it is not surprising because these are well known operations.

Q Is there anything in the Ploeger patent as to the

type of ink that one would use?

A No, they simply refer to an absorbent material which carries the ink and they simply talk about a ribbon, a printing ribbon. They do not specify the ink. They refer to its amount but they do not specify its nature.

MR. HALL: I don't think I have got anything more from Mr. Norton, so you may cross-examine.

CROSS-EXAMINATION

BY MR. ROBSON:

Q Just for clarification, Mr. Norton, you said that the Ploeger patent does not in any way describe the ink. May I call your attention to the first page, line 38 I guess it is, and ask you --

A You mean column 1?

Q Column 2, I'm sorry, line 38. Does that not define an oil base ink?

A Yes, you are correct. It does refer to an oil base ink. It does not refer to any particular -- you are right.

Q I just wanted to clarify that. It was an oversight, I am sure.

A That is right. I should have mentioned that. I missed it.

Q Incidentally, Mr. Norton, it is a fact you have no interest in the outcome of this case, do you?

A None whatsoever. I simply am testifying here, but I have no financial interest in the outcome at all.

Q And if it is necessary to admit something which is favorable to the plaintiff, you would not hesitate to do so, would you?

A That is correct.

Q Let's start with the last portion of your testimony in which you were discussing the reasons why the Ploeger invention was obvious in view of the German patent and the other patents which were mentioned or offered in evidence.

First, let me get an understanding of what you were saying. Are you saying that the Ploeger patent was obvious to you or would have been obvious --

THE COURT: I don't recall that the witness said that the Ploeger invention was obvious in view of the German patent. I understood him to say that the substitution of nylon for silk would have been obvious by 1959, that the German patent refers to silk, and I think the witness testified that the substitution of nylon would have been obvious. I don't think he referred to the entire Ploeger invention as being obvious.

MR. ROBSON: If Your Honor recalls, I objected to one --

THE COURT: I may be in error as to what the testimony was. You may straighten it out, if you wish.

BY MR. ROBSON:

Q Is it your testimony that the Floeger patent or invention was obvious in view of the German patent and the other patents which have been introduced in evidence?

A I meant that it was obvious to the man of ordinary skill in the art and I felt that it might properly be so considered.

Q You then consider yourself as ordinarily skilled in the art of making of printing ribbons, is that correct?

A Not of making them, but of using them.

Q In the art of using them.

Do you have any experience or information whatsoever with respect to the manufacture of printing ribbons?

A Only what I have read and have been told in preparing patent applications dealing with ribbons and dealing with other things in connection therewith.

I, myself, have never with my own hands made a ribbon.

Q Have you ever seen a ribbon made in a factory?

A I have -- no, I have not seen the ribbon woven and inked.

Q Have you ever seen thermoplastics being fused?

A Yes.

Q What thermoplastics have you seen?

A I have seen fusions made with nylon, with polyethylene, and as I recall also with polypropylene. Those are all typical thermoplastics.

Q What sort of nylon fusions have you seen, what sort of nylon material, and being fused to what?

A It was being fused -- these were cases where two sheets of nylon were being fused along the edge to form a sandwich with a material in the middle that was to be protected; and the fusion in that case, because both sides were of the thermoplastic, I think would be called a weld.

Q Now what were the thicknesses of the nylon being fused?

A The thickness of the nylon being fused was, if I recall rightly, of the order of five or six thousandths of an inch or slightly more. I didn't measure it with a micrometer myself.

Q And how was the fusion performed?

A The nylon sheet was laid --

Q May I withdraw that for a moment and ask you one other question, just to get all the facts.

How wide were the sheets or how large were the sheets being fused?

A The one that I saw was about two and a half inches wide and about four inches long, because it was protecting a paper of the form of a badge or something like that and the nylon sheets were slightly wider. Then they were put in a press and heat was applied along the edges so that the edges -- in this case, of course, it was four edges; whereas, of course, in a ribbon it's a long thing, it's only two edges -- and they were softened and then when it cooled it set hard and that was the final product.

Q How was the heat applied to the nylon?

A There was a metal dye which had an electrical heating element in it, and the surface of the dye was brought up to the requisite temperature to soften the two sheets.

Q And could you tell us how wide the resulting fused edge was?

A The resulting fused edge in that case was approximately an eighth of an inch.

Q So that the two fused edges together would amount to about one-quarter of an inch?

A No, I meant the width of the fused area was one-eighth. The thickness was much less because the two sheets --

Q What I am saying is, if we then put the two widths together we would have one-quarter of an inch of fused material on that nylon, is that correct?

A No, because between the two edges there was the paper and, therefore, each edge was about an eighth of an inch. They were not put together. If you cut them off and put them together they would be a quarter inch wide.

Q What I was trying to get to is that the total surface of the film which as a result was fused, added up to a quarter of an inch?

A That is about right.

Q Approximately the total width of the average typewriter ribbon, is that correct, or a little bit less?

A No, I would say that the average typewriter ribbon is wider, it's a little wider than a quarter of an inch.

Q This would be about one-half of the width of the average typewriter ribbon?

A That is approximately true.

Q Now is that the only welding or fusing you have ever seen of nylon to nylon?

A That is the only instance where I saw the welding

actually done. That was your question.

I have seen ribbons where much narrower welds or fusion, bonding, has been made. But you asked me what I had actually seen manufactured, and that was it.

Q Have you ever seen nylon film fused to nylon film at the extreme edge only?

A What I described was at the edges. I don't know how extreme your extreme meant.

Q Do you have in front of you the Ploeger patent?

A Yes, I have it in front of me.

Q Would you look at figure 4 on the Ploeger patent?

A Yes.

Q That is a diagrammatic conception, is it not, or illustration?

A Yes.

Q Now there is a round circle at the extreme left edge of that, is that correct? What does that represent?

A That represents one of the threads of the woven ribbon which is shown in plan view in figure 2.

Q That represents one thread, is that correct, the extreme edge thread?

A Yes. You are referring to the thread numbered 12a, aren't you?

Q That is correct.

A Yes.

Q And immediately under that is the edge of a snake-like illustration, is that correct?

A I don't think I follow you. Immediately under that is a weft thread that is going across.

Q That is what I was getting to. Immediately under that is the weft thread?

A That is correct. 12a is a warp thread.

Q Is it not correct that the only thing that is joined together in this diagram, whether by fusion or welding or melting or what have you, is the extreme warp thread and the extreme edge of the weft thread?

A That is not what figure 4 shows because figure 4 shows, in dark, in black, what had been melted and it seems to extend over two warp threads and underneath the third warp thread, although it doesn't touch it because it touches the weft thread only there.

So, I would say the drawing indicates that it's over about three threads.

Q Do any of the fusing processes that you have seen make it possible to connect a fusible fabric at the extreme one or two threads?

A Do you mean have I ever seen that, or do I know that it can be done?

Q Do you know, in your experience, in which that has been done prior to 1959?

A I have never seen that done. I have seen seals that are very narrow, that is, welded seals that are very narrow and are of about this width. And I have --

Q We are talking now about nylon, are we?

A I am talking about nylon.

Q And are we talking about prior to 1959?

A Prior to '59 and --

THE COURT: Aren't we getting a little far afield?

MR. ROBSON: I really don't think so. This is the guts of the differences between us.

THE COURT: It is the what?

MR. ROBSON: The heart of the differences between us.

THE COURT: Very well.

THE WITNESS: I would like to finish my --

THE COURT: Very well, you may proceed in your own way.

THE WITNESS: I would like to complete my answer.

In 1959, you mean, have I seen things that were in

existence in 1959, I assume.

BY MR. ROBSON:

Q Did you either see or know of any fusion process using nylon fabric which enabled the fusion to be limited to the one or two outside warp threads?

A I was not told that in '59. The German patent, of course, shows it and it was dated prior. But I had not read the German patent in 1959 and your question was limited to what did I physically know in 1959.

Q Yes.

A And in 1959 I had not read the German patent and, therefore, I didn't know it.

Q Then is it correct to state that your opinion that this invention should have been obvious to one ordinarily skilled in the art in 1959, when this application was filed, is based almost exclusively on the German patent?

A That is substantially correct. There were some other patents cited of materials other -- You didn't limit this to nylon, or did you limit to nylon?

Q with respect to nylon.

A Well, the German patent doesn't mention nylon but it mentions a thermoplastic, and it is the one, the only one that I was relying on, referring to, that made a narrow

connection between the impervious film and the fabric at the edge.

THE COURT: I am going to interject a question.

Mr. Norton, in your opinion is there any difference between the structure of figure 1 of the German patent and the structure of the Ploeger patent? And if so, what is the difference?

THE WITNESS: I do not find any difference except -- are you talking of figure 1 only, Your Honor?

THE COURT: Yes, because the other figures refer to other types of connections.

THE WITNESS: No, figure 2 is a cross-section.

THE COURT: Yes, but I am referring to 1 and 2 together.

THE WITNESS: 1 and 2. That is what I thought Your Honor was referring to.

The only difference is that in figure 2 of the German patent they have shown the fabric only diagrammatically.

THE COURT: They have what?

THE WITNESS: They have shown the fabric part, the ribbon part, only diagrammatically and have not shown the actual threads as round circles, as is the case in figure 4 of the Ploeger patent. Apart from that, the showing is the same.

THE COURT: When I refer to the figures I mean in light of the text of the specification.

THE WITNESS: In the light of the text there is no difference because the text refers to a fabric and this is merely a rather diagrammatic drawing.

THE COURT: In other words, is it your opinion that there is no difference between the first structure disclosed in the German patent and the structure disclosed in the Ploeger patent?

THE WITNESS: Yes, Your Honor, that is my opinion.

BY MR. ROBSON:

Q Is it also your opinion that the German patent and the Ploeger patent were seeking -- that the inventor of the German patent and the Ploeger patent were seeking the same result, the same product?

A Yes, they started out to overcome the same drawbacks and I think they were -- my opinion is that they were trying to produce the same kind of a product.

THE COURT: Of course this is an admissible question but it does bring my mind to the fact that the Supreme Court held that it makes no difference whether the two were working on the same thing with the same object in view, and of course the striking illustration of that is the DeForrest-Armstrong

controversy.

MR. ROBSON: What I am getting at now is the strength of this witness' opinion.

THE COURT: You may proceed.

BY MR. ROBSON:

Q Would you tell me what in your opinion was the product that was being invented by the German? And I would appreciate it if you would tell me that without looking at the patent.

A Well, if an invention was made by the Germans it was using a thermoplastic impervious film --

Q I think you misunderstand. What was the final result that he was attempting to achieve? What product was he attempting to produce?

A This is a different question than you just asked.

Q That is why I am restating it.

A I will answer this. He was producing a typewriter ribbon with an impervious flexible thermoplastic backing fastened only at the longitudinal edges of the ribbon.

Q And are you saying that he was attempting to produce the same kind of typewriter ribbon as was covered by the Ploeger patent, one which would be impacted by the typewriter key?

A Yes, the typewriter key strikes the impervious backing in the German patent just exactly as it does in Ploeger, for the same reason.

THE COURT: Well, we will take our luncheon recess at this time.

(At 12:30 p.m. trial stood in recess,
to reconvene 1:45 p.m.)

- - -

AFTERNOON SESSION

THE COURT: Mr. Robson, you may proceed.

BY MR. ROBSON:

Q Mr. Norton, I asked you, I believe, as the last question, whether or not the ribbon in the German patent was designed to be struck by the typewriter key in the same manner as the ribbon in the patent in suit, and I believe your testimony was that the ribbon was so designed, is that correct?

A That is my understanding of the description of the patent.

Q Was that your testimony this morning?

A That is correct, that is what the German patent says.

Q May I ask you to read the first paragraph of the German patent, read it to yourself, and then I would like to ask you some questions about it, the first paragraph of the German patent, which starts with the words, "For particular purposes."

(Pause.)

A I have read it.

Q Does that paragraph not refer to the use of this ribbon in place of carbon paper to provide a second original in back of the first original?

A This is a description of the prior art and it is a description of one kind of the prior art and that particular kind is a carbon ribbon, that is, one that --

Q Would you limit yourself to the question, please? Does that paragraph not refer to a ribbon which is a second original? It does, does it not?

A It refers to a carbon ribbon that is between paper.

Q And that first paragraph does not in any way refer to a ribbon which is struck by a typewriter key directly, does it?

A No.

Q Will you look at the second paragraph and tell me whether the second paragraph does not likewise refer only to a

ribbon designed to be used in place of carbon paper?

A Yes, that is also true.

Q Will you refer me to any place in the patent where any other type of ribbon is referred to?

(Pause.)

A In the, I think it's the third paragraph, it refers to --

Q Third paragraph where?

A Third paragraph.

Q On what page?

A In the translation.

Q What page are you referring to, the third paragraph of which page of the translation?

A The third paragraph refers to --

Q Of what page, please?

A -- refers to the ink being given off --

Q Mr. Norton, could you tell me what page you are reading from? The third paragraph of which page?

A Let me see. I was reading in the German. Let me see where the translation is. (Pause.)

This is the third paragraph on the first page of the translation. It states that various attempts have been made in the past to cover one side of ink ribbons in order to

restrict the ink release to the side opposite the type impact.

Q And is it your position now that the use of --

THE COURT: Have you finished your answer?

THE WITNESS: Yes.

BY MR. ROBSON:

Q And is it your position, then, that the use of the words type impact in that sentence mean to you that they are talking about an ordinary typewriter ribbon used to make originals and not a manifold ribbon as described in paragraphs 1 and 2?

A That is my understanding. Type impact means it hits.

Q When for the first time did you read this patent, Mr. Norton?

A About, oh, two months ago.

Q And when for the first time did you read the Ploeger patent?

A At the same time.

Q Which did you read first?

A I read the Ploeger patent first and then I read the German patent on the same day.

Q Didn't you think it would be more fair to read the German patent first, to see what was obvious, before reading the Ploeger patent?

THE COURT: I am going to exclude that question.

MR. ROBSON: I will withdraw the question.

THE COURT: On the contrary, I think the logical thing is to read the patent in suit first and then see whether it is anticipated or whether it is limited by a prior art.

BY MR. ROBSON:

Q Let me call your attention to the third page of the translation, the second full sentence, beginning with the words "In addition." It says:

"In addition, the stiffness of the product achieved in this way assures a problem-free ribbon transport."

Do you have that?

A The third page of the translation?

Q The third page of the translation.

A The second sentence says, "In addition, the stiffness of the product . . ."

Q Yes. Now I ask you whether a stiff product sounds to you like an original inking ribbon or a carbon, a manifold ribbon?

A I don't believe that it makes any difference. If it is an original ribbon it is stiff in the sense that the cover is a smooth surface and not a fabric; and I would say

that that statement, taken simply by itself, would be equally applicable to either type.

Q It is your opinion, then, that an ordinary typewriter ribbon should be stiff?

A No, it is my opinion that when you have an ordinary typewriter ribbon with an impervious cover, that it should be stiffer than the fabric itself.

Q And when you read the words, "The stiffness of the product achieved in this way assures a problem-free ribbon transport," it is your position that that is describing a problem-free ribbon transport for an original ribbon, not a manifold?

A For either kind.

Q For either kind?

A Yes.

Q Will you describe to me how a stiff original ribbon provides problem-free transport?

A It transports without folding over -- I mean without curling, and if it is a carbon or manifold one you don't transport it at the time you hit.

Q I didn't ask you about the manifold, I asked you about the original.

A I do not find anything there that contradicts the--

Q That wasn't the question, Mr. Norton. The question was how the stiffness of an original ribbon improves its transport.

A I answered that. I said that it can't curl over, it can't stick, and it goes smoothly from one spool to another.

Q Are any of the original typing ribbons you have ever seen stiff?

A In that sense, yes. The modern carbon ribbon is stiffer than a fabric ribbon. A fabric ribbon you can take and you can twist around just as you can any other fabric. When you have an impervious film in the back it will bend in the length-ways of the ribbon, which is what is needed to go through the typewriter transport mechanism, but you can't twist it, it won't curl over.

Q Have you ever seen a ribbon with an impervious film before?

A Oh, yes.

Q You have. In addition to the one manufactured by the plaintiff?

A Yes. The modern carbon ribbon that is used very extensively, particularly for electric typewriters, has a smooth impervious film on the back and it is covered with a composition somewhat analogous to that of carbon paper. It

goes through the typewriter once. The type hits the back, the impervious plastic back, and therefore it never gets dirty and the other side makes the impression on the paper. And I have seen many such ribbons.

Q Is that --

A The typewriters my secretaries use both have that kind of a ribbon.

Q Is that a ribbon made of fabric?

A That is a carbon ribbon. There is no fabric.

You asked me if I have ever seen a ribbon with an impervious back, and I have. I have never seen a fabric ribbon --

Q May I correct my question --

THE COURT: Just a moment. Let him finish. Don't cut a witness off.

Have you finished your answer?

THE WITNESS: That is complete, sir.

BY MR. ROBSON:

Q Have you ever seen a fabric ribbon --and when I ask you about ribbon we are talking about fabric ribbons; that is the only kind of ribbon that is involved in this suit, that is the only kind of ribbon that you have testified about-- have you ever seen a fabric ribbon with an impervious film?

A No.

Q Except for the one manufactured by the plaintiff, is that correct? Have you ever seen the plaintiff's film?

A I have seen, glanced casually at the exhibits that were offered here, pieces of ribbon. I have never examined the plaintiff's ribbon carefully, as such.

Q Have you ever examined the ribbon manufactured in accordance with the German patent?

A I have never seen a ribbon manufactured by the owners of the German patent.

Q Do you know whether any ribbon was so manufactured?

A I have no knowledge pro or con.

Q Have you ever made an attempt or seen an attempt made to construct a ribbon in accordance with the German patent?

A No.

Q Have you ever made any attempt or seen an attempt made to fuse, melt, weld, or what have you, a nylon film by applying heat from above to a fabric, nylon or otherwise?

A You are not restricting this to a typewriter ribbon?

Q To a typewriter ribbon, yes.

A No.

Q You have not. Do you have any idea what would occur if such an attempt were made?

A Yes. In reading the Ploeger patent, that is exactly what is described here and is shown in figure 4. I haven't seen it done but I have no reason to believe that the fused nylon would not flow around the threads of the ribbon and that we would get that fusing which is described in the patent. But I have never seen it done.

Q Does the Ploeger patent indicate that the heat is applied from above by heating the thermoplastic film?

A It describes --

Q Would you answer that question? Does it indicate that the heat was applied to the thermoplastic film from above?

A It indicates that the heat was applied to the thermoplastic film. It does not state whether that is above or below at the moment of --

Q Where does it state that the heat was applied to the thermoplastic film in the Ploeger patent?

A I am reading from column 2, beginning at line 16. It says:

"As shown in figure 4, the impervious strip 14 is of a fusible material, and the edges 12a" --that is the fabric edge-- "and 14a" --that is the edge of the impervious film-- "of the strips 12 and 14 are sealed together by

fusing the edges 14a of the impervious strip 14 to the edges 12a of the absorbent strip 12."

Now that is a very clear statement that the edges of the impervious film are fused and they are fused to the fabric. It does not state whether at the instant that was done the impervious film was on top or on bottom.

Q Are you stating that simply because it mentions one before the other, that that indicates to you that the heat is applied to the one first mentioned?

A No. It says that they are sealed together by fusing the edges of the impervious strip 14a. It does not say by fusing the edges of the printing strip 12a. And if it is fusing the edges of the 14a the heat must be applied to it. It will not fuse otherwise.

THE COURT: What lines are you reading from?

THE WITNESS: I started, Your Honor, reading on column 2, line 16, where it starts the sentence, "As shown in figure 4," and I read through to the end of the sentence on line 20.

BY MR. ROBSON:

Q The words on which you rely now say, by fusing the edges of the impervious strip to the edges of the absorbent strip, do they not?

A It says by fusing --

Q Do they say what I just read?

THE COURT: No, no. Please.

MR. ROBSON: I'm sorry.

THE COURT: You may answer.

THE WITNESS: It says that it fuses the edges of the impervious strip to them and then --

BY MR. ROBSON:

Q To the edges of the absorbent strip?

A That is correct. And it says further down on the same column that:

"Although in the illustrated embodiment of the ribbon 10, the edges 14a of the impervious strip 14 are shown to be fused to the edges 12a of the absorbent strip 12, if the absorbent strip 12 is made of a fusible material, the edges 12a of the absorbent strip 12 may be fused to the edges 14a of the impervious strip 14."

Now taking that whole paragraph, it says that, first, the edges of the impervious strip are fused, which is lines 16 to 20 that I first read; and then it says although this is the embodiment shown, if you have a fusible fabric you can fuse its edges to the edges of the impervious strip.

Now that is a statement of another way of doing it. The two together, to me, mean that the first statement is fusing the impervious strip.

THE COURT: Mr. Norton, beginning at line 16 as you read down into that sentence it says:

"The edges 12a and 14a of the strips 12 and 14 are sealed together by fusing the edges 14a of the impervious strip 14 to the edges 12a of the absorbent strip 12."

Doesn't that mean that the edges of the two strips or two layers are fused together, not that the edges of one layer are fused together?

THE WITNESS: Well, Your Honor, the question was did I say that the heat was applied to the impervious. This states that it is fused together. Now you can fuse two pieces together by melting one of them or you can fuse it by melting two of them. And this is a clear description, to me at least, that the impervious strip, the edges of the impervious strip are fused to the other and that they are melted; and this is strengthened by the fact that further down it refers to another modification in which the fabric is fusible and the fabric strips are fused to the other. To me that means in the first case the heat was applied to --

THE COURT: I am afraid I misunderstood your answer.

In other words, in your opinion the Ploeger structure is a structure where the edges of the two strips are attached together by some kind of a fusing process?

THE WITNESS: That is correct. But the drawings of the Ploeger show that only the impervious strip is fused. That is what is shown in figure 4.

THE COURT: But the description covers either one?

THE WITNESS: The description covers either possibility.

THE COURT: But the result is the same in either instance, isn't it, that the edges of the two strips become attached to each other?

THE WITNESS: I would assume that the final result is not changed depending on which one is melted and which one is not melted.

BY MR. ROBSON:

Q Let's go to the claim itself for a moment.

Am I correct that as a matter of patent practice it is the claim which is the original basis of the invention, with the specifications and description and diagrams serving to explain the claim where it needs explanation?

THE COURT: Well, suppose you just ask your

question.

BY MR. ROBSON:

Q Referring you to the claim, do you know which claim is involved in the suit?

A I understand that claim 1 is involved.

Q Referring you to claim 1, claim 1 covers only a nylon film and a nylon fabric fused together along their extreme edges, is that correct?

A That is correct.

Q And what do the words fused together along their edges mean to you?

A It means that they were melted or at least one of them was melted and it attached itself to the other.

Q Does it mean one of them or both of them?

A It means, to me --

Q Without reference to anything else, just those words for the moment.

THE COURT: No, you can't limit a person to two words.

MR. ROBSON: If he can. If he can't, I will accept his statement that he can't answer with respect to just those words.

Q But I would like to know what those words alone

mean to you?

A Do you mean cut off from the whole of the rest of the Ploeger patent or do you mean the Ploeger patent --

THE COURT: I am going to let you ask the question because it is admissible under the rules of evidence, but I am going to suggest to you that the answer might have no probative value because it is the view of the Court that the entire sentence has to be read together as one and taking words out of context is an exercise in semantics but it does not necessarily produce results.

MR. ROBSON: I do not propose to take them out of context and I will let the witness go on.

THE COURT: I don't invite any replies to my comment. You may go ahead.

BY MR. ROBSON:

Q Referring just to those words, what do the words fused together mean to you?

A Fused together means that there was at least one or both melted and that they stuck.

And the second one, that they were both melted, is an interpretation of this claim which would render it contrary to the rules of practice of the Patent Office and, therefore, I assume is not the interpretation that would be made.

THE COURT: Why would it be contrary to the rules of practice of the Patent Office?

THE WITNESS: I read Your Honor Rule 83 in answer to a question of Mr. Hall, which says that every feature in a claim which is capable of being shown in a drawing must be shown.

Now if this claim means, if these words in this claim mean that both the fabric and the backing both melted, then that is something which is not shown in the drawings because the drawings here, figure 4 shows only the film melted.

THE COURT: How does it appear that only one of them is welded or melted?

THE WITNESS: Your Honor, if you look at the edges here you see that the threads of the fabric remain as their circles, but there is a black material shown between the threads and the backing film for a certain distance from the edge. Now that black material in the drawing as shown can only be coming from the backing material because the threads themselves are not shown to have been changed in shape. And that is my reason for that statement.

THE COURT: Couldn't that be ascribed to the draftsman's choice, to use an old-time phrase?

THE WITNESS: I wouldn't think so, Your Honor. I

would say that this is probably what they intended. But I have no means of knowing what the draftsman thought. I can only state what this drawing shows, and it shows the film melted but the threads not melted.

And if that claim, as Mr. Robson asked me, is to be interpreted that both were melted, that is not what is shown here, that would be a feature of the claims that could be shown in drawings, and it would therefore have been in violation of Rule 83, and I was not putting an interpretation on the claim which I think would be unfair that would have rendered it contrary to the rules of practice.

THE COURT: Well, now, the claim standing alone would cover a structure, would it not, where the edges of both strips are melted and fused together, as well as the structure in which only one is melted and is fused to the other?

THE WITNESS: Your Honor is absolutely correct. The term fused is a broad term which can mean that one melted or both melted.

The question as I understood it was, does this mean that both were melted, and if that is --

THE COURT: It may mean either one?

THE WITNESS: It may mean either one; that would be proper. But if it means only the other, it would be in

violation of Rule 83.

THE COURT: I think the Court will determine whether it is in violation or not, but you, as an expert, can help the Court by construing the claim.

THE WITNESS: I meant to say that that is my opinion, that it would be in violation.

THE COURT: I understand. But irrespective of that, whether it would be in violation or not, your opinion is that this claim covers both types of structures?

THE WITNESS: It is, Your Honor.

BY MR. ROBSON:

Q If this claim may be interpreted or is interpreted as covering a fusion which includes a melting of both materials, would that change your opinion as to whether or not it was non-obvious in light of the German patent?

A No, it would not, because the German patent in its so-called second method of bonding these edges together, that is, the Arabic 2 paragraph appearing on page 3 of the translation, in that modification of the German patent they add a further fusible strip, so that there are three strips, and they say that all three are firmly welded together under heat, and therefore, to me, this is a clear teaching that you may melt the fabric as well as the impervious film.

Q Do I understand --

THE COURT: Mr. Norton, in the German patent there is more than one embodiment, is there not?

THE WITNESS: Yes.

THE COURT: The first embodiment, which is illustrated by figures 1 and 2 and which is described in greater detail in the specification, contains just two layers, doesn't it?

THE WITNESS: That is correct.

THE COURT: And the two layers are joined together at the borders, according to the description, and isn't that broad enough to cover a case of either both being melted and fused together or only one being melted and fused together?

THE WITNESS: The particular description of the number one method describes melting only the film. As I understood the question, the last question that was put to me, it was would I consider it obvious to have both of them melted, and I referred to the second modification, which shows that the Germans considered melting more than one thing, and therefore I would have the same opinion that it would be obvious.

THE COURT: The first claim of the German patent is broad enough to cover both types of joinder, is it not, if

you look at the first claim in the translation?

THE WITNESS: The first claim of the German patent says joined to the ink ribbon along the borders only. That language is broad enough to cover it joined by melting one or by melting two.

THE COURT: That is what I had in mind.

THE WITNESS: Yes.

BY MR. ROBSON:

Q In the German patent the material that carries the ribbon is made of what product or what type of product?

A The German patent describes specifically only one material for the inking ribbon and that is silk.

Q What sort of silk?

A The finest silk of the finest weave.

Q I call your attention to the translation which is in issue and with which we are dealing and I ask you whether it does not talk about a silk tissue?

A At what point are you referring?

Q The same point you were just reading.

A This occurs in the first paragraph of the third page. I do not mean the first paragraph that starts on there but the first paragraph that ends there and it is the sentence beginning on line 6. It says it's now possible to use the

finest silk, and the translation says tissues and the German says weave.

Q We are referring now to the translation which has been offered by the defendant here and with which we are dealing, and that says tissues. And a tissue is normally not a fabric but a paper of some sort, is it not, made of silk, is it not?

A I have never seen a silk tissue that was not a fabric but I suppose it is theoretically possible.

Q Have you ever seen cotton tissue?

A I have seen cotton, non-woven cotton tissue, but I have never seen a non-woven silk tissue.

Q Does the fact that this is to be used in a construction in substitution for carbon paper cause you to believe that we are talking here about melting or soldering or gluing a thermoplastic to a paper of some sort and not melting one to the other?

A You mean that because it can be used for carbon paper or a transfer sheet?

Q We are talking now about a ribbon to be used as a replacement for carbon paper, which is to be stiff and which has been described by the German translator as a tissue. Now does that not indicate to you, reading this patent that we

are talking about some sort of paper to be placed behind the original and that we are not talking about a ribbon at all?

A It does not. When I read —

Q That is your answer, it does not.

THE COURT: Just a moment. Don't cut a witness off like that. We don't do that here.

BY MR. ROBSON:

Q Do you want to explain that answer, Mr. Norton?

A I say it does not because I also, as I told you, read the German patent. The German says a weave which is used only to a fabric, the finest silk weave. And I read both and that is why —

Q You have answered the question.

THE COURT: Will you suspend for a moment. (Pause.)

You may proceed, Mr. Robson.

Q Can you tell me whether the German patent was designed to protect the type, whether there is any indication in the patent that it was designed to protect the type face?

A I do not recall any particular point that states that the face of the type that strikes it is protected. It is, but there is no specific statement in the patent.

Q Can you tell us what the size is of the ribbon referred to? What sizes are they supposed to be constructed

in? Is there any indication of that in the patent?

A There are no numerical figures, but the drawings, diagrammatic though they may be, show a structure that is very long in comparison to its width, which I would refer to as a ribbon.

Q Do you have any idea how long that ribbon was designed to be?

A No.

Q Do you have any idea how wide the border, the border referred to in figures 1 and 2, that is, in the first embodiment, how wide was the border which sealed the two materials together supposed to be?

A They do not give figures, but they do show very clearly on the drawings that this is the extreme edge and, therefore, very narrow in comparison to the width of the ribbon.

Q Will you look at figure 2 and I call your attention to a small white portion in the middle of that cross-section.

A Yes.

THE COURT: That is figure 2 of which patent?

MR. ROBSON: The German patent.

BY MR. ROBSON:

Q I call your attention to a small white portion in

the center of that and I ask you what that small white portion represents to you?

A It bears the number 1, which is applied to the ink carrying material, but I have got to read this as a cross-section through figure 1, not as standing simply by itself; and in figure 1 these borders which are numbered 3, the points or strips the translator calls them correctly, are very narrow in comparison to the width of the ribbon. I don't know why the cross-section looks different from the other figure; they don't explain.

Q I am not sure I understood that. There is a small white portion in the middle of figure 2. Do you see that? It is approximately an eighth of an inch wide, is that correct?

A Yes, it's narrow compared to the whole of the ribbon.

Q Just stick with me because it is difficult enough for me to understand this --

A It is about an eighth of an inch on the drawing.

Q And the whole cross-section shows a ribbon about one inch wide, is that correct?

A If that is one-eighth inch, that is correct.

Q What does that one-eighth of an inch of that white portion of that cross-section indicate to you, what is that?

supposed to be as you read this diagram?

A I find two drawings which do not agree.

Q Can you answer the question, Mr. Norton? What does the white portion appear to be to you?

A It appears, according to the description, to be the ink carrying --

Q Portion of the ribbon, does it not?

A Yes, that is what I have said.

Q And the two black portions on either side of it appear to be what?

A The black portions -- there is a number 3 at the extreme edge and if that is intended to cover the whole of that black portion, then those are where the two are together.

Q The cross-section, then, the diagram which modifies the claims would appear to indicate a rather wide border and a rather narrow ink bearing portion, is that correct?

A That one figure would so indicate.

Q Is that correct in that figure?

A Yes.

Q Now you say in that figure, implying that in the other figures the situation might be different.

Will you look at the other figures, figures 4 and 6, and tell me whether the same thing is not true in figures

4 and 6?

THE COURT: What same thing?

MR. ROBSON: That the ink bearing portion represents --

THE COURT: Suppose you reframe your question.

BY MR. ROBSON:

Q Tell me whether it is not true that in figures 4 and 6 the dark portions representing the fused border which is fused together, is much larger than the white portion representing the ink bearing portion of the ribbon.

THE COURT: I am afraid I don't understand your question. Well, perhaps I don't have to. It is the witness that has to understand it.

MR. ROBSON: Perhaps Your Honor didn't hear the question I was asking earlier about figure 2.

THE COURT: That doesn't help me. What do you mean by one portion being larger than the other?

MR. ROBSON: Looking at this face-on as a cross-section, the dark portion represents the portion of the ribbon which is bound together.

THE COURT: There is no dark or light portion.

MR. ROBSON: There is, Your Honor. It is very difficult to see, you may have a bad copy, but there is one-

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MR. ROBSON: There is, Your Honor. It is very difficult to see, you may have a bad copy, but there is one-

eighth of an inch in the middle of that cross-section is white and the balance is black.

THE COURT: All you see is black lines, but there is no black portion.

MR. ROBSON: There is a white portion in the middle of that. Perhaps you can see it better on this.

THE COURT: Very well, proceed in your own way.

BY MR. ROBSON:

Q Is it correct to state, then, Mr. Norton, that on the basis of your looking at the three cross-sections which appear here in figures 2, 4 and 6, it would appear that the border, the fused border is extremely broad and the ink bearing portion is extremely narrow in comparison or relation to that border?

A As far as those three cross-sections is concerned your statement is correct.

Q Now is there any indication in the German patent that the material, be it tissue, paper or fabric, which bears the ink, may be or should be made of a thermoplastic material?

A The German patent is silent as to what that is to be made of, except that in discussing the second modification that is where there is an additional strip of fusible material laid on top of the impervious strip --

state that this additional strip is on top of the impervious strip, whereas if I understood your question now you said isn't that in between them.

THE COURT: No, I didn't mean in between them. It over-lays them, doesn't it?

THE WITNESS: It's on top of them, on top of the impervious.

Now if I may complete my answer, in that modification the German patent states -- and this is this number two modification on page 3 of the translation, where they describe the ink-free strip of tissue placed over the borders of the thermoplastic film. And then they describe the next sentence, the three. That is to say, the ink-bearing material, this ink-free layer, and the thermoplastic film. All three are firmly welded together -- or I believe you objected to that and said you wanted to use the word fusing, and I am quite willing to use your word fusing. But saying that the three are fused together, to me means that all three must have been melted to some extent or they would not have fused together because that would be the ordinary interpretation of it.

Now, to me, that indicates that the Germans contemplated also using an ink-bearing tissue which was fusible.

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THE COURT: That is shown in figures 3 and 5, is it not?

THE WITNESS: That is shown in figures 3 and 4.

THE COURT: What about 5?

THE WITNESS: Well, 5 had a thread. It's a textile thread.

THE COURT: Figures 1 and 2 are the only figures showing a direct connection between the edges of the two strips, are they not?

THE WITNESS: Yes. But the question was asked whether there was any indication --

THE COURT: Yes, I understand. I am asking something else.

THE WITNESS: Oh, I beg your pardon, Your Honor. What was it?

THE COURT: You have answered my question.

Of the three embodiments showing in the drawings, only the first embodiment shows a direct connection between the edges of the two strips, the other two show an intermediate body, be it a strip or a thread, used to make the connection; is that not the case?

THE WITNESS: Not quite, Your Honor. Your first statement is absolutely correct. The second statement, they

state that this additional strip is on top of the impervious strip, whereas if I understood your question now you said isn't that in between them.

THE COURT: No, I didn't mean in between them. It over-lays them, doesn't it?

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Now, to me, that indicates that the Germans contemplated also using an ink-bearing tissue which was fusible.

BY MR. ROBSON:

Q Whatever the Germans may have contemplated, what appears in the patent --

THE COURT: Mr. Robson, please remember that you are not to argue with the witness, just to ask him questions. I know there is a tendency in patent cases sometimes to get into an argument with the expert. That neither helps the Court nor saves any time.

Q Will you ignore for the moment whatever it is you think the Germans may have been contemplating --

THE COURT: You can make your argument to the Court at the proper time and not to the witness.

Q Is there anything in the patent, in the patent itself, which indicates that the ink-free strip of tissue referred to and the inked ribbon referred to in claim 2 is made of a thermoplastic material?

A Yes, because as I read before, the statement is made that these three are firmly welded or fused together with heat, and to me that means that they must have been fusible. Therefore, I think that the German patent at least makes some suggestion that that tissue --I am using your word tissue now-- might be a fusible one. You asked me whether there was any suggestion in the German patent and that is my answer.

Q The word I used was not any suggestion. I said is there any statement in the German patent to indicate that the ink-bearing tissue or the ink-free tissue is made of a thermoplastic material.

A I have answered that this statement indicates to me that it was of a fusible material.

Q Is it correct, however, that nowhere does the word thermoplastic modify the word tissue in that patent?

A That is correct.

Q And nowhere in listing the nature of the tissue or the matters which can go into making up the tissue, is thermoplastic material included as a possibility, is that correct, in those very words?

A That is correct.

MR. ROBSON: Would Your Honor bear with me for just one moment.

(Pause.)

BY MR. ROBSON:

Q Incidentally, the German patent nowhere refers to nylon at all, does it, in those words?

A That is correct, the word does not appear.

Q Do you know, Mr. Norton, whether or not the Patent Examiner who examined the Ploeger patent had before him the

German patent?

THE COURT: I think the file wrapper speaks for itself.

MR. ROBSON: I don't mean whether he used it as a reference, but whether it was available to him.

THE COURT: I don't think that is appropriate cross-examination, at least so far as this question is concerned.

BY MR. ROBSON:

Q Is it not a fact, Mr. Norton, that in the Patent Office prior patent references are filed by class number?

A Class and sub-class number, that is correct.

Q And is it not a fact that the Patent Examiner examines every --

THE COURT: I think the Court has a little familiarity with the routine of the Patent Office, not too much but a little.

MR. ROBSON: I am sure it is much more than I have, Your Honor.

Would Your Honor bear with me for just one or two moments and let me consult with co-counsel? I may be completed but I want to check. (Pause.)

I have no further questions, Your Honor.

REDIRECT EXAMINATION

BY MR. HALL:

Q Mr. Norton, I'd like for you to look at page 2 of the translation, the last six lines and particularly the passage that reads:

"The ink-carrying tissue on the entire surface of the ink ribbon, or ink screen, is thus covered by only a loosely touching film."

And I refer you to the word "entire." Does that shed any light on how wide the ink portion is and how narrow the borders are?

THE COURT: Mr. Hall, what page were you reading from?

MR. HALL: Page 2, the last six lines. It reads:

"The ink-carrying tissue on the entire surface of the ink ribbon, or ink screen, is thus covered by only a loosely touching film."

Q Now does that shed any light on how wide the borders are?

A Yes, it does. That is consistent with figure 1, which shows very narrow borders. I mean very narrow in proportion to the width of the ribbon, and it indicates to me that either the reproduction of figure 2 is poor or the drafting

is poor because it is contrary to that statement and it is contrary to the figure 1 of which it is supposed to be a cross-section; and I, therefore, still believe that those borders are shown as very narrow in comparison to the width of the ribbon.

Q Now I'd like for you to look at the following passages which I will refer to, and I will refer to several, and then you tell me if this sheds any light on whether the ink-carrying tissue is something like carbon paper or something more like a typewriter ribbon.

I first refer to page 1, eight lines from the bottom:

"Ink ribbons have thus been impregnated on one side or coated with suitable means."

And then going over to page 2, the last paragraph, the third line:

"Joining this film to the ink ribbon, or ink screen respectively."

And then going over to the drawings, the description of the drawings at the bottom of page 3, it says:

"Figure I shows an ink ribbon."

And then you will notice that the claims are both addressed to an ink ribbon.

Does any of this help you in telling whether this

is like carbon paper or whether it is more like an ordinary typewriter ribbon?

A Yes, it does. An ink ribbon, which is true of the ordinary typewriter ribbons up to recently, is not a piece of carbon paper or was not, at least, in those days, and therefore it means, to me, that this was a ribbon and that it was a fabric as the ordinary ribbon is. And as the German word that has been, I think, somewhat loosely translated as tissue, the German word says woven fabric, Gewebe; that is never used in German for a tissue that is not woven, like a piece of Kleenex.

And, therefore, to me, reading both the German and the translation, the German patent clearly indicates that the ribbon was a woven fabric of some kind.

Q Now look at the very last word of the German patent, where it cites the U. S. patent to Francis, at the very end of the German patent. Now tell me, is the German patent to Francis for a typewriter ribbon?

THE COURT: To which line are you directing the witness' attention?

MR. HALL: The last line of the German patent. It says references to other printed materials and then it cites the Francis patent.

THE WITNESS: May I have your copy of the Francis patent again? I don't seem to have a copy here.

The Francis patent talks generally of an ink transfer element and in the second paragraph, beginning on column 1, it talks about various expedients having been tried in an attempt to provide typewriter ribbons which, when struck by the type face, would not liberate ink.

I would assume from this that the Francis patent was clearly directed to a typewriter ribbon and not to carbon paper.

BY MR. HALL:

Q Now I'd like for you to look at claim 1 of the German patent. Is it true that under German practice they first state what is old in the art and then follow that by the word characterized and then state what is new?

A That is correct.

MR. ROBSON: If Your Honor please, I object to what the German practice is as hardly binding on one in the United States who is supposedly --

THE COURT: What is your point?

MR. ROBSON: I object to what is the practice in the German Patent Office as having no bearing on the issues in this case.

THE COURT: I will allow the question. In fact, it is unnecessary because the Court is very familiar with the fact that German and English claims are drawn in a different way than American claims, and I wish our claims were drawn in the German or English way because the carrying element of the claim is always introduced by the words characterized by or characterized in that. I don't think you need to ask the witness that.

MR. HALL: I don't, because the first time I ever heard of that as a patent lawyer was that somebody told me that Judge Holtzoff thought that the U. S. claims ought to be drawn that way.

THE COURT: Yes, I do, because you can read the average patent issued by our Patent Office and you don't know what contribution the inventor made to the art in which he is working.

BY MR. HALL:

Q Mr. Norton, would you say that the first two lines of claim 1 of the German patent are descriptive of the U. S. patent to Francis which was cited as a reference in the German patent?

A Yes.

Q So the last two lines of the German patent which

characterized his invention are telling how he has an improvement over the Francis patent, is that correct?

A That is correct.

Q And the Francis patent is a typewriter ribbon with a nylon backing going clear across the back of it?

A That is right, and this is characterized that this German patent invention was fastened only along the borders. That is correct.

Q Now did the Patent Office Examiner, when he examined this Ploeger case, cite any patent that had fusing along the edges only?

A He cited -- you used the word fusing, didn't you?

Q Yes.

A I don't recall that the Patent Examiner showed any patent in which the borders were fastened by fusing. He did show one where they were fastened together, but presumably by adhesive or similar means. That was the old Phelps patent of 1936.

MR. HALL: No further questions.

MR. ROBSON: No further questions -- just one moment, Your Honor. (Pause.)

Could we have the last answer read?

THE COURT: Yes.

(The Reporter read the last answer.)

RECROSS-EXAMINATION

BY MR. ROBSON:

Q Mr. Norton, you stated in answer to the last question that the Patent Examiner did not refer to any patent in the prior references in which the borders were sealed by fusion, is that correct?

A That is correct.

Q Would you look at the file wrapper and tell me whether the Patent Examiner did not refer to the Murphy patent as one of the prior references?

THE COURT: What page of the file wrapper is that?

MR. ROBSON: You can see that on the back of the patent itself, Your Honor, column 4 on the back page of the patent are the references cited.

THE COURT: Which patent?

MR. ROBSON: Murphy. That is the second from the last United States patent.

THE COURT: Well, he did.

Q He did, did he not, Mr. Norton?

A The Murphy patent did not -- one modification, the backing was folded over.

Q I can't hear you.

A In one modification, the backing was folded over.

That was figure 1. And in others, as I recall it, there were more than the edges fastened together.

Now, I am not quite sure if I am mistaken that I think you may be right that figure 2 had the edges only. My memory of Murphy was that it was either one edge or more than one extreme edge. Figure 2, however, said that there were two relatively narrow elongated strips of nylon fabric that are joined along longitudinal edges by two substantially continuous welds. I was reading from the paragraph that started on column 2, page 23. You are correct, I had overlooked that second figure.

Q So that the fusion of two thermoplastic materials along the edge was a prior reference considered by the Patent Examiner when he granted the patent in suit?

A Yes; and I would like to correct my last answer on redirect when I said there was no mention of anything.

MR. ROBSON: Thank you. No further questions.

FURTHER REDIRECT EXAMINATION

BY MR. HALL:

Q The Murphy patent does not have a film backing, does it?

A The Murphy -- let me read it. (Pause.) No, there was not an impervious film. But your question, Mr. Hall, was,

was there anything along the edges, and I was thinking wrongly that there was nothing fastened along the edges.

Q Let me rephrase my prior question and say the Examiner did not cite any ribbon with a film backing that was attached to the ribbon -- that was fused to the ribbon along the edges only?

A Answering that question, I would state no.

MR. HALL: No further questions.

MR. ROBSON: No further questions.

THE COURT: The witness may stand down.

We will take our usual mid-afternoon recess at this time.

(Recess.)

THE COURT: You may proceed.

HARRY H. FARRELL

called as a witness by Defendants, having been duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. HALL:

Q Would you state your name, age, and occupation?

A Harry Hilton Farrell, and I operate an office machines business in Arlington.

Q Are you now employed by the Spellright Corp.?

A No, I am operating my own business.

Q Were you ever employed by the Spellright Corp., and if so, over what period of time?

A Yes, I was employed by the Spellright Corp. from January 1961 through 1965.

Q Did there come a time when the Spellright --

THE COURT: We always ask a witness' address, for the record.

BY MR. HALL:

Q What is your address?

A My home address or business?

Q Both.

A My home address is 1534 North Stafford Street, Arlington, Virginia. My business address is 3434 North Washington Blvd., Arlington, Virginia.

Q Did there come a time when the Spellright Corp. moved to Cedar Street?

A Yes, we moved to Cedar Street.

Q Can you identify the time?

A It was January, right after Christmas of 1963.

Q January of 1963?

A Yes, sir.

Q Shortly after you moved to Cedar Street -- I will

withdraw that question.

I will show you a ribbon which has been marked Plaintiff's Exhibit 7-B and ask you if the Spellright Corp. was making and selling ribbons of this type at the time you moved to Cedar Street?

A Yes, we were.

Q Was this the regular line that Spellright was selling, their regular ribbon?

A Yes, it is.

Q That's got one-half of it is a printing portion connected to the other half by Scotch tape, is that correct?

A That is correct, yes.

Q Just after you moved to Cedar Street did you have anything to do with making some other ribbons?

A Yes. When we moved to Cedar Street I was working with Mr. Wolowitz on experimental ribbons, trying to improve and develop the Spellright ribbon, and our work was solely on the experimental end of it.

Q During the month of January, just after you moved, did you make any of these experimental ribbons at that time?

A Yes, we did.

Q Did these ribbons have Mr. Ploeger's material in them on the inked side?

A Yes. We used Ploeger material. We had quite a bit of Ploeger's material.

Q I am speaking of the inked ribbons that you made just after you moved, that is, the ones you made in January.

A The ones we made in January we made originally with other materials. Those are the ones we made first in January.

Q Then what happened after you made the ones with the non-Ploeger material?

A We had problems developed with them and we later started -- we had quite a bit of Ploeger material on hand and we started using up the Ploeger material.

Q In the experimental ribbons?

A We used it in the experimental ribbons, yes, sir.

Q I have put on your desk a Ploeger -- a ribbon that has been marked Plaintiff's Exhibit 17 and I ask you if the printing half of that ribbon is made of Ploeger's material?

(Pause.)

A Yes, sir.

Q Would you tell us how that ribbon was made? If you can, show the Judge just what was done to make that ribbon.

A This is one of the ribbons that we made by putting the white correcting material down and the inked portion on

top, in this manner, and cutting it along this edge.

When you open it up, of course, you would get this, by putting it down in this manner, then cutting it along this edge here.

Q Let's see if we can illustrate that to the Judge a little better.

As I understand it, you had on hand -- Spellright Corp. had purchased over a million tape yards of material from Ploeger through Schwarzenbach-Huber, is that correct?

A That is correct.

Q And at this time you had a large quantity of it on hand?

A Oh, yes.

Q And your regular spellright ribbon attached this to the correction portion by Scotch tape?

A Correct.

Q And now you are going to do the same thing, only you are just going to attach it a little different way, is that right?

A That is correct.

Q Now let's see what you did.

I am going to lay down a sheet of paper on the Judge's bench and can we assume that that is a strip of Mr.

Ploeger's material?

A All right.

Q And then you laid on top of it a piece of correction material with a film backing on it?

A Correct.

Q And then you heated the edge with a hot instrument of some kind to weld them together?

A Correct.

Q And then you unfolded it and you had a ribbon?

A That is the idea.

Q Mr. Farrell, I refer you to Plaintiff's Exhibit 18 which is in evidence and which gives the date on which the Spellright Corp. furnished Abraham & Strauss ribbons. It says that they furnished them 20 dozen ribbons for three stores during the month of April and 7- $\frac{1}{2}$ dozen ribbons in May. These are what are called Mark II ribbons. How did those ribbons compare with Plaintiff's Exhibit 17?

A The ribbons that we used there were these ribbons that we have just illustrated using here.

Q The printing half was Mr. Ploeger's material?

A That is correct.

Q The very material that Spellright had bought from him?

A That is correct.

Q And it was attached onto the correction material by this means that you have described?

A Correct.

Q Did there come a time when the Spellright Corp. got its own inking machine?

A Yes, we bought an inking machine in 1963 and we started doing our own inking then.

Q Was anything done with reference to the box of the ribbons at the time you got your inking machine?

A Yes. The ribbons that we sent out we used, in addition to the regular box, we put a label on it to the effect of improved ribbon, longer lasting. I don't recall exactly the wording of that but it was put on the box because we were using an improved ribbon.

Q Could you look at this box, Plaintiff's Exhibit 7 -- oh, that box doesn't have it on. Excuse me.

I would ask you to look at the box Plaintiff's Exhibit 10 and ask if this box has the label on it?

A Yes, it does.

Q What does that label refer to?

A The improved inking that we were doing after obtaining our own inking machine.

Q And you used that label not only on the experimental ribbons but the other ribbons as well, is that right?

A Yes, sir, that is correct.

Q If they had been inked on your new machine?

A That is right.

Q Now when these experimental ribbons were sent out do you know what was put in the box with them?

A In most cases we used a mimeographed tab or copy to go with them, in addition to the other one, or sometimes it was eliminated and just put the mimeographed in there with it to help identify it.

I was solely interested in experimental, the experiment and development of Spellright and I didn't follow through too closely on packaging the thing.

Q So you are really not sure what was put in the box?

A No, I am not.

Q Now let's discuss for a moment these ribbons that were made out of non-Ploeger material around January. Do you recall how they were made?

A We made those by using a layer of material or nylon covered by a layer of plastic material, another layer of plastic material and another layer of cloth, and through that it was cut through the center, and in so doing, of course,

when you opened it up it would form the same thing.

MR. HALL: I ask that this letter of December 18, 1961 from Mr. Ploeger to Mr. Wolowitz be marked Defendants' Exhibit 12 for identification.

(Letter of December 18, 1961 from
Mr. Ploeger to Mr. Wolowitz
marked Defendants' Exhibit No.
12 for identification.)

BY MR. HALL:

Q Do you recall when the Spellright Corp. received that letter from Mr. Ploeger?

A Yes, the letter is dated December 18th, 1961. I remember it, yes.

Q And there was a spool of material that came along at about the same time from Mr. Ploeger?

A That is right.

Q You described these experimental ribbons that were made by Spellright in January of 1963 out of non-Ploeger material. Had Mr. Wolowitz demonstrated experimentally that method of making ribbons to you at some earlier date?

A Oh, yes.

Q When did he first demonstrate that to you?

A In September, the latter part of September, first

of October; right in there.

MR. ROBSON: May I have the year? September or October of which year?

BY MR. HALL:

Q How did that compare --

MR. ROBSON: Just one moment. The witness didn't indicate what year, Your Honor. He said September or October, and I don't know what year.

THE COURT: Of what year?

THE WITNESS: '61.

Q How do you know that? Do you have a bench-mark that you can relate that to?

A Yes. We were all -- I say we were all, Mr. Wolowitz and I both were quite enthusiastic over the idea, and he did it in a very crude manner, of course, because it was only an experiment, and by using an ordinary kitchen knife and a blow torch; and in November he re-demonstrated the same thing to his son, who happened to be out from school on Thanksgiving vacation.

Q And this was in your presence?

A Yes, it was.

Q And are you positive that it was a month or two prior to the time you people received this letter of December

18th, 1961?

A Oh, yes.

Q In the ribbons which you were making during the first half of the year 1963 would you say that Spellright's ribbons were heavily inked, lightly inked, or how was the inking done?

A Until we obtained our own inking machine the inking was done by other companies and was a problem for us; and we used -- do you mean the ribbons that we --

Q Let's limit it to the experimental ribbons, how were they inked?

A They were -- on the experimental ribbons we used some Ploeger material and, of course, that was inked by Ploeger or someone else; and we had materials inked by different companies. We were experimenting with different types of inking and so forth.

Q As for the inking that was done in your place of business, what --

A Type of ink we used?

Q I don't mean the manufacturer's name or anything like that, but can you tell us how thick it was, whether it was very light, very viscous, or --

A We used a heavy paste-type ink.

Q Mr. Farrell, when the Spellright ribbon is in a typewriter is the inked portion of the ribbon vertically above the correction portion?

A It is.

Q And what happens if any of the ink happens to creep down onto the correction portion?

A Well, it will render the correction portion unusable.

Q Now if you used an ordinary ink and inked the ink strip in the ordinary way, what would you expect to happen to the ribbon over a period of time?

A It would bleed.

Q And ruin the correction portion?

A Right.

Q And for that reason you have to go to this heavy paste instead of the lighter ink?

A That is one of the reasons, yes, sir.

Q And you apply it lightly on the surface of the ribbon?

A Yes, sir.

Q You don't attempt to inject it into some reservoir that might exist in the back of the ribbon?

A Well, we did both.

Q Well, I mean on these experimental ribbons that went out, how was the inking done?

A Well, the inking, I think, was pressed through, pretty much, in those ribbons.

Q With this heavy paste?

A Yes, sir.

MR. HALL: No further questions.

CROSS-EXAMINATION

BY MR. ROBSON:

Q What was your position with Spellright, Mr. Farrell?

A Mr. Wolowitz and I were working together. I was on the board of directors of Spellright; that is, later. And my job with Spellright was strictly developing the Spellright ribbon.

Q What were your duties? Let's put it that way.

A I worked very closely with Mr. Wolowitz on any ideas he had, plus my own ideas, in trying to improve the Spellright ribbon.

Q Did you spend eight hours a day at the Spellright plant?

A Yes, indeed I did; 16, 20, sometimes.

Q What did you do, did you supervise manufacture or sales or wrapping or what?

A No, indeed, I did not. The Spellright ribbon that was in production, we had others doing that. I was solely

developing new ideas and improving the Spellright ribbon.

Q The first Spellright ribbon was just a piece of ribbon connected to the correcting portion with Scotch tape, is that correct?

A Yes, you could say that.

Q Now there came a time when you commenced using ribbon processed by the Filmon Corp., Mr. Ploeger's company, is that correct?

A That is right.

Q Do you remember when that was?

A It was in -- I don't remember the dates that we first, or Mr. Wolowitz first started purchasing ribbon from Ploeger, no.

Q You remember that sometime in September or October, and you are fairly certain of that month, Mr. Wolowitz showed you this process. Can you tell us with respect to the date when he showed you this process for cutting or welding or sewing, when you started using the material supplied by the Ploeger Company?

A That was in 1961.

Q Right. And when did you start using the material with relation to that date?

A Well, we were using the material then.

Q In other words, is it correct that you were using the Ploeger material already, at the time that Mr. Wolowitz showed you the method of making that cut which you have described here, is that correct?

A Yes.

Q Did Mr. Wolowitz tell you where he had learned that process or how he had come to learn that process?

A No, he didn't.

Q Did you ever ask him?

A No, I never asked him.

Q Did he just come in one day and say, Look, I have got a great new way of cutting this?

A No, he come in and he was very enthusiastic and he said, I have a new idea, let's try it, and we did.

Q At the time you were using the Ploeger material in the Spellright ribbon were you manufacturing ribbons using any other material?

A No.

Q Now, I believe it is correct, is it not, that you used the Ploeger material from approximately September 1961 until approximately September 1962, is that correct?

A We used it later than '62.

Q Let me rephrase that question. You are correct.

Is it correct that your relationship with Ploeger or the Ploeger companies lasted from September 1961 until September 1962 and thereafter a rift developed?

A I couldn't answer the question. I don't know the answer to it. That was out of my bailiwick.

Q Directing your attention now to the period from September 1961 until you moved your plant in January 1963, a period of approximately 15 months, during that entire period of time did you use the Ploeger material exclusively in manufacturing your ribbons?

A Yes, we did.

Q Did you make any experimental ribbons during that period of time?

A We made many.

Q Would you describe what the nature of the experimental ribbons, if any that you can recall, what sort of ribbons did you make in that 15-month period?

MR. HALL: Well, Your Honor, we ought not to have to tell them all of our experimenting that we did.

THE COURT: I think you better ask one question at a time. Don't ask the witness to give a whole narrative.

BY MR. ROESON:

Q How many other types of experimental ribbons did you

work on?

THE COURT: I would like to be informed what the relevancy of all this is.

It is not denied, in fact, admitted expressly, affirmatively, that the defendant was manufacturing ribbons which corresponds to Plaintiff's Exhibit 17. The only question is, was it an infringement and was the plaintiff's patent valid.

Now is there anything else to the first cause of action?

MR. ROBSON: No, sir. I am directing these questions in an attempt to get at the question of whether it was an infringing ribbon. Maybe I am doing it a little awkwardly, but that is what I am leading to.

THE COURT: Whether it was an infringing ribbon or not is a question that has to be determined by comparing the structure with the claims.

MR. ROBSON: All right, let me withdraw the last question and go to this point:

BY MR. ROBSON:

Q You were shown a ribbon which has been identified as Exhibit 17, which I believe is on the table before you, is that correct?

THE COURT: Yes, he has. That question is excluded. He has been shown it and it is there.

BY MR. ROBSON:

Q When did you see Exhibit 17 for the first time before testifying today?

THE COURT: I am going to ask you this question: what is the relevancy of this to the issues involving the first count of the complaint? The only question that has to be determined, it seems to me, the way the evidence has been developed, is the plaintiff's patent valid; second, is plaintiff's Exhibit 17 an infringement of it. You don't have to prove they were making Plaintiff's Exhibit 17 because they admit it.

MR. ROBSON: If I understood this witness' testimony correctly, he testified that Exhibit 17 was manufactured with plaintiff's material and not material which infringed. Now maybe I misunderstood, but perhaps I ought to ask him that. That was his direct testimony, I understand.

THE COURT: Very well, I will let you proceed in your own way. I want you to have full opportunity to present your theory.

Q Is it your testimony that the inked portion of Exhibit 17 was manufactured or processed by one of the Ploeger

companies?

A Yes.

THE COURT: Well, you put the ribbon together and sold it commercially, isn't that it?

THE WITNESS: That is correct.

THE COURT: Who inked it?

THE WITNESS: The material was purchased through Schwarzenbach-Huber and I understand that Ploeger was the people that actually did it for them.

THE COURT: Who inked the material?

THE WITNESS: I really don't know.

THE COURT: Did your concern purchase the material?

THE WITNESS: We purchased the material.

THE COURT: And then you sent it over to Ploeger to be cut, is that it?

THE WITNESS: No; we purchased it from Schwarzenbach-Huber and they had it done at Ploeger, had the material cut. Then as I understand it, it was sent out to other companies to be inked, Eaton Allen --

THE COURT: Did Spellright have any direct connection with the Filmon Process Corp. in connection with these transactions? Did you have any direct dealings with Filmon?

THE WITNESS: With Filmon? No, I didn't. I don't

know anything about --

THE COURT: When I say you, I mean Spellright.

THE WITNESS: No, sir. You see, Your Honor, as I understand it, Schwarzenbach-Huber were the sales agent and Ploeger were the ones that did the work.

THE COURT: I see.

THE WITNESS: I was only interested in the actual development of the ribbon, and the purchasing was done mostly by Mr. Wolowitz.

THE COURT: Very well.

THE WITNESS: Perhaps I didn't understand about those things --

THE COURT: You have answered my question.

BY MR. ROBSON:

Q How do you determine, or did you determine that the ink portion of Exhibit 17 was made by or processed by the Ploeger Company?

A The manner in which the backing is put on.

Q Did you examine that piece of ribbon at any time under a microscope or with any other instrument?

A No, I haven't.

Q Have you ever seen it before you sat down in the courtroom today?

A This particular spool?

Q This particular spool.

A I couldn't say that I have or have not. We made many ribbons.

Q Did Spellright obtain printing ribbon similar to or identical to the ribbon on Exhibit 17 from any place other than Schwarzenbach-Huber?

A Not to my knowledge.

Q Did Spellright make material similar to that in its own plant at any time?

A We made some material similar to this later.

Q When was later?

A Oh, we were making these experiments and we attempted to do it, but not very satisfactorily, so we continued to use Ploeger.

Q Will you tell me when it was, what period of time, by date, that the Spellright Company made this material itself instead of obtaining it from Schwarzenbach-Huber, whether it was for experimental or any other purpose?

(Pause.)

A Counsel, you want exact dates. I can't give it to you. I have been away since 1965 and running my own business and I just can't give you exact dates.

Q Will you give them to me as close as you can?

A We made, as I said, many types of ribbons. Let's see. It was after '63.

THE COURT: What part of the work on these ribbons was done by Spellright?

THE WITNESS: What part was done by Spellright?

THE COURT: What part of the work was done by Spellright?

THE WITNESS: Judge, at what period of time? As long as we were purchasing material from Schwarzenbach-Huber we didn't fool with the ribbon at all.

THE COURT: What did you do with it? You just bought it from Schwarzenbach-Huber and then resold it, is that all?

THE WITNESS: No. The ribbon we got from them was quarter-inch, approximately, with a backing on it. And then, of course, the bottom portion of the correcting material, we purchased that through another company. We had to cut and process it and join it together and make the --

THE COURT: That is what I wanted to know. What part of the process was done by Spellright?

THE WITNESS: Spellright did all of it except for the cloth portion of the ribbon that we were purchasing from

Ploeger.

THE COURT: You did all of it except what?

THE WITNESS: The cloth portion of the ribbon we bought from Schwarzenbach-Huber -- or Ploeger, the inked part.

THE COURT: But I want to know what part of the process was carried out by Spellright.

THE WITNESS: This black portion we purchased from Schwarzenbach-Huber. It was later inked by an inking company. Then it was shipped in to Spellright here.

The bottom portion of the ribbon, of course, we obtained in large rolls. This was cut and processed at Spellright, and then the ribbon itself was put together at Spellright.

THE COURT: Where was the nylon film put back of the ribbon, was that done at Spellright?

THE WITNESS: Yes.

BY MR. ROBSON:

Q How much material was -- withdraw that.

Spellright placed nylon film itself on some of the printing ribbon, is that correct?

THE COURT: He has already answered the Court's question to that effect and said so.

Q On how much material was that done?

A How much material?

Q Yes.

A That is a tough question to answer. I can't. I have no way of knowing how much.

Q Approximately. Was 100,000 yards, 200,000 yards --

THE COURT: I don't think we are going into that, Mr. Robson, because that goes to the issue of damages, if any.

Now I think we will suspend at this time until tomorrow morning.

How much longer will your cross-examination be?

MR. ROBSON: Five or ten minutes with this witness.

THE COURT: How much more do you have?

MR. HALL: Well, I have one very short witness and then I have Mr. Wolowitz, so we should be done in an hour and a half.

THE COURT: Very well.

MR. ROBSON: If Your Honor please, I would like to hand up a brief which we have prepared on the question of prior art.

THE COURT: Very well. I am sure it will be helpful.

Well, I don't think I need this. My view of legal encyclopedias is they are useful only as sources out of which to get references, that is all; they are not authoritative

in themselves. Unfortunately, every once in a while they cite references that don't stand for the propositions for which they cite them. That used to be particularly in the older encyclopedias. I think they have reformed.

MR. ROESON: I have had that experiences many times.

THE COURT: Of course.

(At 4:00 p.m. trial stood in recess,
to reconvene 10:00 a.m., October 8, 1967.)

- - -

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.)

Plaintiff)

v.)

Civil Action No. 1514-63

SPELLRIGHT CORP.,)
et al.)

Defendants.)

Washington, D. C.

Friday, October 6, 1967.

The above-entitled cause came on for further trial
before the HONORABLE ALEXANDER HOLTZOFF, UNITED STATES
DISTRICT JUDGE, at 10:24 a.m.

Appearances:

For the Plaintiff:

MORTON ROBSON, ESQ. and
EDWARD C. GONDA, ESQ.

For the Defendants:

WILLIAM D. HALL, ESQ.

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C O N T E N T S

<u>Witnesses:</u>	<u>Direct</u>	<u>Cross</u>	<u>Redirect</u>	<u>Recross</u>
FARRELL, Harry (Resumed)		604	608	618
MONTAGUE, Homer R.	624	627		
WOLOWITZ, William	627	662	678	
PLOEGER, Walter, Jr. (Rebuttal)	686	694	697	
SEIDEL, Arthur H. (")	698	700		
ARGUMENT IN BEHALF OF THE PLAINTIFF (By Mr. Robson) ..				Page 704
ARGUMENT IN BEHALF OF THE DEFENDANTS (By Mr. Hall) ...				" 731
REBUTTAL ARGUMENT IN BEHALF OF THE PLAINTIFF (By Mr. Robson) ..				" 786

E X H I B I T S

<u>Plaintiff's Exhibits:</u>	<u>Marked for Identification</u>	<u>Received in Evidence</u>
No. 21 -- Patent 961,108 issued To Wolowitz in Great Britain		677
Interrogatories & Excerpts from Depositions		680 et seq
<u>Defendants' Exhibits:</u>		
No. 5		685
No. 6		685
No. 12		685
No. 13 -- Piece of Ribbon	608	685
No. 14 -- Letter from Mr. Hall to Opposing Counsel	648	648

P R O C E E D I N G S

THE COURT: We will proceed with the case on trial.

Thereupon

HARRY H. FARRELL

resumed the witness stand and further testified as follows:

CROSS-EXAMINATION (Resumed)

BY MR. ROBSON:

Q Mr. Farrell, would you tell me, please, how many experimental ribbons were sent to a customer when you sent the experimental ribbons?

A We sent out very few. There were just a few integrated with orders.

Q When you sent an experimental ribbon to a customer, did you send any letter to the customer advising him that he was receiving an experimental ribbon and not an ordered ribbon?

A No. We used our mimeographed sheet, I believe; a notice to distinguish the difference in the two.

Q What did the mimeographed sheet say about it being an experimental ribbon?

A I never read it.

Q How many employees did the Spellright Corporation have during the year 1962?

A 1962, three or four, I believe.

Q The three were you, Mr. Wolowitz, his sister, and one other?

A I think so.

Q I show you a leaflet which has been marked, I believe it is Exhibit 7-A, and ask you whether that leaflet was enclosed in all packages of Spellright ribbons during the year 1962 and during the year 1963?

MR. HALL: Your Honor, the witness has already testified that he had nothing to do with the shipping department of the ribbons.

THE COURT: This is cross-examination. I think it is permissible on cross-examination.

THE WITNESS: I couldn't say whether this was enclosed in every ribbon, because, as I've already said, the packaging and the shipping was -- I had very, very little to do with that.

BY MR. ROBSON:

Q Who did the packaging and shipping? You and Mr. Wolowitz did the experiments, is that correct?

A That is correct.

Q And Mrs. Jacobs was the bookkeeper?

A That is correct.

Q Who did the shipping, manufacturing and running of the business?

A Well, the manufacturing, I did quite a bit of that, and Mr. Wolowitz did as well. And the shipping was done by -- let's see -- we had several employees, outside employees, that did most of that.

Q When you say "outside employees," do you mean you shipped the merchandise out of the plant?

A No, no. They would come in and work for Spellright at different intervals. They were employed by Spellright.

Q In 1962, you said there were three or four employees.

A In 1962 -- let me get my dates straight. I believe in 1962, we had -- in '62, I believe we had quite a few employees. I think I am in error. I think we had probably twenty-five or thirty employees at that time.

Q You had twenty-five or thirty --

A Something like that.

Q -- in 1962?

A We had quite a few. I don't know exactly how many we had.

Q Do you have any idea what the pay roll was?

A No, I don't.

Q Were you a stockholder of the Spellright Corporation?

A I was given stock, yes.

Q So you have no idea whether that leaflet was included

in the boxes or not?

A No, I couldn't say.

Q In 1962 and up through June 1963, do you know whether the Spellright Corporation owned any patents?

A No. I couldn't say. I don't know whether they owned patents or not.

Q Do you have any idea what the words, "Patented Construction backing keeps type clean," means on the leaflet in front of you?

A (Perusing the exhibit.) The word -- I don't know anything about patent law. I would assume that everything in the ribbon was patented, the tape was patented, the glue was patented, and everything else. To me, the word "patented" simply means something like "Grade A beef" or "Choice," or something like that. It's a similar word.

Q What about the whole sentence, "Patented Construction backing -- "

THE COURT: I think that is a matter of construction for the Court.

MR. ROBSON: I just want to know what this witness understands that to mean in the leaflet.

THE COURT: The witness did not compose this leaflet, so it makes no difference. If he was responsible for it, that would be different. The testimony is that Mr. Kaufman composed it.

BY MR. ROBSON:

Q Let me ask you this one question, Mr. Farrell:

Was there any substance on the Spellright ribbon which, to your knowledge, had the effect of keeping type face clean?

A Yes.

Q What was that?

A It was a plastic backing.

Q On what?

A On the cloth part of the ribbon.

Q The printing part?

A The printing part, the black part.

MR. ROBSON: No further questions, Your Honor.

MR. HALL: I have here a piece of ribbon that I ask to be marked as Defendants' Exhibit 13.

(Defendants' Exhibit No. 13, a piece of ribbon, was marked for identification.)

MR. HALL: For identification.

REDIRECT EXAMINATION

BY MR. HALL:

Q Mr. Farrell, you testified that when you made Plaintiff's Exhibit 17, you used some Ploeger material, didn't you?

A Right.

Q Now, I hand you this exhibit, Defendants' Exhibit 13, and ask you if this is the kind of Ploeger material that you used?

A (Examining the exhibit.) Yes, Counselor; looks like it.

Q Now, it has the film backing on the nylon ribbon, doesn't it?

A Yes, sir.

Q And that's the way you received it from Ploeger?

A Correct.

Q You didn't put that film backing on, did you?

A No, indeed.

MR. HALL: I'll rip off a little end of this so the Court can see the film backing. Your Honor possibly can see the film backing. I thought maybe I could cut a little piece off with my knife so you could see it. Perhaps you can see it without that.

THE COURT: What is this? Is this the film?

MR. HALL: No, this is the nylon cloth with the film backing.

THE COURT: Oh, yes. It is so minute.

MR. HALL: If you work it back and forth with your hand.

THE COURT: It will take a magnifying glass to see

that there are two layers.

MR. HALL: Can I give you a magnifying glass?

THE COURT: If you have one.

MR. HALL: It is a very cheap one.

(The magnifying glass was passed to the Court.)

THE COURT: Naturally I would not question your statement, Mr. Hall, that there are two layers there, irrespective of the fact that it is difficult to discern them.

BY MR. HALL:

Q Mr. Farrell, you took this Ploeger material that had the nylon film together with the nylon backing, and you attached an additional piece of nylon to it, is that correct?

A That's correct.

Q And that's the piece of nylon that you told the Judge yesterday that you put on, in addition to what Ploeger sent you, is that correct?

A That is correct.

Q Now, can you show the Court on this ribbon, Defendants' Exhibit 13, where this additional piece of nylon is that you put onto Ploeger's nylon?

A Do you mean the piece of backing?

Q Yes. Show what you put on in addition to what Mr. Ploeger had?

A Well, on the lower part here, on the blue portion.

Q That is the piece of film that is behind the correction material?

A That's correct.

Q And you welded it onto the piece of correction material -- I mean you welded it onto the piece of film that was on Ploeger's ribbon to begin with?

A Correct.

MR. HALL: Possibly, if there is no objection, we could peel some of this back so that Your Honor could see it very clearly.

THE COURT: Our ever vigilant Clerk showed me where the second layer is. He sliced a piece of it off. I see it there.

MR. HALL: I don't know whether I can do this or not, but this may enable you to see both layers. I believe it is very important, Your Honor. It goes to our defense of non-infringement. Yes, I think I am going to be able to do this. Yes, I was able to do it. Let me get my glass. Could I hand Your Honor again my magnifying glass.

(The material was passed to the Court.)

MR. HALL: I would like for you to look at this film which you will notice is a half inch wide. The Ploeger film

was a quarter inch wide, as per Defendants' Exhibit 13, but now the film is half inch wide, and there are these two strips here that were both sealed down to that half-inch wide film.

THE COURT: Thank you. There are two films there, one alongside the other. Is that what you contend?

MR. HALL: Yes. And one of them is Ploeger's film. You see the one behind the black part --

THE COURT: There are two films, one behind the black part and one behind the blue part, is that it?

MR. HALL: That's right. And the one behind the black part is Ploeger's film, and the black part of the ribbon is Ploeger's own ribbon; so that the black part, together with the film that is behind the black part, is Ploeger's own material, exactly the way he sent it.

Is that correct, Mr. Farrell?

THE WITNESS: That's correct.

MR. HALL: And then the blue part is not fused to the film, is it, Mr. Farrell? It is put on by cement?

THE WITNESS: Correct.

THE COURT: Did you purchase ribbon from anyone else but Filmon?

THE WITNESS: No, we did not.

MR. HALL: Perhaps you misunderstood the Judge's

question. You mean you didn't purchase any other ribbon with a backing on it --

MR. ROBSON: Your Honor, I don't believe there is anything in the record to indicate that the witness misunderstood anything. If Your Honor please, I think this is improper redirect, and I object to him telling the witness he misunderstood the Court's question.

THE COURT: I do not permit colloquy of counsel during an examination of a witness unless there is an objection to the admissibility of evidence.

I think that both of you gentlemen had better clear this point up.

What is your theory here, Mr. Hall?

MR. HALL: Our theory is that they are suing us for infringement on their own material, that the only thing in our ribbon which Mr. Ploeger pointed out on his direct examination as being an infringement was his own material.

THE COURT: Is it your theory that during the period in which the defendants were charged with infringing a patent that actually they were buying the plaintiff's material and using that and attaching the extra strip to it, is that it?

MR. HALL: As for all the ribbons that they have ever produced as coming from Spellright, that is true.

THE COURT: Is it your contention that Spellright has not produced any printing ribbon containing the two layers plus the film backing, other than what they had purchased from the plaintiff?

MR. HALL: No. We did have an additional approximately one thousand ribbons in that category, but they were quite different, and they don't infringe for additional reasons that I have given, and none of them have ever been produced by the plaintiff, and none of them have ever been officially charged to infringe in this case because, so far as we know, the plaintiff never had one of them in its possession. At least --

THE COURT: The plaintiff charges infringement, and he produces Plaintiff's Exhibits 11 and 17.

MR. HALL: Yes.

THE COURT: Plaintiff's 11 is claimed to have been purchased from Abraham & Strauss. The plaintiff claims that it has shown continuity of possession from the moment that Plaintiff's Exhibit 11 was purchased from Abraham & Strauss. Now, it also claims that there is circumstantial evidence to the effect that Abraham & Strauss purchased Plaintiff's Exhibit 11 and others like it from the defendants, because the defendants admit that they shipped some ribbon to them and that Abraham &

Strauss was selling it in boxes bearing the imprint of the defendants. The plaintiff would have the Court draw the inference by this circumstantial evidence that Plaintiff's Exhibit 11 was produced by the defendants.

That contention is not entirely without foundation, because even in criminal cases the Supreme Court held in the Holland case that it is no longer necessary that circumstantial evidence be strong enough to eliminate every possible conclusion but one.

Do you contend that the ribbons that you sold to the various concerns, among them Abraham & Strauss, listed in Exhibit 18, were made of supplies purchased from the plaintiff?

MR. HALL: The ones sold to Abraham & Strauss were made exactly like the one that you are holding in your hand, but --

THE COURT: I understand that. I am assuming that they were, but is it your contention that all of them were made of material that came from the plaintiff, that the defendants purchased from the plaintiff?

MR. HALL: All of those from Abraham & Strauss, but not all of those sold to all of the other companies.

THE COURT: Not all of them?

MR. HALL: Not all. But those other ribbons were

made a different way, and we have a different reason for non-infringement with respect to them; and none of them have been produced or charged in this suit.

THE COURT: But the inference that I draw from the testimony is that after the conference in 1962, when the defendants' request for an exclusive license was denied, there were no more dealings between the plaintiff and the defendants.

MR. HALL: We had two hundred thousand yards of their material on hand at the time this suit was filed. We bought a million and a half yards, and it took --

THE COURT: There is no evidence of that.

MR. HALL: Yes, Your Honor, I think there is a stipulation in the pretrial order.

THE COURT: Suppose you call my attention to the particular provision in the pretrial order, because I do not have all of it in mind.

I think this is a rather important point. Do I understand correctly your contentions, Mr. Robson, the way that I summarized them?

MR. ROBSON: You correctly understood our contentions exactly, except that there's just a little bit more to add to what you have already understood.

THE COURT: As far as I have gone, is that correct?

MR. ROBSON: As far as you have gone, that is absolutely correct. But I would like to refresh Your Honor's recollection on the testimony of Mr. Ploeger and Mr. Seidel with respect to the physical examination of the ribbons purchased at A & S under a microscope.

THE COURT: - That is going off on a tangent. As I understand it, the defendants' contention is that the alleged infringing articles were made of material purchased from the plaintiff. Of course, I suppose, if that is so, there is no infringement, is there?

MR. ROBSON: There would, of course, be no infringement, but two witnesses have testified to the contrary.

MR. HALL: Your Honor, the pretrial order, on stipulations --

THE COURT: What page?

MR. HALL: Page 2. (Reading.) Prior to November 1962, plaintiff, Filmon Process Corp., sold to defendant, Spellright Corp., certain materials used in the manufacture of typewriter ribbons. Said materials were used in the manufacture of typewriter ribbons which were sold under the name of Spellright.

Now, I will prove the quantity of material by a later witness.

THE COURT: Very well. I think that this short discussion has helped to crystallize the situation.

BY MR. HALL:

Q Mr. Farrell, did the Spellright Corporation ever make any Filmon material of the type of Defendants' Exhibit 13? I mean did it ever manufacture any itself, or did it get all of it from the Ploeger company?

A No, we bought all of it from Ploeger company.

Q And when you used all of that up, you went to a different nature of ribbon?

A Correct.

Q And you used a different nature of ribbon from that time thereafter?

A That's right.

MR. HALL: No further questions, Your Honor.

RECROSS-EXAMINATION

BY MR. ROBSON:

Q Mr. Farrell, is it your testimony that the Spellright Corporation never produced a printing ribbon or a printing element which was made up of a portion of printing fabric and a nylon film welded to each other?

A Counselor, I don't understand your question.

THE COURT: Suppose you repeat your question, Mr. Robson, and clarify it -- or simplify it.

THE WITNESS: Yes.

BY MR. ROBSON:

Q You were shown Exhibit 13, which is a piece of nylon fabric welded to a piece of nylon film, is that correct?

A Correct.

Q You testified that Exhibit 13 was made by the Ploeger Company of the Filmon Process Corporation, is that correct?

A That's correct.

Q Did you or the Spellright Corporation ever manufacture on your own premises or anywhere else, other than in the Filmon Process Corporation's premises, a ribbon like this?

A No.

Q Never?

A No.

Q Did you not hear Mr. Hall state that the experimental ribbons were made of the same material and in the same manner?

A Counselor, we made ribbons of every conceivable method possible. Now, the ribbons what we make in experiments and what we were making for use and resale, there's a difference.

Q Don't read anything into my question. The question was: Did you ever make any ribbon like this?

A We tried that method, yes.

Q You did make ribbon like this?

A We made some.

Q How many yards of ribbon like this did you make?

A That's a difficult question.

Q Was it enough to make one thousand ribbons, type-writer ribbons?

A A thousand ribbons? Well, let's see -- we could have. We could have made --

Q And those were the thousand ribbons that were shipped to the various stores, is that correct?

A We would make ribbons --

Q What was done with those thousand ribbons?

THE COURT: Let him finish his answer.

THE WITNESS: When we would make experimental ribbons, we would send a few out for field testing, and so forth, very few, because we were making the regular Spellright ribbon, and we didn't want to go too far afield in any way.

THE COURT: I think you have answered the question.

BY MR. ROBSON:

Q Were these thousand ribbons sent to the various stores in the United States for sale?

A I don't know whether they were or not.

Q Were any of them sent to various stores in the United States?

A They could have been, yes, because all experimental ribbons, we would integrate a few.

THE COURT: You manufactured those so-called experimental ribbons yourselves? You did not purchase the material from Ploeger Company, did you?

THE WITNESS: That's right. We manufactured those ourselves.

THE COURT: Where did you get the material?

THE WITNESS: It came from -- from -- I don't know, Your Honor.

THE COURT: Anyway, it did not come from the Ploeger Company?

THE WITNESS: Not to my knowledge.

BY MR. ROBSON:

Q Now, you were shown an exhibit and asked whether this was Ploeger material or not. And you looked at it.

A Yes.

Q Would you tell me how you can tell by looking at this with your naked eye who manufactured this?

A Ploeger is the only one, to my knowledge, that was manufacturing a piece of ribbon of that type -- to my knowledge.

Q How do you know this is not a piece of the experimental ribbon manufactured at Spellright?

A I don't know that.

Q I could be, could it not?

A It could be.

Q You can't tell the difference with the naked eye, can you?

A No, you cannot.

Q You were shown Exhibit 17 --

THE COURT: I want to say this, gentlemen, if it should come to that, I think that there would have to be an accounting. At the accounting proceeding it will be necessary to show which ribbons were made of material purchased from the plaintiff and which were made of material purchased from others. I do not think that I am going to decide that question here.

MR. ROBSON: I just want to make sure that we have evidence of infringement clear on the record.

THE COURT: Yes.

BY MR. ROBSON:

Q I show to you Exhibit 17, which is the ribbon that was shown to you by Mr. Hall and which you testified was made by the Ploeger Company, and I ask you whether it is not true that by looking at this you cannot tell whether it was made by Ploeger or whether it was one of Spellright's experimental ribbons, is that correct?

A I cannot tell whether that ribbon was made by

Spellright or Eaton-Allen or anyone else. That's just a name --

Q In other words, when you testified on direct examination that this was made with Filmon material, you were just guessing, is that correct?

A No, I wasn't guessing. As I understand it, during the year --

THE COURT: Just a moment. That is a matter of argument. Don't argue with the witness.

BY MR. ROBSON:

Q I show you what has been marked Plaintiff's Exhibit 11 for identification, and ask you to tell me, looking at this, whether it was made by Spellright, one of the Ploeger companies, or anybody else?

A (Examining the exhibit.) Counselor, I can't tell who it was made by. Ploeger could have made it, someone else could have made it, Spellright could have made it.

MR. ROBSON: No further questions, if Your Honor please.

MR. HALL: No further questions.

THE COURT: You may step down, Mr. Farrell.

(The witness stepped down.)

MR. HALL: Mr. Montague, please.

Thereupon

HOMER R. MONTAGUE

called as a witness by the defense, being first sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. HALL:

Q Would you state your name, age and occupation?

A My name is Homer R. Montague.

THE COURT: What is your first name, Mr. Montague?

THE WITNESS: Homer.

THE COURT: H-o-m-e-r?

THE WITNESS: Yes, sir.

A (cont.) I am fifty-four years old, and I am a patent attorney.

Q Would you state how many years you have been a patent attorney?

A Well, I was admitted to practice in 1946, I believe.

Q The plaintiff has introduced a letter, Plaintiff's Exhibit 20, written by you to Mr. Seidel, and I would like to ask you if, at the time you wrote that letter, you had ever seen the Ploeger application for patent or the Ploeger patent, or anything tangible about it?

THE COURT: I wonder if this is relevant to the issues, Mr. Hall?

MR. HALL: Well, they brought it up. They

apparently are trying to say that we were seeking some sort of a license from them, and they referred to this letter.

Now, at the time Mr. Montague wrote the letter he had never seen Ploeger's application.

THE COURT: I understand that, but how is it relevant?

MR. HALL: It shows that he was not recognizing that Mr. Ploeger had a valid patent, he had never seen it.

THE COURT: I do not think that testimony is admissible. I must say that I do not consider a request for license an admission that the patent is valid. If they can get good terms, many people would rather pay for a license than to litigate. I do not think that the application for a license is an admission of the validity of a patent any more than the negotiations for the settlement of a lawsuit constitutes an admission on the part of the defendant that the plaintiff's claim is valid.

MR. HALL: Very well. That has very much shortened Mr. Montague's testimony.

THE COURT: Very well.

BY MR. HALL:

Q Mr. Montague, did you attend a meeting with Mr. Seidel in September of 1962, or some such date as that?

A Yes, I did, in Philadelphia.

Q At that meeting did Mr. Wolowitz say anything to the effect that he would infringe?

A I don't recall his saying so.

Q Now, at that meeting did you tell Mr. Seidel that Mr. Wolowitz did not have an allowed claim?

A No.

Q Can you tell us why you would not have made such a statement?

MR. ROBSON: If Your Honor please, I object to why he wouldn't have made it.

THE COURT: Objection sustained. What statement are you asking him about, Mr. Hall?

MR. HALL: Mr. Seidel's. Mr. Seidel testified that Mr. Montague told Mr. Seidel that Mr. Wolowitz did not have an allowed claim.

THE COURT: Oh, well, Mr. Montague denies this. I do not think it is very important anyway, but I will sustain the objection as to why he would not make such a statement.

BY MR. HALL:

Q Did Mr. Wolowitz have an allowed claim at that time?

A Yes.

Q Approximately what date did the Patent Office first allow a claim on Mr. Wolowitz's self-correcting ribbon?

A It was in an office communication in June of 1961.

Q And did you promptly communicate that fact to the Spellright people?

A I'm sure I did.

MR. HALL: No further questions.

CROSS-EXAMINATION

BY MR. ROBSON:

Q I believe your testimony was that you did not recall that Mr. Wolowitz advised Mr. Seidel or Mr. Ploeger that he intended to infringe the patent, is that correct?

A That is correct.

Q Did you hear everything that was said by Mr. Wolowitz at that meeting?

A Probably not.

MR. ROBSON: May I have the letter?

(The witness handed Mr. Robson the letter.)

MR. ROBSON: No further questions.

MR. HALL: No further questions.

THE COURT: You may step down.

(The witness stepped down.)

Thereupon

WILLIAM H. WOLOWITZ

called as a witness by the defense, being first sworn, was

examined and testified as follows:

DIRECT EXAMINATION

BY MR. HALL:

Q Would you state your name, age and occupation?

A My name is William H. Wolowitz -- W-o-l-o-w-i-t-z.
I'm fifty-eight. I'm president of Spellright Corporation.

Q Would you state your education and your experience, being very brief about your experience?

A I graduated with a Bachelor of Arts degree from American University, and I graduated from the Army Industrial College.

I was president of United Typewriter Company, of United Equipment Company, of two or three other companies, and president of Spellright Corporation, and I have been engaged in research and development and have acquired quite a number of patents in my field.

Q Mr. Wolowitz, you mentioned that you were president of United Typewriter Company. Is that a retail store down on Fourteenth Street?

A Yes, it is a typewriter company that is at 813 Fourteenth Street, Northwest, that was engaged in the business of selling a full line of office machines and the repairing, servicing and rental of those machines

Q Over what period of time were you in charge of the company when it was selling that line of equipment?

A Beginning in 1927, I became president about 1930, and was so engaged with the exception of the time during World War II through 1962, thereabouts.

Q All right. Getting back to the years 1957 and '58, was your store selling any nylon typewriter ribbons?

A Yes, nylon typewriter ribbons were sold by our company.

Q Tell us, if you can, -- a rough idea about the volume of nylon typewriter ribbons against other types of typewriter ribbons?

A We sold mostly cotton -- we sold mostly cotton ribbons. Second in sale to cotton ribbons were nylon ribbons.

Q Were there any other materials generally sold on the market at that time, other textile fabrics than cotton and nylon, that were used for typewriter ribbons?

A Yes, we also sold silk ribbons.

Q Would you say that cotton, silk and nylon were the common three textile fabrics used in typewriter ribbons in the years 1958 and 1959?

A Yes. In fact, they were the only ones that I knew of.

Q Now, Mr. Wolowitz, you want to make a test something similar to the one that Mr. Ploeger made. Would you think it

would be desirable for you to make your test so that the creeping up could go on while your testimony is in progress?

A I would like to make a test. It would take --

THE COURT: A test to show what, Mr. Hall?

MR. HALL: Like the test that they made at the opening of their case.

THE COURT: Very well.

MR. HALL: They said theirs went up higher.

THE COURT: What is the purpose of making another test?

MR. HALL: Well, we are going to make a test showing a prior art patent. The thing goes up just as high as theirs.

THE COURT: That is what I wanted to know.

MR. HALL: We are going to show that with our ink which the witness will use that our ink is practically a paste, and our ink does not have a capillary that they are talking about, on which they are relying.

So you could set up your apparatus and start your test in action.

THE WITNESS: If I may get my associate to help me.

MR. HALL: Yes.

(The witness left the witness stand.)

THE WITNESS: May I set them up here so it won't get

on the desk?

THE COURT: Let's not have colloquy across the courtroom.

MR. HALL: He wants to know whether he could make the test here.

THE COURT: I understand, but let's not have anyone speaking across the courtroom.

MR. HALL: Excuse us, Your Honor.

MR. WOLOWITZ: Excuse me.

MR. HALL: He wants to know whether he should set his apparatus up over there or over here.

THE COURT: It is immaterial to the Court, but I think that he should speak through counsel and not address the Court.

Suppose we take our mid-morning recess at this time while the apparatus is being set up. That will save a little time.

(Whereupon, at 11:07 a.m., the Court recessed.)

AFTER RECESS

11:25 a.m.

BY MR. HALL:

Q Mr. Wolowitz, would you tell the Court briefly what experiment you expect to perform.

A Yes. I have on one holder a nylon ribbon, plain,

with a piece of film unattached, as shown in the Markes patent.

Q No sealing at all?

A No sealing at all of any kind. They are lying on there, one on top of the other. And on the reverse side of the carrier I have a piece of Carter inked ribbon which I received from Ploeger.

Q That is his material?

A Yes. And I have the same items on the other carrier.

In my right hand, I will put the carrier in a jar containing ink which I bought at the drug store, Script ink. In the jar at my left hand I have ink of the paste type which Spellright used in its inking of ribbons, all ribbons that we made that did not use the Ploeger material.

Q Don't put it in yet.

A I will not.

Q You have only a quarter-inch wide Ploeger material. Are you willing to include a half-inch strip, Ploeger material a half inch wide, if they are willing to give you a strip?

A I certainly am willing.

Q But you do not have a half-inch strip of Ploeger material?

A I do not.

MR. HALL: If you wish us to run the test with your

half-inch material, please give us some.

MR. ROBSON: I couldn't care less. As I pointed out, it has nothing to do with the test.

THE COURT: You have a right to decline.

MR. HALL: All right. Then proceed with your test.

THE WITNESS: I put those in at 11:28, and I will let them set for a few minutes.

BY MR. HALL:

Q Mr. Wolowitz, I want to read some testimony given by Mr. Ploeger, and ask you if you agree that this happened:

Mr. Wolowitz approached me and asked me whether or not I would permit the words, "Patented Construction backing keeps type clean," seeing that I was going to issue or that -- in other words, seeing that I had a patent covering those words, and in the absence of his own patent it would dignify his product with those words.

A That is an incorrect statement.

THE COURT: What was your answer?

THE WITNESS: The statement that Mr. Hall has read me is an incorrect statement.

THE COURT: An incorrect statement.

BY MR. HALL:

Q What contact, if any, did you have with the words,

"Patented Construction backing keeps type clean"?

A I had no contact with those words.

Q Where were you at the time that the leaflet was made up and printed?

A I was in the Washington Hospital Center.

Q You had had a major operation?

A I was there for about four to six weeks, as I recall it, in about March or April -- March and April of 1962.

Q Well, now, after you got out of the hospital, what were your duties with respect to the United Typewriter Company and the Spellright Corporation, in general, briefly?

A My duties were still as president of the United Typewriter Company, still as president of the Spellright Corporation. In addition to that, I was engaged in research and development, and in other work outside of both fields that was --

THE COURT: May I interrupt you a moment, please. Mr. Hall, the witness, in answer to your question, said that the statement you read as made by Mr. Ploeger was incorrect. Perhaps it might be useful to point out what part of it was incorrect.

MR. HALL: Would you do that for the Court.

THE WITNESS: Mr. Ploeger never did suggest to me

that -- I think the statement read was that I had asked Mr. Ploeger if I could use the words, "Patented Construction backing," as I recall the way you read that statement. I never made such a request as that of Mr. Ploeger. That is what is incorrect about that statement.

BY MR. HALL:

Q Did you ever discuss the words, "Patented Construction backing keeps type clean," with Mr. Ploeger?

A No, I did not. When the trial -- I mean after they sued us the subject came up, which was after June 21, 1963.

Q Did you even know that these words existed in Spellright ribbons at any time that you were dealing with Mr. Ploeger?

A I didn't pay particular attention one way or another. As I stated before, I was president of United Typewriter Company and other companies. For instance, United Typewriter Company sold a wide line of office machines. We had brochures and pamphlets from I don't know how many companies, and I didn't pay any attention to those particularly. I did look at the folder, I admit that. I don't know -- I can't say when I looked at it I didn't see those words, but they struck no note with me. I don't recall seeing them. They certainly didn't raise any -- I didn't see them enough to pause over them.

Q Now, you heard me read from the stipulation in the pretrial order about you buying material from Ploeger.

How much did you buy?

A About a million and a half yards. Mr. Hall, --

THE COURT: How much?

THE WITNESS: A million and a half yards.

Mr. Hall, it's now been four or five minutes since I put these materials in. I have no ruler here, but I would like to call your attention, if I can, now --

THE COURT: No, I think you should confine yourself to answering questions. Counsel knows what questions to ask.

THE WITNESS: Excuse me, Your Honor.

BY MR. HALL:

Q Would you tell us the status of your test at this moment?

A I'll be glad to, Mr. Hall.

Q If you wish some sort of measuring rod, I can give it to you.

A Would you please do that.

(Mr. Hall handed the witness a measuring rod.)

A This measuring rod you gave me goes up to three inches. The material that I received from Ploeger -- I have now another ruler that goes full length -- the material that I got

from Ploeger appears to me to have risen, the ink appears to have risen three and a half inches. The material as per the Markes patent, nylon fabric with a film unattached, has risen the same distance. The material in the ink such as we use, I can't measure it. It is less than -- I have no instrument to measure it -- it appears to be less than -- about a thirty-second of an inch -- about one thirty-second of an inch.

Q Possibly if we rotated this a little, the Court could see.

A I will rotate each jar, I hope so the Court can see.

Q Let's rotate this one very gently so that Your Honor can see both ribbons.

A At any rate, the ribbon with the paste ink, both ribbons, if there is any measurement, it would appear to be identical as to the rise of the ink, the vertical rise of the ink.

Q Let's make certain that the Court understands this experiment. Which one of them is the Markes patent?

A The Markes patent is now on my righthand side. I will move the film separately. I will take the fabric separately and show they are unattached for the full length. The Ploeger material is on my left, and I have now moved it so you can see it as to the materials. I think the test is pretty

much finished, if you like. There's no point in it staying there, because they've reached -- they'll just keep going up in this plane. If you wish to let the paste ink stay, I think you'll see in an hour or so it will rise no more than that.

Q In other words, if you lay the two pieces of Ploeger ribbon together without sealing at the edges, you will get the same capillary as if they --

THE COURT: Will you repeat your question, please, Mr. Hall.

Q If you lay the two pieces of Ploeger ribbon together without sealing them at the edges, just lying loosely on top of each other, you will get exactly the same capillary action as if you seal them together as Ploeger does?

A Yes.

Q And you get no capillary action if you use your ink?

A I wouldn't say "no," I would say imperceptible, if any.

THE COURT: What was your answer?

THE WITNESS: I wouldn't say it had no capillary action. I would say it would be imperceptible.

THE COURT: Imperceptible. Very well. I did not understand that word. Thank you.

BY MR. HALL:

Q Now, then, do I understand that you used this heavy ink so as to reduce the possibility that your ink will run down onto the white part of your ribbon?

A We use the heavy ink as in a machine that, in effect, coats the top surface, the printing surface of the ribbon. Rather than using any other ink that we would use -- other inks that they have used go through and would possibly damage our white material. Our objective is to so treat the ink that it does not contaminate the white material.

THE COURT: The answer to the question is yes, is it not?

THE WITNESS: Excuse me, Your Honor?

MR. HALL: Let's try to speed things up, because I think maybe we can finish by slightly after 12:00 if we go real fast.

BY MR. HALL:

Q Now, does your nylon fabric have to be absorbent in order for your ink to work with it?

A No, it does not.

MR. ROBSON: I object to this as completely irrelevant to the issues, whether he needs an absorbent fabric or not.

THE COURT: I will allow it.

MR. HALL: Your Honor, the claims say --

THE COURT: I am allowing it.

MR. HALL: Oh, oh. I misunderstood.

BY MR. HALL:

Q Mr. Wolowitz, does it make any difference whether your fabric is absorbent or not?

A Yes, it does. I would rather it were not absorbent for my purposes.

Q So your ink will go in whether the fabric is absorbent or not?

A My ink goes in on the surface regardless of the absorbency of the fabric itself.

THE COURT: Do you have in mind the statement in the claims referring to an absorbent nylon strip?

MR. HALL: Yes, Your Honor.

BY MR. HALL:

Q In your experimental ribbons, the ones you made without Ploeger material, did you try any nylon fabric that was not absorbent?

A Yes.

Q How did it work?

A It worked suitable for my purposes.

Q The same as the fabric that is absorbent?

A I don't recall using any nylon that has been absorbent.

Q I would like to read you some statements from the

file wrapper of Ploeger's patent and ask you if these are true in your ribbons:

"... The ability of the present invention to protect the capillary action of its absorbent material becomes even more apparent when absorbent materials of extremely fragile and thin construction are required. Absorbent materials as thin as .002 inch may be incorporated in the present invention without fear of construction break down."

Now, in your ribbon is there any capillary action that needs to be protected?

A No, there is not.

Q Now, later, on page 31 of the file wrapper it was stated:

"... The impervious plastic film of the present invention provides for a capillary action so that each time a key strikes the film, the ink on the inner surface of the film is forced through the layer of absorbent material."

THE COURT: May I ask from what you are reading?

MR. HALL: The file wrapper of the patent in suit. That was at the bottom of page 31.

THE COURT: Very well. You may proceed.

MR. HALL: It was the last sentence on page 31.

THE COURT: Very well.

BY MR. HALL:

Q All right. Let's go to page 34 of the file wrapper, the first full paragraph on that page:

The printing ribbon of the present invention provides a reservoir of ink between the film and the strip of absorbent material.

Now, in your ribbon, do you use any reservoir -- do you have any reservoir effect?

A No, we don't. I don't recall answering that on page 31 of the file wrapper.

Q Oh, let's see. I thought you had answered. Let's go back and read the last sentence at the bottom of page 31:

The impervious plastic film of the present invention provides for a capillary action so that each time a key strikes the film, the ink on the inner surface of the film is forced through the layer of absorbent material.

Would that happen in your ribbon?

A No, it does not happen in my ribbon.

Q Does your ribbon have a capillary action?

A There may be some capillary action, but there is no absorbent material.

Q Well, does your test here show the approximate amount

of capillary effect when your ink is used?

A It would be imperceptible.

Q Would you show the Judge how far your ink --

Do you attribute the rise of the ink in those experiments to be due to capillary action?

A Yes, I do.

Q And how far has your ink moved up as compared to the ordinary ink?

A The one, the ordinary ink, has gone now to the pins that stop it. My ink appears no more than three thirty-seconds of an inch. In fact, if I may go a little further, the action on the ribbon that is after the Stark patent -- the ribbon that I have put in the jar that imitates the Stark patent seems to have risen a little bit higher, if it were measurable at all.

Q You mean the Markes patent?

A The Markes patent.

Q All right. Now, let's move on to page 43 of the file wrapper, where they argued to the Examiner: --

THE COURT: What page?

MR. HALL: Page 43.

THE COURT: Thank you. I have it.

Q (cont.) The middle paragraph. It says:

"The 'Film-On' ribbon of the present invention has been put through extensive absorbency tests. The present invention was applied to fabrics of varying gauges and constructions. It was conclusively established that the maximum level of absorbency of all fabrics tested, was increased between 20% and 30%. It follows, then, that the ribbon has achieved an ink holding capacity which must be considered as 130% absorbency."

Now, would such a statement be applicable to your ribbon?

A No, it would not be.

Q Do you want to hold more or less ink than an ordinary typewriter ribbon?

A We want to under-ink, if possible.

Q Why do you want to under-ink?

A The ribbon that we were manufacturing, the first objective was to correct the impresssion made by the type. Therefore, then, we would want as light an impression made by the type as possible.

Secondly, the danger has existed from the very outset of the attempt for self-correcting ribbons that the ink portion would contaminate the white portion, and we had to overcome that danger.

Q Now, it is your understanding of the Ploeger patent that its object is to hold more ink in a reservoir?

A That's correct.

Q And thus hold more ink than an ordinary nylon typewriter ribbon?

A That appears to be the objective of his invention.

Q That's what he claims is --

MR. ROBSON: If Your Honor please, I object on the grounds that the witness is neither an expert --

THE COURT: Objection sustained, because that is argumentative really and a conclusion.

BY MR. HALL:

Q Now, what have you found with respect to the life of your ribbon with respect to the life of an ordinary nylon typewriter ribbon?

A The way we inked my ribbon, it would not last as long as an ordinary nylon ribbon.

Q Now, the other side has introduced an exhibit, Plaintiff's Exhibit 3, and you heard their testimony about it. If your ribbon with your ink was used, could you have made as extensive a copy as this, with the ink retaining the same intensity of impression throughout the entire operation as they say happened in this case?

A It would all depend on how long my ribbons were. If I had an extremely long ribbon, maybe fifty or sixty yards, it might. I haven't seen that exhibit.

Q Well, now, let's get back to the ribbons that were sold to the Abraham & Strauss store. Do you know how they were made?

A Yes, I do.

Q I am speaking of the so-called Mark II ribbons. Would you tell us briefly how they were made?

A The ribbons that were sent to Abraham & Strauss were made by taking Ploeger material which was about nine thirty-seconds up to five-sixteenths of an inch, either one of those materials, by superimposing that material with the fabric portion up over a piece of our correction material which had affixed to its back some film -- let's say the righthand margins were aligned up with those two pieces, and the lefthand margin was cut off and away, so that we had all members I described sealed at one of its edges. Then we unfolded the ribbon, and that resulted in the ribbon that we sent to Abraham & Strauss as an experimental ribbon. There were other ribbons as well that we sent to Abraham & Strauss as our normal production.

Q I show you Plaintiff's Exhibit 17, and ask you how

this compares with the ribbons sent to Abraham & Strauss?

A (Examining the exhibit.) Exhibit 17 is the ribbon that we sent to Abraham & Strauss.

THE COURT: What is your answer?

THE WITNESS: I'm sorry. Exhibit 17 is of the type of ribbon that we sent to Abraham & Strauss.

BY MR. HALL:

Q Now, how do you know that?

A I know that, because when my deposition was taken in March of 1964, the Judge, I think, had asked that we produce a ribbon of the type that I thought we had sent to Abraham & Strauss. I went to Mr. Farrell and asked him to give me a ribbon like we had worked on at that time. We had shipped to Abraham & Strauss, as I recall it, in March, April -- oh, I think April, May and June -- maybe March, April and May of 1962. During those months we had produced ribbons, our experimental ribbons of this type, only with Ploeger material, because in the preceding two months we had experimented with materials other than Ploeger material.

Q Now, at the time this suit was filed, did you have two hundred thousand yards of Ploger's material still on hand?

A Yes, we did.

Q Did you tell Ploeger shortly after the filing of this suit that you still had two hundred thousand yards

of his material and you were still using it up?

A We told his attorneys.

MR. ROBSON: If Your Honor please, I object to the materiality of that question and move to strike the answer.

THE COURT: Objection overruled.

BY MR. HALL:

Q I have here a letter --

MR. HALL: First, I would like to ask that this letter be marked as Defendants' Exhibit 14 for identification.

(Defendants' Exhibit No. 14, a letter from Mr. Hall to opposing counsel, was marked for identification.)

MR. HALL: This is a letter that I wrote to opposing counsel; and they, I think, are willing to agree that I wrote it on the date indicated, and they received it on or about that date. With that stipulation, I offer it in evidence.

THE COURT: Let it be admitted.

(Defendants' Exhibit No. 14 was received in evidence.)

Q (cont.) Mr. Wolowitz, this letter invites the opposing side to come and verify for themselves by looking at your place that you have the two hundred thousand yards.

Did they ever come over and take a look?

A No, they did not.

Q Now, after you had used up all of your Ploeger

material, did you change to some --

MR. ROBSON: If Your Honor please, there was no testimony by the witness that he used up all the Ploeger material.

THE COURT: What is your objection?

MR. ROBSON: There is no testimony by this witness that he used up all the Ploeger material.

THE COURT: Oh, I am not going to be captious over semantics. This is not a jury trial. Objection overruled.

BY MR. HALL:

Q After your Ploeger material was all used up at your place, or all gone, whatever happened to it, did you then switch to some other kind of ribbon?

A Yes, we did.

Q Do you have any intent to revert back to Ploeger material in any way, shape or form?

A No, we do not.

Q Now, in the manufacture of your experimental ribbons, when you tried to fuse nylon to nylon, did you find that both the strips of nylon melted or just one?

A If we fused nylon film to nylon fabric, my experience was that if my right hand be the nylon film and my left hand be the nylon fabric that the film melted and fused itself over

the threads and into the threads of the nylon fabric. (Indicating.) I did not find that the threads of the fabric in any way melted and fused themselves into the film, merely the film melted and held.

Q Now, did the fabric have ink on it at this time?

A At the time --

THE COURT: You mean that only the film melted?

THE WITNESS: Yes, sir.

THE COURT: The fabric did not?

THE WITNESS: The fabric did not melt.

BY MR. HALL:

Q When you were in your experimental work and when you were making the experimental ribbons with materials other than Ploeger material, did you find that you had already inked the nylon fabric before you attempted to make the weld, or before you attempted to make the seal or the fusion?

A Yes.

Q So, therefore, the nylon fabric had ink on it?

A It had our paste ink on it, yes.

Q Now, would you tell us how -- maybe you have already answered this question -- did I ask you how these thousands of ribbons of non-Ploeger material were made?

A I don't think that you did, sir.

Q Then would you tell us?

THE COURT: What was your answer?

THE WITNESS: My answer was that I don't think counsel had asked me the question.

MR. HALL: Would you tell us how these thousand ribbons that used non-Ploeger material were made and how they came out?

THE WITNESS: I can tell you, or I could give a visual demonstration, if the Court would permit.

THE COURT: I think you have answered the question.

MR. HALL: You mean we did a little while back? I think we did, too.

THE WITNESS: Pardon me. I thought you had asked me how we had made the experimental ribbons using the Ploeger material. I don't recall your asking me how we made the experimental ribbons that did not use Ploeger material.

BY MR. HALL:

Q Then tell us how you made the experimental ribbons using non-Ploeger material.

A I can show you right here.

Q Mr. Wolowitz, please be very careful that you don't scratch the desk.

A I put it on this, hoping I would not. (Indicating.)

MR. HALL: Will Your Honor give us permission to move those bottles over on my counsel table?

THE COURT: Surely.

MR. HALL: Hold them very gently so that nothing, especially the lefthand one -- so that nothing --

(The bottles were moved to counsel table.)

THE COURT: Are you ready to proceed?

BY MR. HALL:

Q Would you show the Court how these were made?

A We took one piece of nylon fabric and another piece of film of equal width and placed it under that. Under both of them we placed a piece of our correction material which had affixed to its back surface a film. This film was already pasted onto the correction material. When those were all in position, we cut -- we cut and heat sealed the center line, and that resulted in two separate ribbons, which we then unfolded, and then had our correction ribbon.

I will add that there were sometimes in some of our experiments when the ribbon film -- the ribbon and the film -- the second piece of film -- were sometimes joined, but --

THE COURT: What was joined?

THE WITNESS: We sometimes in these experiments used the ribbon fabric and the film -- they were sometimes joined

together at various places, sometimes at the edges in the experiments; but basically we were making our experimental ribbons the way I have described. (Indicating.)

Q Did there come a time when you told Mr. Ploeger that you had an idea to make a ribbon that way?

A Yes, there did.

Q When was that?

A Well, I didn't tell him the way I had -- I didn't tell him the way I could make the ribbon. I went to him, starting in about September of 1961, and asked him if his company had a way of making a longitudinal seam down the middle of a ribbon. His answer to me was no, they did not; that they could make a seam, maybe up to three inches, and he then showed me how he made it.

THE COURT: Would you mind repeating just what you asked him.

THE WITNESS: I asked him if he could make a longitudinal seam down the center of a ribbon. His reply was that he could not; that he could make a seam up to three inches, and he showed me the way he did this, by taking a three-inch wide ribbon and folding it in some way -- I think he said he could make an endless ribbon, make something up to three inches, and that was the capacity of his ability to make a seam, except at

the edges of a ribbon.

BY MR. HALL:

Q All right. Then did there come a later time when you told him more?

A Yes. Several times I repeated this, and he said, "It can't be done." I said, "Well, you're an engineer. It can be done. Sometime I'll tell you about it."

But I came out of therapy December 16, 1961, and the subject came up again, that prior -- a little prior to that I had asked Mr. Ploeger to furnish me some material, some correction paper which was sealed at each of its edges only, and he said, "What do you want this for?" I said, "Never mind, I want to try it." On December 15th, the subject came up again, and he said, "I know how to do that." And he got out one of his ribbons about a half an inch wide with film on the back, another one, and placed one on top of the other. And then he got a knife, got it heated, and he pulled it down, and he performed the operation. (Indicating.) So I said, "Well, now you know." And then a couple days later I phoned him and said, "Walter, I want you to, of course, keep that confidential," and he said, "You know me, Wolly, we'll keep things confidential, don't worry about it."

Q Who had you demonstrated this to prior to that date,

prior to the time you were up to Ploeger's about it?

A I had demonstrated it to Mr. Montague, my patent attorney, first of all, later to Mr. Farrell -- my patent attorney, I think, before my first discussion of the matter with Mr. Ploeger around September of '61, maybe around that date -- then with Mr. Farrell; shortly thereafter to my son, about Thanksgiving Day of 1961.

Q Now, at any time during your dealings with Mr. Ploeger, did he ever ask you to keep anything confidential?

A No, it was the other way around. After my first visit, I asked him -- told him that I wanted my matters kept confidential. He said, "You don't need worry about our company. We cut for the entire ribbon industry, and we have to keep things confidential. We can't let one company know what another company is doing." He said, "I wouldn't even let you or my grandmother see our machines." I said I wasn't interested in seeing his machines anyway.

Q Let's get back to this second cause of action, relating to alleged false marking.

Did you at any time tell Mr. Kaufman to use the word "patented" in the literature?

A No, I did not.

Q Did Mr. Kaufman attend the meetings of the board of

your company?

A Yes, he did.

Q Did you ever mention to the board of directors that you had an allowed application or an allowed claim from the Patent Office?

A Yes, I did.

Q When would you have done that?

A I would think, as I remember it, we applied for the patent around April of 1961. Mr. Montague told me about three and a half -- about two and a half months later that a claim had been allowed, and I mentioned that to the board. They wanted us to have a patent issued immediately. It was patent counsel's advice that we should not have a patent issued immediately. The subject came up two or three times, because many members of the board were stockholders, and they thought patents had some kind of magic that would --

THE COURT: I think you have answered the question.

THE WITNESS: Pardon me, Your Honor.

Q Did you ever tell Mr. Seidel or Mr. Ploeger that you wanted to buy their patent?

A I think at the meeting in Philadelphia, as I recall it, September 19, 1962, it is possible that I said a thing like that, because the purpose of that meeting was to, in some way,

prevent the competition of a company that Ploeger had supplied ribbons to in breach of what I thought was his contract with us, and I may have made that suggestion to him, if that would prevent the issue of the other ribbon. I don't recall making it, but I'm not saying I didn't.

Q Now, you say Mr. Ploeger had a contract with you. Would you tell us very briefly -- I'm not asking you to be very accurate about it -- but tell us very briefly what that contract was about?

A Ploeger -- when I first went to Ploeger, I told him that I would like to experiment with his ribbon. He gave me some to try. When I tried it and came back, at that self-same time he told me that he was going to have a patent that was going to issue. I tried his ribbon and when I came back to him I said, "If you're going to get a patent that will issue, it will help me if I have an exclusive on your product until the time my patent issues." He said he would have to talk to his attorneys about it. And there were some letters between attorneys. I came back about October 19th or 20th and said, "All right, Walter, I can use your ribbon, and I'm ready to buy some, enough to make six thousand ribbons, if you can give me an exclusive on it." He said he couldn't give an exclusive on it because he sold this ribbon to many, many people. I said,

"Well, then, give me an exclusive on it for use in self-correcting ribbons." I said, "The normal ribbons you sell are about half-inch, and I want to use about a quarter-inch." He said, "Well, some people use quarter-inch." I said, "All right, Walter, we'll work it this way if it's okay, that you will not knowingly sell this ribbon to someone if they're going to make self-correcting ribbons; but, on the other hand, I'm not going to ask you to police it, you have a lot of customers, so I'll say that if I find out someone is using them, I will tell you, and I would say that you would then discontinue selling them to those companies." He said, "Okay." I said, "Okay, and I'll order enough for six thousand ribbons." I said, "I would like to order enough for six thousand ribbons." He said, "We do not sell ribbons." I said, "Okay. I'll go back to Standard Products who had sent me theirs and order from them." He said, "No, not Standard Products, I have someone else who sells them." I said, "Who?" And he mentioned what I now know is Schwarzenbach-Huber --

THE COURT: Suppose you spell that for the reporter.

THE WITNESS: S-c-h-w-a-r-z-e-n-b-a-c-h hyphen H-u-b-e-r. I couldn't spell it at that time.

A (cont.) He then got Mr. Hommel on the phone, and I over the phone gave Mr. Hommel an order for enough to make six

thousand Spellright ribbons, based on the contract that I had, the previous --

Q Did there come a time when he did sell this ribbon to someone else for making self-correcting ribbons?

A Yes. He sold quite a large quantity, I found out later, a couple of hundred thousand yards minimum to Eaton-Allen Corporation.

Q Was Eaton-Allen giving you a lot of competition?

A I had lunch with the vice-president of Eaton-Allen Company about mid-September -- early September 1961, and he told me then he was coming out with a ribbon. And I went back to Ploeger and told him that. And Ploeger said, "Thank the Lord Glenn told you we sold him ribbons, I didn't tell you we sold him." He said, "Yes, we furnished him some ribbons from the stock we cut for you." And I objected at that time to his having broken his contract.

Q And did he then indicate --

A Excuse me. The date -- did I say '62? That month of '62.

Q Did he then indicate that he wanted an excuse to be able to cut Eaton-Allen off from further purchases?

A We went to -- Eaton-Allen by that time was advertising the ribbons, though we had not seen any yet. Mr. Mesirov

and I went to Mr. Ploeger's office, as I recall the date about September 18, 1962, and Mr. Ploeger and his father were there, and they told Mr. Mesirow and me -- or Ploeger, Jr. told me mostly -- that Eaton-Allen was a big customer of theirs, had tremendous good will, and that they had to sell them ribbons unless I could furnish something in writing that would force Ploeger -- something he could show to Glenn, Eaton-Allen Company, that he had to sell ribbons to me. He said, "Why don't you get a patent issued or something like that?" I said, "Well, that I am not going to do. Maybe we can accommodate you in some way, get something in writing." As a result of that meeting, the meeting of September 19, 1962, was set up in Philadelphia, at which time Mr. Montague attended, and the efforts there were to get something in writing that would please -- that would help Ploeger not use Eaton-Allen's good will.

Q So the idea of getting an exclusive license was so that Ploeger could take the exclusive license and show it to Eaton-Allen and say, "Unfortunately, my hands are tied, I can't sell you any more"?

A That was exactly what Ploeger stated to me. Not in those exact words.

Q Before you engaged in this talk about exclusive license --

THE COURT: I don't think that these negotiations for an exclusive license or for a sale of a patent that did not eventuate successfully are relevant, Mr. Hall.

MR. HALL: Very well. I was just rebutting something that they put up, and I will ask no further questions about it.

BY MR. HALL:

Q Mr. Wolowitz, what have you found with respect to the bulking in Ploeger's ribbon?

A I have found that it seriously handicaps the life of my ribbon -- of any ribbon. What happens to it is that, as the typewriter keys strike it, it expands, it forms somewhat of a tube. A ribbon which on a spool would have been eight yards on a spool initially, as the ribbon wound back and forth it would expand in diameter until finally it jammed the ribbon reverse mechanism. Even before that, it might seriously affect the ribbon vibrator, and --

THE COURT: Mr. Hall, I wonder if it is relevant to explore the merits of the plaintiff's invention for the purposes of this case? I don't have to decide how good or how bad Mr. Ploeger's ribbon was.

MR. HALL: All right. I am very near the end, and I would have had one or two questions on that, but I won't --

THE COURT: I am not trying to hurry you, but I would like to keep us from wandering off on tangents.

MR. HALL: I don't think I have any further questions.

THE COURT: Mr. Robson.

CROSS-EXAMINATION

BY MR. ROBSON:

Q Mr. Wolowitz, when did you first start using the Ploeger material for your ribbons?

A I saw him as I recall it, on August 4th, 1961. I think at that time he gave me some samples. I tried the samples. I think about October 19, I ordered sufficient for six thousand ribbons. And from that point up until the time that we --

THE COURT: I think you are going beyond the confines of the question, Mr. Wolowitz.

THE WITNESS: October 19th, in production -- after October 19th, in production.

BY MR. ROBSON:

Q And you continued to purchase material from Ploeger up through about September of 1962, is that correct?

A As I recall it, through September of '62.

Q And during that period, is it your testimony that you used the Ploeger material exclusively in the construction of the Spellright ribbon?

A Of its production ribbons, yes.

Q And this was despite any bulking that existed, as

I recall it?

A That is quite correct, sir.

Q Now, the Spellright ribbon containing the Filmon or Ploeger material had a nylon that was absorbent, is that correct?

A No, that is not correct.

Q Is it your testimony that Ploeger submitted to you or sold to you ribbon containing nylon material which was not absorbent?

A That is correct.

Q Is it your testimony that during that period, you used -- I withdraw that.

When did you commence your own inking process?

A In about January 1963.

Q Can you be exact, was it in January of 1963?

A It may have been before; I don't think it was after.

Q It was not before you moved, was it?

A It was not before we moved.

Q And you have heard Mr. Farrell testify that you moved in January of 1963, does that sound correct?

A That's correct.

Q And it was after you moved that you purchased the inking material?

A We purchased it before, but we got delivery on it in January of '63, after we moved to Cedar Street.

Q Prior to the time you got the inking machine, isn't it a fact that the ribbon was being inked with ordinary ink by Eaton-Allen?

A I don't think it was quite ordinary ink. I don't know exactly what it was. Eaton-Allen had sent us samples of various kinds of inking, and we then chose the best we could from that sample and used it.

Q You were not using the paste ink at that time, though, were you?

A I wasn't using any ink. Eaton-Allen was inking.

Q And they were not using paste ink, to your knowledge, were they?

A It is my understanding they were using paste ink.

Q Will you examine Exhibit 17 which is before you and tell me whether that is paste ink or ordinary printing ink?

A Exhibit 17?

Q Yes.

A That is paste ink.

Q You say that is paste ink?

A Yes.

Q Can you tell me what kind of nylon Exhibit 17 is

made of? Is that absorbent nylon or non-absorbent?

A That is non-absorbent nylon.

Q And that is the nylon, you say, which is the nylon always produced for you by the Floeger company?

A That's right.

Q How do you determine by looking at that ribbon with the naked eye that it consists of non-absorbent nylon, Mr. Wolowitz?

A Because it is my understanding --

Q No, no. Just tell me how, by looking at the ribbon.

A I can't tell you by looking at the ribbon. You asked me if it was nylon, and I'm trying to explain it. I think I'm entitled to explain how I can tell --

Q Let me withdraw the question, and ask this question.
Can you tell by looking at that ribbon whether it is absorbent nylon or not?

A I could tell you about all nylon, that nylon itself --

THE COURT: No, no. That is not the question.

Read the question, please, Mrs. Byrholdt.

(The reporter read the pending question.)

THE WITNESS: My answer to that is that the nylon is not absorbent.

BY MR. ROBSON:

Q That is not the question. Can you tell by looking at that ribbon whether the nylon is absorbent or not?

A I can tell by looking or not looking.

Q Let me ask you this question: Mr. Wolowitz, do I understand your testimony now that the Spellright ribbon at all times used a paste ink and non-absorbent nylon, is that correct, -- when it used the Ploeger material?

A The thing that I can ascertain correctly, I mean positively, is that when I ink, I ink a non-absorbent nylon with a paste ink.

Q But what about the material that was obtained from Schwarzenbach-Huber and inked by Eaton-Allen, was that non-absorbent nylon?

A Yes.

Q At all times?

A Yes.

Q And was that paste ink at all times?

A It was my understanding that the inkers were using a paste ink.

Q And the resultant printing ribbon would have a shorter life than an ordinary ribbon, is that right?

A A resulting ribbon of whose?

Q A resulting Spellright ribbon?

A Yes.

Q Would have a shorter life, is that correct?

A That's correct.

Q It would not outlast an ordinary two-color nylon ribbon, would it?

A The ribbon --

Q Can you answer my question yes or no? Would it outlast an ordinary two-color nylon ribbon?

A Yes.

THE COURT: Is not that going a little far afield, Mr. Robson?

MR. ROBSON: Your Honor, I am attacking this witness's credibility with respect to the brochure.

THE COURT: Oh, I am not going to permit that.

MR. ROBSON: I don't think Your Honor understands me. The witness testified on direct examination that his ribbon is not as long-lasting as the ordinary nylon ribbon. His brochure says it outlasts the ordinary nylon ribbon.

THE COURT: I understand that, but I am not going to permit you to cross-examine this witness concerning the accuracy of the statements in the leaflet merely on the issue of credibility.

MR. ROBSON: I am cross-examining on the accuracy of

his statement here in court, Your Honor.

THE COURT: It is customary in this court that when the Court rules that ends the matter.

MR. ROBSON: I just wanted to be sure that Your Honor understood me.

THE COURT: The last word is with the Court.

MR. ROBSON: I agree.

BY MR. ROBSON:

Q Let me show you Exhibit 11, Mr. Wolowitz, and ask you whether you can tell me whether that exhibit consists of non-absorbent nylon?

A I don't know what this exhibit consists of.

Q Would you look at it and tell me whether it consists of non-absorbent nylon or not?

A I can't tell by looking at this whether it is even nylon.

Q Can you tell me whether that exhibit has used a paste or an ordinary ink?

A I cannot tell you that.

Q Now, you performed an experiment or demonstration using certain materials, and you characterized one set of materials as the materials covered by the Markes patent, is that correct?

A That's right.

Q What is the Markes patent? Would you describe it, please.

THE COURT: I am going to exclude that. I do not think that this witness is a patent expert, at least he has not been shown to be qualified as a patent expert. For that reason, I attach no significance to his statement that the exhibit was structured according to some prior patent.

BY MR. ROBSON:

Q Let me ask you this with respect to that experiment: The piece of nylon which was laid side by side with a piece of nylon film, is that capable of being used as it stands as a ribbon?

A Properly inked?

Q No, as it stands?

A It's not inked.

Q Well, with ink, of course.

A Properly inked, yes.

Q With nothing else done to it, just the two pieces of material, one next to the other, can you use that as a ribbon?

A Oh, yes. Absolutely.

Q Without welding or joining?

A Of course. I have done it.

Q You can put those in the typewriter that way?

A I've done it.

Q Let's see if we can get straight what the situation was with respect to these one thousand ribbons.

First let me ask you: Was there any time from September 1962 until June 1963 when the Spellright Corporation constructed a printing ribbon consisting of a nylon fabric and a nylon film welded together?

A We never made a complete ribbon that way. We never made a complete ribbon that way. I will admit that part of the construction of the ribbon may have been that -- was that.

Q What do you mean by "part of the construction"?

A Well, our ribbon had a correction material and other materials, and you have not named those in your question.

Q I am asking only about the printing portion of a Spellright ribbon. Did there come any time in that period when the printing portion of a Spellright ribbon consisted of a film and a fabric of nylon which were welded together by you or someone at your order, other than the Ploeger company?

A Yes.

Q By whom were they welded together?

A I did it, Mr. Farrell did it, we both did it together.

Q How many ribbons were constructed in that fashion?

A Less than a thousand.

Q What was done with those ribbons?

A Those ribbons were -- first of all, about half were retained, were retained to see their aging qualities at our place. Some of the remainder were sent to individual customers for testing purposes.

Q Were any of them ever sent to A & S?

A No.

THE COURT: I think we will take our luncheon recess at this time.

(Whereupon, at 12:30 p.m., the Court recessed.)

AFTERNOON SESSION

2:00 p.m.

THE COURT: You may proceed.

BY MR. ROBSON:

Q Mr. Wolowitz, the experimental ribbon which you referred to earlier, was that identified by you as a Mark II ribbon?

A I didn't identify it here as a Mark II. We called it around our shop a Mark II, because we thought all our experiments --

THE COURT: You have answered the question. Just

confine yourself to answering questions.

THE WITNESS: I'm sorry, Your Honor.

Q I show you what has been marked as Exhibit 18, and ask you whether that is a list that was prepared at your direction?

A (Perusing the exhibit.) Yes, it is.

Q And does that list show the stores to which the Mark II ribbons were sent?

A Yes, it does.

Q And does A & S appear as one of the stores --

THE COURT: No, no. The document speaks for itself. Let's not waste time repeating its contents.

BY MR. ROBSON:

Q How did you determine, in answering my question this morning, that Mark II ribbons were not shipped to A & S?

THE COURT: Will you repeat your question, please, Mr. Robson.

Q How did you determine, in answer to my question this morning, that Mark II ribbons were not shipped to A & S?

A I told you that all our experimental ribbons were called Mark II. In January and February we, at our Cedar Street address, made Mark II ribbons which did not use Ploeger material. As soon as we accomplished the objective of those

tests, we made -- and that occurred after January and February -- in March, April, May and part of June, our Mark II ribbons were made with Ploeger material. That's how I made the determination.

Q Let's go back to the one thousand ribbons which you testified this morning were made with non-Ploeger material. Does that list contain any of the stores to which the non-Ploeger Mark II ribbons were sent?

A This list does not contain any ribbons that did not contain Ploeger material. To put it another way, these ribbons shipped, of Mark II, in them had only Ploeger material.

Q I show you Exhibit 17, and I ask you whether that is one of the ribbons which was shipped to the stores listed on Exhibit 18?

A This is one of the ribbons -- this is a ribbon similar -- this Exhibit 17 was a ribbon that was produced a year later -- about a year later -- at the request of Judge Jackson.

THE COURT: What exhibit are you showing the witness, Mr. Robson?

MR. ROBSON: That is Exhibit 17. The ribbon was handed --

THE COURT: Just the number of the exhibit.

MR. ROBSON: Exhibit 17, sir.

THE COURT: Very well.

THE WITNESS: Have I answered your question?

MR. ROBSON: I am not sure that you have. Would you repeat it, please.

THE WITNESS: This Exhibit 17 was a ribbon similar to the ribbons sent to A & S and other stores on this list. This ribbon was produced at the request of Judge Jackson about a year later at my deposition, March 1964.

BY MR. ROBSON:

Q Were the ribbons sent to the stores listed on Exhibit 18 manufactured in exactly the same way as Exhibit 17?

A Yes.

Q With respect to your testimony this morning about the absorbency of the nylon ribbon which was used in the Spellright ribbon, did I understand you to say that that absorbency was less than the absorbency of ordinary nylon ribbons?

A I don't think you understood me correctly.

Q Would you tell me what your testimony is in that connection?

A My testimony is that nylon in and of itself is not absorbent, either in my ribbon or any other ribbon.

Q What about the nylon ribbon? Is the nylon ribbon absorbent?

A No, the nylon fabric is not absorbent.

THE COURT: Mr. Robson, I told Mr. Hall this morning that I shall not try the merits of your client's invention.

BY MR. ROBSON:

Q You testified this morning that your examination of the Film-On printing ribbon indicated to you that it was the film that had been fused into the fabric and that the fabric had not melted. Was that your testimony?

A I think you understood me correctly.

Q Would you tell me how you determined that, what sort of tests you performed to determine that?

A Well, I could show you a test, if you would like.

Q What test did you perform?

A We pulled the fabric away from the film and found the fabric to be whole, to be not melted in any sense.

Q Did you apply a microscope to the fabric?

A I think once or twice I did. But my test relied more on the fact that when I pulled the film away from the fabric, I saw no trace of white or black, which there would have been -- if it were an uninked ribbon, it would have been white; if it had been an inked ribbon it would have been black. When I pulled them apart I found no trace of white or black in the film. On the other hand, I saw shiny --

THE COURT: I think you are going way beyond the confines of counsel's question, Mr. Wolowitz.

MR. ROBSON: Would Your Honor bear with me for a moment? I may be finished.

THE COURT: Surely. Take whatever time you need.

BY MR. ROBSON:

Q Mr. Wolowitz, did you at one time obtain a patent in Great Britain for a typewriter ribbon which incorporated a ribbon similar to the Film-On ribbon in suit here?

A I obtained a patent in Great Britain on a typewriter ribbon.

Q I show you a patent which has the number 961108 on it, issued in Great Britain, and ask you if that is a patent that was issued to you on your application?

A Yes.

MR. ROBSON: If Your Honor please, I would like to offer that in evidence.

THE COURT: What is the relevancy of that?

MR. ROBSON: The relevancy is that this patent contains as an integral part of it the exact structure which we contend --

THE COURT: I asked what is the relevancy?

MR. ROBSON: It contains as an integral part of it

the exact structure which we contend is an infringement of the structure in suit, and it describes it as welded at the edges.

THE COURT: How is it relevant to the issues of this action? What does it tend to prove?

MR. ROBSON: It refutes this witness's testimony that the film and the fabric would not be welded together because the fabric would melt.

THE COURT: Oh, I see. Very well. Let it be admitted.

Suppose you call the Court's attention to the statement in the exhibit on which you rely. Otherwise, the exhibit is valueless. Especially in non-jury cases when you offer a voluminous exhibit in evidence and you rely on a single sentence, you want to point out that sentence.

THE DEPUTY CLERK: Plaintiff's Exhibit 21 in evidence.

(Plaintiff's Exhibit No. 21, Patent No. 961,108 issued in Great Britain to Wolowitz, was received in evidence.)

MR. ROBSON: I am referring now to page 3, column 1, line 55.

THE COURT: Would you mind marking that.

MR. ROBSON: I will mark it at the edge. And it continues on line 73, column 3. It refers to Figure 5 of the

drawing and Figure 6, which Your Honor will see when you look at them are identical to the figure in the patent in suit.

THE COURT: I will read the parts that you mark

MR. ROBSON: All right. You don't want me to read them to Your Honor?

THE COURT: Just hand them to the clerk, if you will, please.

(The exhibit was passed to the Court.)

THE COURT: You may suspend a moment, if you will.

(The Court perused the exhibit.)

THE COURT: Very well. You may proceed.

MR. ROBSON: I have no further questions, if Your Honor please.

THE COURT: Very well.

MR. ROBSON: If Your Honor please, I did offer that exhibit in evidence, did I not?

THE COURT: Yes. It is admitted.

REDIRECT EXAMINATION

BY MR. HALL:

Q One question, Mr. Wolowitz: When Ploeger's material is run through an inking machine to apply this ink, does the inking machine squash the ribbon any?

A Yes, it does.

MR. HALL: No further questions.

THE COURT: You may step down.

(The witness stepped down.)

MR. ROBSON: If Your Honor please, I would like to call Your Honor's attention to the results of that experiment, just to indicate that in all of the ribbons there is a certain amount of absorbency.

THE COURT: Oh, Yes.

MR. HALL: Your Honor, we are through except that I want to offer in evidence some interrogatories and some excerpts from depositions.

THE COURT: Just a moment. What do you want to offer in evidence first?

MR. HALL: Some interrogatories that we propounded to them and some excerpts from depositions.

THE COURT: Will you locate them for me, please. I want to take them up one at a time.

MR. HALL: I offer in evidence our interrogatories 35, 36 --

THE COURT: You offered some interrogatories previously, did you not?

MR. HALL: We read from some. In fact, we read some of these.

THE COURT: What are you offering now, Mr. Hall?

MR. HALL: Well, the ones that we have read from and then some more.

THE COURT: Oh, well, let them be considered in evidence.

MR. HALL: I think so, Your Honor. A lot of these are just background information that I just don't want to be caught without in the final argument.

THE COURT: I see.

MR. HALL: There is only one page of this that I would like to have Your Honor read.

THE COURT: Very well.

MR. HALL: I offer in evidence the following interrogatories, together with their answers: 35, 36, 62-S, 52, 53, 54-A and 54-B.

Now, from the deposition of Mr. Ploeger, Jr. --

THE COURT: Before you do that, which do you want the Court to read?

MR. HALL: None of those interrogatories. Just one page from the deposition.

THE COURT: Are there any parts of the interrogatories that you wish the Court to read?

MR. HALL: No, Your Honor. Before I read this one page of the deposition, we have a stipulation. I believe

opposing counsel is willing to stipulate that at the time of this demonstration in New York regarding the alleged trade secret that there was present, in addition to Mr. Wolowitz and Mr. Ploeger, Jr., also Mr. Ploeger's father, who was Mr. Ploeger, Sr., and there was also present Mr. Ploeger, Jr.'s sister. Do you agree?

MR. ROBSON: I so stipulate.

MR. HALL: Now, Your Honor, I would like to either read to Your Honor or ask you to read --

THE COURT: I will read it myself. Just indicate what you are offering in evidence.

MR. HALL: I will offer in evidence from the deposition of Mr. Ploeger, Sr. pages 2 and 3 for the purpose of showing who he was. And I will also offer in evidence from page 61, line 4 through the end of the page.

THE COURT: Very well. Page 61.

MR. HALL: Yes, Your Honor.

THE COURT: Very well.

MR. HALL: In addition, I would like to offer the following pages of this same deposition, but without asking Your Honor to read them: Page 45, line 10, to page 46, line 4; page 86, line 12, to page 88, line 21; page 97, line 15, to page 98, line 3.

In the deposition of Walter Ploeger, Jr., I will

offer page 2 to identify who he was, and I will further offer page 52, line 12; page 53, line 1; and page 57, line 6, to page 58, line 5.

In the deposition of Lawrence G. Hommell, I will offer in evidence the whole direct examination and the entire redirect examination. That's quite a short deposition, and I don't think Your Honor is very much interested in the point that was covered there, but --

THE COURT: Whose deposition?

MR. HALL: Lawrence G. Hommell -- H-o-m-m-e-l-l.

And then the deposition of John --

THE COURT: The clerk informed the Court that we do not have that deposition. There is nothing in it that you wish the Court to read?

MR. HALL: No, Your Honor. And then the deposition of John Nagy, I will offer his entire cross-examination.

MR. ROBSON: If Your Honor please, I object to the introduction in evidence of the testimony of any witness without any proof of why he wasn't produced by the plaintiff, why he wasn't subpoenaed.

THE COURT: Without proof of what?

MR. ROBSON: Why he wasn't subpoenaed.

THE COURT: What about that, Mr. Hall? You are

referring to the deposition of John Nagy?

MR. ROBSON: Yes, Your Honor. The other people are offering it.

MR. HALL: John Nagy lives in Philadelphia. He is beyond the range of any subpoena of this Court.

THE COURT: I think that is an adequate answer. The Court will take judicial notice of the fact that it is more than one hundred miles to Philadelphia.

MR. ROBSON: Even if Mr. Nagy is not subject to subpoena, I believe that counsel should have to show that he made an attempt to get him here and he didn't come.

THE COURT: If he was available within a one-hundred-mile radius of the place of holding court, there would have to be a showing that he tried to subpoena him; but I do not think that there is any requirement that an attempt to have a witness come voluntarily be made. At least we do not take that view in this court. I don't know whether they do in other courts.

MR. ROBSON: Frankly, I am not a hundred per cent certain. I thought that the rule was that an attempt had to be made to produce the witness, but I wouldn't be willing to stake my reputation on it.

THE COURT: An attempt has to be made to get the witness to court, which means that if he is within the range of

a subpoena an attempt has to be made to subpoena him. I do not think that an attempt has to be made to induce him to come voluntarily.

MR. HALL: I will offer page 5 of the Nagy deposition just to show who he is. Otherwise, we rest -- no --

THE COURT: You are offering his cross-examination, I believe you said.

MR. HALL: Yes. I believe that there were some exhibits that we didn't offer in evidence.

THE COURT: Is there anything that you wish the Court to read? If there is, we will suspend, and I will read it.

MR. HALL: No, I don't think we need to ask you to read anything from the Nagy deposition, but I may bring up some of the things that Mr. Nagy said in the final argument.

THE COURT: Oh, you have a right to do that.

MR. HALL: The clerk is now telling me that I didn't offer some of the exhibits in evidence, and as soon as I find out what they are, I will offer them.

MR. ROBSON: I wish Your Honor's indulgence for a moment while I examine the references of Mr. Hall so I can see if I need anything to explain them.

THE COURT: Just go slowly.

MR. HALL: I offer in evidence Defendants' Exhibits 5, 6, 12 and 13.

THE COURT: Let them be admitted.

(Defendants' Exhibits 5, 6, 12 and 13, previously described, were received in evidence.)

MR. HALL: The defendants rest, Your Honor.

MR. ROBSON: If Your Honor please, with respect to Interrogatories Nos. 52, 53 and 54 which Mr. Hall has introduced in evidence, I would like to object to the admissibility of those. Those interrogatories relate to the matter which Your Honor has already ruled is irrelevant in this case, that is, the question of the sending of the letters to various customers.

THE COURT: I understand. If they are irrelevant, then the Court won't consider them. This is different from a jury case.

Do both sides rest, or is there some rebuttal testimony?

MR. ROBSON: No, sir. I do have some very short rebuttal testimony which will take about ten minutes. I just want to finish examining these exhibits that were admitted.

THE COURT: Surely.

MR. ROBSON: With respect to the exhibits which were

just offered, I would merely like to offer the direct testimony of Mr. Nagy since counsel only offered the cross-examination. Other than that, I have no further objection.

THE COURT: Do both sides rest?

MR. ROBSON: No, Your Honor, I would like to call Mr. Ploeger, Jr. again.

THE COURT: Very well.

Thereupon

WALTER PLOEGER, JR.

called as a rebuttal witness by the plaintiff, having been previously sworn, resumed the witness stand and further testified as follows:

DIRECT EXAMINATION

BY MR. ROBSON:

Q Mr. Ploeger, with respect to the ribbon processed by your company, did you ever use nylon fabric which was non-absorbent?

A Never.

Q Was the nylon fabric on the ribbon which was processed for Spellright Corporation always an absorbent nylon?

A As far as I know, it was always absorbent.

Q Mr. Ploeger, have you ever seen or heard of in your trade a process of welding -- I withdraw that.

Have you ever seen a process of fusing a nylon film to a nylon fabric, or vice versa, which involved using a dye and heat and pressure at the edge of the two materials?

A No, I have never seen such an operation.

Q Is it feasible to join the nylon fabric -- I withdraw that.

Is it possible by any equipment which you have ever seen or which is known to anyone in your trade to fuse the nylon fabric and the nylon film used in your ribbon by means of pressure applied and heat applied on only one of the two members?

A I have never seen such a feasible operation.

Q What is the only method of fusing the nylon fabric and the nylon film known to you so as to achieve a seam or weld along the extreme edge involving only the outside one or two fibers?

A The only way known to me is to have a heated element, that is to say, the element being a sharpened knife, having it heated to such an extent that it is able to melt or fuse both the nylon plastic film and the nylon woven film, also to render that molten, and to have both of these molten masses run together into a permanent welding. And this heat is employed from the side, not from the top, always from the side.

Q How wide --

THE COURT: Just what do you mean by "from the side," Mr. Ploeger?

THE WITNESS: Well, sir, if you consider my hand here as the length of the tape, by "side" I mean picturing the thin edge part, the heat would enter in this way, as opposed to pressing down from the top. (Indicating.)

Let's picture a long -- let's picture a butcher knife, so to speak, which has its flat surface laying on the table, if you look at the edge side of the knife, the sharpened side -- that is what I am referring to as the "edge," as opposed to the "flat."

THE COURT: What does the knife cut?

THE WITNESS: The knife cuts the two members, the film and the cloth, simultaneously; and at the same time applies heat to the side.

THE COURT: Does it cut longitudinally?

THE WITNESS: Yes, sir, in one continuous strip.

BY MR. ROBSON:

Q How wide is one of the fibers in the nylon fabric which is a part of your ribbon?

A About two-thousandths of an inch.

Q Is a weld two-thousandths of an inch wide, or even

four-thousandths of an inch wide, if it covered two fibers, visible to the naked eye?

A It is very, very difficult to detect it, very difficult. No, it would definitely take a microscope to see such a weld. Absolutely.

Q You heard Mr. Norton testify that he has seen nylon fabrics or films fused by applying heat to one surface, and he indicated that the border was approximately one-eighth of an inch. If you were to apply heat to a border one-eighth of an inch on each side of your ribbon, would the ribbon be usable in accordance with your patent?

A The ribbon would definitely be rendered unusable for any printing ribbon purpose.

Q Why is that?

A Why is that? Because, first of all, the printing ribbon is so designed to have the ink flow to the extreme outside of the ribbon. And there's a good reason for that, because when the ribbon is employed -- let's say in a typewriter -- one finds that the typewriter keys will impact. We find that the typewriter keys impact the ribbon all across. In other words, the keys come very, very close to the rim of the ribbon. So, obviously, if your edge is an eighth of an inch wide on each side, you are going to be impacting on the

area that contains no ink; or, better still, you are either going to end up with a character that's cut off, so to speak. You'll have part of the character without ink and part with ink. You'll only have half a character.

Q How wide is a typewriter ribbon?

A Normally one-half inch wide.

Q So that if one-eighth of an inch at each edge was taken up with a fused seam, there would only be one-quarter of an inch --

A That's all. You would just have a quarter of an inch left. Yes, sir.

THE COURT: I want to bring the witness back to something on which I feel that I am a little obtuse: Just how do you apply the knife? I don't understand your statement that you applied it to the side. What do you mean by that? You cut along the edge longitudinally, don't you?

THE WITNESS: If you will, Your Honor, picture this rigid knife -- let's say this is the knife right here -- actually this is the knife here. Let's say this is the knife. The cutting area, the point, is right here, just like so. (Indicating.)

You have a condition whereby the cloth actually runs along this heat -- this whole knife here is hot -- it's

almost red hot -- you have the two layers -- you must picture this as a continuous operation. And these two layers are running against this knife, being sliced by the knife, and also receiving this tremendous heat from the side, from the edge, so that the heat is pushed in from the edge, as opposed to over the top, you see.

In other words, this knife actually is in contact with both simultaneously.

THE COURT: I do not understand what the words mean, "from the side." That is what is confusing to me.

THE WITNESS: Yes.

THE COURT: Does the knife cut the ribbon longitudinally along the edge?

THE WITNESS: Well, as soon as you cut, it automatically receives an edge, you see.

THE COURT: My question is: Does it cut longitudinally along the edge of the ribbon?

THE WITNESS: That's correct. That's correct.

THE COURT: And at the same time it heats the edge, is that it?

THE WITNESS: It heats the edge. That's right. In other words, the heat comes in contact with both these layers. It cuts the edge --

THE COURT: Don't get ahead of me now.

THE WITNESS: Yes.

THE COURT: You have this heated knife. I gather from what you said the other day that it is heated by electricity to a high degree, --

THE WITNESS: That's correct.

THE COURT: -- and it is moved along the edge of both layers together?

THE WITNESS: Well, the action is similar to what you are explaining, except that the knife in this case is rigid, and the cloth does the moving. In other words, --

THE COURT: Oh, the knife is not moving, it is the cloth that is moving?

THE WITNESS: Right. That's correct.

THE COURT: But the cloth, the fabric and the film, are moved longitudinally along the knife, is that it?

THE WITNESS: That is absolutely correct.

THE COURT: And the knife stands up and down?

THE WITNESS: Up and down. Just like that. That's correct. I'm exaggerating the angle of the knife.

THE COURT: I think I understand now. I hope that I understand correctly.

THE WITNESS: I hope so.

MR. ROBSON: May I call Your Honor's attention to one of the illustrations on the back of the Wolowitz patent, the last exhibit, which shows this process.

THE COURT: Which exhibit? Oh, the Wolowitz patent.

MR. ROBSON: That was the last exhibit.

THE COURT: It was one of the last exhibits.

MR. ROBSON: Number 21.

THE COURT: I like to be able to visualize this piece of machinery.

MR. ROBSON: It is much easier to understand then.

THE COURT: Which figure is it, Mr. Robson?

MR. ROBSON: It is Figure 5, Your Honor.

THE COURT: Figure 5. Thank you. You may proceed.

BY MR. ROBSON:

Q Mr. Ploeger, would it be obvious to anybody ordinarily skilled in the trade of making ribbons that it would be necessary, in order to fuse a nylon film to a nylon fabric to a depth of only one or two threads, that the heat would have to be applied simultaneously from the side to both edges?

A I'm sorry -- would it be obvious?

Q Would it be obvious?

A I don't believe it would be obvious.

Q Referring to your patent and the illustrations contained in your patent, if one ordinarily skilled in the trade looked at your patent and saw the illustration which showed a weld extending in only as deep as one thread, would it be obvious to such a person that he would have to make that weld by applying the heat from the side?

A Oh, yes, yes, surely.

THE COURT: Would it be obvious that what?

MR. ROBSON: That the heat would have to be applied from the edge or the side?

THE WITNESS: Oh, yes. Absolutely.

BY MR. ROBSON:

Q Would it also be obvious that that was the only way it could be done?

A Absolutely.

MR. ROBSON: I have no further questions.

THE COURT: Is there any cross-examination?

MR. HALL: Yes, Your Honor.

CROSS-EXAMINATION

BY MR. HALL:

Q Mr. Ploeger, now dealing with the absorbency of this fabric, I want to read from your deposition at pages 57 and 58, and ask you if you so testified:

THE COURT: May I have the deposition, please.

(The deposition was handed to the Court.)

Q (cont.) (Reading.) Question: Woven nylon, such as you used for the inked portion of your ribbon?

Starting at line 3.

Answer: The question is not clear.

Question: Would it be a correct statement to say that nylon per se is not --

THE COURT: On what page is that?

MR. HALL: Page 57.

THE COURT: Of the witness's deposition?

MR. HALL: Yes. Line 3.

THE COURT: Thank you. Very well.

Q (cont.) "Question: Woven nylon, such as you used for the inked portion of your ribbon --

"Answer: The question is not clear.

"Question: Would it be a correct statement to say that nylon per se is not particularly absorbent?

"Answer: When you say absorbent, again you will have to clarify what you mean by absorbent. Absorbent to what?

"Question: Would you clarify it?

"MR. GONDA: He clarified it. Are you asking him to read your mind? I don't understand.

"BY MR. HALL:

"Question: Is it particularly absorbent to ink?

"Answer: I don't know. I am not a textile engineer, and I don't know. Again the question could be highly technical and I don't know if it is or not, as such. I am going to help you along in this by trying to break down the fiber from the woven material, so if you want to ask me, from that point on, the fiber itself or the woven material, ask me the question from that.

"Question: I will ask you that question. Could you give me the answer?

"Answer: Right. What is the question?

"Question: The fiber of nylon?

"Answer: Fiber or filament?

"Question: Is it particularly absorbent?

"Answer: No.

"Question: But you don't think it is stating the matter fairly to say that nylon per se is not particularly absorbent?

"Answer: Again, nylon per se is what? What does per se mean? I don't know the legal term.

"Question: In and of itself.

"Answer: The nylon fabric. Is that what you are

saying?

"Question: Yes.

"Answer: It could be and it couldn't be. It could or couldn't be."

Did you so testify?

A Yes, sir.

MR. HALL: I have no further questions.

MR. ROBSON: Just one question.

REDIRECT EXAMINATION

BY MR. ROBSON:

Q Is nylon fabric treated specially when it is manufactured in order to make it absorbent?

A Nylon fabric has to be specially treated for printing ribbon purposes. Absolutely.

Q To your knowledge, --

A Yes, then it becomes very absorbent.

Q To your knowledge, is all nylon fabric commercially produced treated to make it absorbent?

A Not treated to make it absorbent for printing inks, no, sir.

Q Not for printing inks but to make it absorbent for something?

Let me ask it this way: Is all nylon fabric which is

produced for use in printing ribbons treated to make it absorbent?

A Absolutely.

MR. ROBSON: I have no further questions.

THE COURT: You may step down.

(The witness stepped down.)

MR. ROBSON: May I call Mr. Seidel back for just a few questions, Your Honor.

MR. SEIDEL: I will be brief.

THE COURT: Only counsel can say that. You are a witness.

MR. ROBSON: I swore him to brevity, Your Honor.

Thereupon

ARTHUR H. SEIDEL

called as a rebuttal witness by the plaintiff, having been previously sworn, resumed the witness stand and further testified as follows:

DIRECT EXAMINATION

BY MR. ROBSON:

Q Mr. Seidel, in what part of the Patent Office classification system is the patent in suit classified?

A Class 197 --

THE COURT: Oh, the classes are printed on the

patents. You don't have to have him testify to that.

MR. ROBSON: Just four questions, Your Honor. Would you bear with me?

THE COURT: You do not have to call a witness in order to state what particular class a patent is in in the Patent Office.

BY MR. ROBSON:

Q Does the file wrapper indicate the class or classes searched by the Patent Examiner?

THE COURT: What is your question?

MR. ROBSON: Does the file wrapper indicate the class or classes searched by the Patent Examiner.

THE COURT: I will exclude that. That is a matter of routine that the Court is familiar with, and we do not want testimony on it.

BY MR. ROBSON:

Q Did you have occasion to examine Class 197, Subclass 172, recently?

A Yes, sir, I did.

Q When was that?

A Monday, October 2nd, at 4:35 p.m., at the Examiner's Division.

Q And did you find the German Patent 966,174 in the

Examiner's patent collection in that class?

A Yes, sir, I did.

Q Has that class been reclassified since 1959?

A No, it has not.

MR. ROBSON: No further questions, Your Honor.

CROSS-EXAMINATION

BY MR. HALL:

Q Did you know the definition of that class and subclass?

A The class is called "Typewriting Machines," and the subclass is directed to "Typewriter Ribbons."

Q So the German patent is classified in the Patent Office under "Typewriter Ribbons"?

A It is classified under "Typewriter Ribbons" in the same class as the patent in suit and in the class that was searched. That's correct.

MR. HALL: Thank you.

THE COURT: You may step down.

MR. ROBSON: The plaintiff rests, Your Honor.

THE COURT: Both sides rest. Gentlemen, if you are ready to proceed with the summing up, we can take a short recess if you wish.

I do not wish to hurry you, but so as to get an idea

of the time, about how long does each one of you expect to take? I am not going to hold you to any particular estimate of time, but I want to get some idea in order to fix some sort of schedule. I don't suppose we can finish it this afternoon.

MR. ROBSON: I hope so, Your Honor. I shouldn't be more than half an hour myself.

MR. HALL: If he can limit himself to half an hour, I can, too.

THE COURT: Very well. However, if you run over, that is perfectly all right. I want you both to feel free to take whatever time you need, and you had better make arrangements to be here on Monday morning, Mr. Robson.

MR. ROBSON: If I am going to have to come back to Washington on Monday morning, I wonder if we could hold the arguments on Monday morning also?

THE COURT: That is not an unreasonable request. What do you say, Mr. Hall? That will give counsel a chance to confer with their associates and organize their thoughts.

MR. HALL: I have no objection to that. However, I may have to appear before Judge Sirica as a preliminary matter on Monday morning.

THE COURT: You are in trial here. I expect to render my opinion on Monday.

MR. HALL: Maybe he will put it over until Tuesday morning. You know that big motion they had, my stand-in didn't win, and I guess he didn't lose either because Judge Sirica is going to certify the question to the Court of Appeals.

THE COURT: I see.

MR. HALL: The other man I don't think has had any experience with anything like that, and I think maybe I had better be there. Maybe Judge Sirica will put it over.

THE COURT: I am sure that Judge Sirica will hold that. We always take the view in this court, as you no doubt know, that engagements in a trial take priority over engagements in a motion, and members of this court always cooperate with each other accordingly.

Then I see no reason why we shouldn't recess at this time and have the arguments on Monday morning. As I say, I just want to get an estimate, but I don't want you to feel restricted, that you must finish in thirty minutes or even thirty-five.

I want to say to both of you that I have read the briefs on both sides. They are very helpful. And I also want to say this, that this case has been very ably tried on both sides in the best traditions of the bar.

MR. ROBSON: Thank you, sir.

MR. HALL: Thank you.

{Whereupon, at 2:45 p.m., the Court recessed, and the case on trial was respited until Monday morning, October 9, 1967, at 10:00 a.m.)

- - -

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.)

Plaintiff)

v.)

Civil Action No. 1514-63

SPELLRIGHT CORP.,)

et al.)

Defendants.)

Washington, D. C.

Monday, October 9, 1967.

The above-entitled cause came on for further trial
before the HONORABLE ALEXANDER HOLTZOFF, UNITED STATES
DISTRICT JUDGE, at 10:09 a.m.

Appearances:

For the Plaintiff:

MORTON ROBSON, ESQ. and
EDWARD C. GONDA, ESQ.

For the Defendants:

WILLIAM D. HALL, ESQ.

- - -

P R O C E E D I N G S

THE DEPUTY CLERK: Filmon versus Spellright.

MR. ROBSON: The plaintiff is ready.

THE COURT: You may proceed, Mr. Robson.

MR. ROBSON: Does the plaintiff sum up first, Your Honor?

THE COURT: I beg your pardon?

MR. ROBSON: In the Southern District the plaintiff always sums up last.

THE COURT: Oh, no, no, no. The plaintiff opens and closes. You may proceed. Here the plaintiff opens and closes, and in criminal cases the government opens and closes.

MR. ROBSON: I represent the plaintiff here.

THE COURT: Yes. So you may proceed.

MR. ROBSON: I thought Mr. Hall would close first and then the plaintiff.

THE COURT: I am saying to you that in this District, the practice is for the plaintiff to open and close.

MR. ROBSON: Open and close first. I see.

THE COURT: The plaintiff opens and closes, and in criminal cases the government opens and closes.

MR. ROBSON: May it please the Court. At the risk of stating to Your Honor basic rules which I know Your Honor is

already aware of, but simply to indicate the context in which I want to present the facts, I am going to briefly state certain basic principles which I understand to be applicable.

I believe it is Hornbook law that a patent is presumptively valid once it is issued by the Patent Office, and that the invalidity must be shown by the defendants by clear and convincing evidence.

THE COURT: I think we generally render lip service to that principle. It is not a very obvious presumption like the presumption of the constitutionality of a statute.

MR. ROBSON: I would liken it to the presumption of an administrative regularity which attaches to an administrative hearing.

THE COURT: And it is hardly even as strong as that. Since you practice in the Second Circuit, I have noticed over the years that the Second Circuit pays very little attention to that presumption. Some of the other circuits pay more attention to it. You may proceed, Mr. Robson.

MR. ROBSON: In any event, it is clear that the burden is on the defendant to establish that the patent in suit is invalid, and this should be done by clear and convincing evidence.

THE COURT: No, the first part of your statement is correct, but not by clear and convincing evidence. The burden

is on the defendant to establish the invalidity of the patent, of course, but not by clear and convincing evidence, by the preponderance of the evidence.

MR. ROBSON: Moreover, as I understand the law, subject to that correction, it is not a question of whether this Court in the same position would have rendered the same decision or come to the same conclusion as the Patent Examiner, but, rather, whether this Court can conclude that the Patent Examiner erred, that is, that his decision was an incorrect decision rather than one with which the Court disagrees.

There are also certain other presumptions which I think attach in this case, one being that all doubt should be resolved against a patent infringer; two, that a patent wherever possible should be narrowly construed in order to sustain its validity; and finally, that where a defendant has imitated the patent in suit, this is some evidence of the fact that the item or invention patented is --

THE COURT: Where the defendant has what?

MR. ROBSON: Has imitated, has attempted to copy the item patented, that this is some evidence of the validity of the patent.

In the context of the law as I have stated it, as modified by the Court, let's examine what the defendants' proof was on the subject of invalidity.

Although the defendants did cite a number of prior patents on the theory that these patents tended to lead to, in obvious fashion, the patent in suit, and cited specifically a German patent which its expert claimed was almost identical -- or identical -- with the patent in suit, I think we will find upon analysis that the testimony of the expert did not really tend to sustain the position which he took.

Before discussing the testimony of the expert, I think it is important to remember -- and Your Honor himself has stated this following proposition -- it is important to remember that when dealing with a foreign patent, the identity of the invention should be clear and unequivocal in the foreign patent. It should not be necessary to drag it out of the language of the patent and read it in by implication.

Now, as I understand the expert's testimony, he concluded that he was a person ordinarily skilled in the art, which is the test, that is whether or not the German patent was obvious or made the present patent obvious to one ordinarily skilled in the art, and the expert said that he was such a person.

It is my position that his testimony is completely worthless on that basis, for the reason that he is clearly not a person ordinarily skilled in the art. Quite to the contrary,

he is in certain areas much more highly skilled than any person in the art and in other ways completely ignorant in the art. Thus he is a graduate organic chemist, a patent lawyer with forty years of experience.

THE COURT: I did not understand that he testified as an expert skilled in the art. He testified as a patent expert.

MR. ROBSON: I asked him whether he considered himself ordinarily skilled in the art.

THE COURT: Yes, but I think he was tendered as a patent expert. I so understood.

MR. ROBSON: Yes, he was, but his conclusion, as I understand the law, must be that as a patent expert he was concluding that a person ordinarily skilled in the art would have arrived at the plaintiff's patent. And I say that he is not ordinarily skilled in the art. He comes to this court with a very, very high degree of expertise both in the sciences and in the patent law, but when it comes to the art involved he knows nothing about it. He's never seen a ribbon made. He's never seen any of the patents in suit in final form. He has never seen the German patent constructed. He has no idea of what is involved in constructing patents. He knows a lot about chemistry. He knows a little bit about how nylon, under some

finding that this really should be understood by us to include two thermoplastics and those thermoplastics nylon.

We should not be required to ignore normal rules of interpretation of language which indicate that where a qualifying word is used, wherever it is intended to qualify something, that when that word is not used it should not be read in. The words "thermoplastic bonding" and "thermoplastic film" are used possibly ten or fifteen times but never "thermoplastic fabric" -- not once.

Now, Your Honor indicated on several occasions during the trial a concern with and an interest in the De Forest-Armstrong case.

THE COURT: I only referred to it as an illustration.

MR. ROBSON: As an illustration. But it is a good illustration. I think it's good because it indicates the problems and also the differences between that area and our area.

THE COURT: I always thought that the history of that controversy read like a romance, and it is more interesting than many novels.

MR. ROBSON: From what little I've learned of it since I became involved in this case, I think you're right.

But one thing was clear in that case: they were dealing with a rather simple circuit, simple in retrospect, although it

sensitive adhesive affixed to fabric did not teach the use of similar pressure sensitive adhesive to a piece of cellophane. The difference there only being in the material used, yet the patent was held valid.

I believe that unless you read a great deal into the German patent and read a great deal out of the Ploeger patent, the only conclusion possible is that they are not identical structures. And if they are not identical structures, then I think there is no evidence in the case whatsoever to warrant a finding that the Ploeger patent was obvious.

The changes made by Ploeger, the use of a thinner nylon film than the nylon fabric and the weld along the edge, had unexpected, unexplainable results. It is the first embodiment that has been able to work. The courts have held, and I'm not sure whether Your Honor follows this rule or not, because apparently there are variations of these rules, but many courts have held that the fact that there are unexpected and unexplained results is in itself conclusive of the lack of obviousness.

THE COURT: Oh, yes. That is not conclusive, but it may be some proof of invention, of course.

MR. ROBSON: It is certainly strong if not conclusive evidence.

not specifically referred to as a patent reference is no indication that the concept of the German patent was not considered by the Patent Examiner when he examined the Phelps patent.

THE COURT: The general rule is that prior art which is not referred to in the file wrapper has a greater weight on the issue of validity than prior art referred to by the Examiner and not considered as barring the patent.

MR. ROBSON: I realize that, and that's why I'm pointing this out, that it was a good reason why it wasn't referred to.

THE COURT: I think he would have referred to it, because the usual practice is for the Examiner to list the prior art. I think it is a fair inference that he did not discover it. We find in patent litigation lots of instances where some item of prior art is not discovered by the Examiner, especially so when you have an item in a foreign language, because it is more likely to be overlooked by the Examiner than an item in the English language.

MR. ROBSON: Although the picture here is --

THE COURT: Oh, yes, the picture is good.

MR. ROBSON: Obviously, I don't know what the Examiner had in mind.

THE COURT: Of course, we can't figure out what was

in the Examiner's mind except from the outward facts.

MR. ROBSON: There's only one other patent which I think really should be mentioned which the defense placed some feeble hopes on, and that was the Markes patent. There was some testimony and demonstration by Mr. Wolowitz which apparently was supposed to be indicating that the Markes patent really taught the increased absorbency rate and other things, because that patent used a nylon film — they say used a nylon film and a nylon fabric. But the Markes patent is so far from what we are dealing with here that it hardly requires an answer. The Markes patent had two separate reels. The two ribbons were not inked together. There's no indication that Markes was talking about a nylon film, and a ribbon such as ours could not possibly function unless somehow the film and the fabric were held together. There wouldn't be any reservoir, any absorbency increase, or anything else, unless these two were part of one structure, which they clearly were not in Markes.

I believe that I have now adequately covered the defendants' evidence on the question of validity, and I think that I have demonstrated that there is barely any evidence at all to establish that the German patent is a patent which should have taught the invention contained in the Floeger patent.

There were a couple of defenses on the question of patent infringement. I'm not sure whether they are seriously urged at this time or not. One of them was that the defendant had a license to use the patent.

THE COURT: Certainly there is not enough evidence to sustain that, so you need not burden yourself by discussing it.

MR. ROBSON: The other was a discussion of bad faith, which I don't think, again, was ever seriously urged or could have been.

On the question of whether or not there was an infringement we are entitled to damages, a few words should be said:

It was apparently the position of the defendants that even if there were an infringement, there would be no right to damages or an accounting for profits, in view of the provisions of the statute that indicated that damages would not flow unless there were either markings with the patent number or notice of infringement.

This statute, however, has been interpreted in a number of cases as not applying to a situation in which the infringer has actual knowledge of the patent. It would seem clear that the statute is designed to deal either with constructive notice or, in the absence of constructive notice,

a question of what kept the type face clean, which could have applied to almost anything. He said after all scotch tape was on the ribbon, maybe they were referring to scotch tape. I don't know what the purpose of that red herring was. Scotch tape has not been a patented item since 1956 when the patent on that expired, and certainly was not in existence in 1961 or 1962 when these acts took place.

The last item, which will only take me a few minutes, is the question of the trade secret.

There's no real denial by Mr. Wolowitz that they used the trade secret, although there was an attempt made to indicate that when they constructed the ribbon, they didn't use the trade secret in constructing these particular ribbons --

THE COURT: Assuming that they were using the trade secret, is not that the purpose for which it was revealed, because there was no confidential relationship between the plaintiff and the defendant? The defendant was a customer of the plaintiff.

MR. ROBSON: That is correct.

THE COURT: Of course, according to the testimony, and giving full effect to Mr. Ploeger's testimony, he did ask the defendant to keep this process confidential. Did not that mean that he didn't want it disclosed elsewhere, to anyone

else, because he was planning to patent it? That does not necessarily mean that he didn't want the defendant to use it, because if he did not want the defendant to use it, why did he tell him?

MR. ROBSON: I think he did want the defendant to use it. I think the narrow issue is --

THE COURT: Then if that is so, that is not an abuse of a trade secret.

MR. ROBSON: I think it would boil down to the narrow issue of fact whether the defendant could use it only so long as he was using the Ploeger material, or whether he gave him carte blanche to use it whenever he wanted to. His testimony -- it was Mr. Ploeger's testimony that it was limited to use with the Ploeger material. And this makes a certain amount of sense since they were doing business, Ploeger in an attempt to increase his business was willing to allow certain of his trade secrets to be used. The fact that Ploeger did file a patent application and receive a patent on it -- an application which was filed, curiously enough, after the defendant filed an application for a patent on the exact same item in the United States, and never filed an interference or made an attempt to keep the plaintiff from getting that patent.

I believe that I have covered all the points. I

that be true, the same process of manufacture would have to be accorded to the German patent as is accorded to Mr. Ploeger.

THE COURT: Mr. Hall, I would like to ask you this question. Is it your contention that the German patent is an anticipation; or is it your contention that in the light of the German patent, the additional step taken by Ploeger was obvious?

MR. HALL: The latter.

THE COURT: The additional step, I presume you contend, was the substitution or the possible addition of nylon to silk, is that it?

MR. HALL: Not the substitution --

THE COURT: Not the substitution, but the additional possibility.

MR. HALL: I look at it this way: That the three common ribbon materials that were in use at the time the German patent was written were cotton, silk and nylon, and that it would be obvious to anybody attempting to apply the German patent that he try it with these three materials.

THE COURT: In other words, according to your theory, the additional step taken by Ploeger over the German patent was the possible use of nylon, is that it?

MR. HALL: Yes.

THE COURT: And that is obvious?

MR. HALL: The German patent does not specifically refer to nylon.

THE COURT: He refers to silk in passing.

MR. HALL: That's right. That's why I think he is contemplating the others, because the way he refers to silk is, "My thing is an improvement, even as to the finest silk tissues," and since nylon is coarser than silk and cotton is coarser yet, by saying, "Mine is applicable to even the finest possible materials," --

THE COURT: In other words, your contention is that using nylon in the structure described by the German patent was obvious, and therefore not a product of his invention?

MR. HALL: That's right.

THE COURT: We will take our usual mid-morning recess.

(Whereupon, at 11:16 a.m., the Court recessed.)

AFTER RECESS

11:30 a.m.

THE COURT: You may proceed, Mr. Hall.

MR. HALL: Your Honor, getting back to the thing that we were discussing just before the recess, it is our position that the German patent is classified in the Patent Office under "Typewriter Ribbons," and if anyone is interested in a typewriter ribbon with a backing, that they would do

false marking.

We submit that if these questions are answered as we contend that then it disposes of the whole case.

These are three simple little questions.

THE COURT: It seems to me, though, in accordance with many patent decisions that the Court should decide the validity of the patent first.

MR. HALL: That's right. And the Court of Appeals for the District of Columbia so held.

THE COURT: And other circuits have so held, and that is the holding of the Supreme Court.

MR. HALL: Yes, but if these questions were also decided, and if they are decided the way we suggest, we think it would avoid any possibility whatsoever of any reversal on appeal in the event you did hold for us.

THE COURT: I am going to decide both the issue of validity and the issue of infringement just for that reason.

I believe that it is sound judicial administration for the trial court to try all issues of a case rather than picking out one issue and disposing of it. I recall another patent case in which I decided both the issues of validity and infringement, and I am going to do that here.

MR. HALL: Fine. May I address my remarks to these questions?

THE COURT: Even if they don't admit it, it is obvious that there can be no charge.

However, on the other hand, the defendant has admitted that he did manufacture some ribbons that were not of the plaintiff's material.

How many belong to one class and how many to the other is not to be decided at this trial. If we ever come to the accounting stage, then will come the time to determine how many ribbons were manufactured out of material other than Ploeger's, if there is infringement. In other words, I am not going to determine now how many ribbons go into one group and how many into the other.

MR. HALL: I agree with everything you have said up to now, but I haven't made my point clear.

These thousand ribbons that were made out of non-Ploeger material were made in an entirely different way. As Mr. Farrell testified, they were not made by taking a quarter of an inch of Filmon's material and then trying to adhere a piece of correction material to it. They were made by laying a number of pieces of double width on top of each other and running a knife down through the middle, and these ribbons did not have anything like the same edge treatment that --

THE COURT: But we are dealing with a patent on a

structure, not a patent on a process.

MR. HALL: That's right. But I'm trying to get to the point that these ribbons could not possibly have had this idea that Ploeger claims to have patented where he seals at opposite edges only, because our thing had a single backing, a half-inch wide, with the ribbon attached in the middle, and it was produced by a triple process which caused a triple joining at the middle to create --

THE COURT: The real test, though, as I see it, and I'm sure you concede, is whether the claims of the Ploeger patent read a new structure.

MR. HALL: No, we don't believe they do.

THE COURT: You will concede that that is the test, rather than the method by which it was made?

MR. HALL: Yes, that was the test, and I will concede that the method by which it was made has nothing to do with it, any more than they can attempt to sustain their patent by telling how they cut the edge.

THE COURT: Exactly.

MR. HALL: Exactly. But the reason I was pointing out how they were made was not to give you the final structure so much as to remind you of Mr. Farrell's description, so you would see what came out of this process.

Now, what came out of this process was a ribbon,

he started out with what Ploeger did, and he went on from there. But when we made the thousand experimental ribbons, what we did was quite different. He didn't start out with a piece a quarter of an inch wide and add something to it. He came up with a piece that was solid across the back, and there was no edge there.

THE COURT: The only samples that were introduced in evidence as coming from the defendants' shop were Exhibits 11 and 17, I believe.

MR. HALL: That's right. And we deny 11 but admit 17.

THE COURT: Do you deny that those two exhibits read on Claim 1 of the Ploeger patent?

MR. HALL: I would say it this way: If you read the claim in the normal way, you could read it -- you could read the claim on those two things. But if you try to read into it the invention, the things which they are relying on to try to sustain their patent --

THE COURT: Oh, no. I would like to put those things in separate water-tight compartments. If it were to be assumed that the patent is valid, does not Claim 1 read on Plaintiff's Exhibits 11 and 17?

MR. HALL: Yes, it would read on 11 and 17, because

they are made of Ploeger's material with a --

THE COURT: That is their contention.

MR. HALL: -- with an extra piece that goes off to one side.

THE COURT: The mere fact that there is an extra piece, the correction strip, will not take it out of infringement.

MR. HALL: Because that is put on separately. It is a separate piece, and all that. But the other one wasn't that way.

THE COURT: There was no sample produced by either side of the other structure.

MR. HALL: That's right. And the burden of proof is on them. They've known about these thousand ribbons throughout the entire case. We told them about it at a very early stage of the case. All throughout Mr. Wolowitz's deposition they went over it. They never asked that a sample be produced. They never charged infringement. We asked in interrogatories, Interrogatory 5, asking them to designate the ribbon they charged to infringe. We've been over that time and time and time again in this case as to what it was they charged to infringe.

Now, in answer to Interrogatory 5 they put a piece

here, and starting just below the paper clip you will notice that our ribbon is described. It said at that time the scotch tape went clear across the backing of the ribbon.

(The document was passed to the Court.)

THE COURT: You may proceed.

MR. HALL: So you see at the time that Mr. Kaufman wrote his little printed leaflet, the type of the typewriter never struck the Ploeger material at all. It was completely covered by the scotch tape.

Now, getting to this sheet that I presented to you on Spellright's defenses, I think I've pretty well covered the first two items, and they will go quite fast from here on.

We have now the third item, namely, that there were no sales after the notice of infringement.

You will notice that in the pretrial order there is a stipulation which the Court of Appeals relied on in its decision. In this stipulation --

THE COURT: I want to say this: I don't put too much weight on dicta. The only point that the Court of Appeals passed on was the question of a jury trial.

MR. HALL: You're right.

THE COURT: The rest was dicta.

MR. HALL: You're right.

Now, the Seventh Circuit Court of Appeals has held that in a case where all of the infringement occurred prior to the notice of infringement, and upon getting a notice of the infringement the defendant stopped right there and only a very few articles got out after that time, the case is de minimis and can be dismissed on that basis.

Even the plaintiff in its brief cites a case on de minimis which I think is a hundred per cent applicable here.

THE COURT: I am not going to dismiss this case on the grounds of de minimis. As a matter of fact, I don't think you would want me to do that. You want a decision on the merits.

MR. HALL: You will notice that is my third ground.

THE COURT: Yes.

MR. HALL: Going on down my list of defenses on the false marking, my number one point is that the word "Patented" was used in good faith, and there we rely on the testimony of Mr. Kaufman, Mrs. Jacobs and the other witnesses. You know all that as well as I do, so I won't prolong that.

We go to point two, namely, that they are urging that the only example of false marking that was charged -- and we asked in interrogatories very specifically as to what was charged here -- and the only charge of false marking that has

difference in the world between me requesting J. P. Morgan and Company to give me a million dollars and having them agree to give me a million dollars. So I think that's the point there.

Now, there's one further thing I'd like to bring up on this trade secret cause of action, and that is that the plaintiff, Filmon Corporation, did not own the trade secret at the time of the alleged injury

THE COURT: I am not going to decide this issue or any issue on a technicality like that, Mr. Hall. I don't think that would be satisfactory to either side. I always like to decide cases on their merits if I possibly can. I think that is the better way of administering justice.

MR. HALL: That does conclude my argument, unless Your Honor has some questions.

THE COURT: No.

MR. ROBSON: I will try to be very brief in rebuttal, Your Honor.

THE COURT: Thank you.

MR. ROBSON: I would like to get to the real heart of the case first, the question of the validity of the patent.

With respect to that, I would like to call Your Honor's attention to Your Honor's own decision in the case of General Tire & Rubber Company v. Watson with respect to the

treatment to be accorded a foreign patent and the specificity and clearness required in such a patent. I mention that because I think in view of the concession that Mr. Hall has made in his argument -- or what I interpret as a concession -- which is that the German patent and the Ploeger patent are not identical, and he doesn't claim that the German anticipates, which I understood was the testimony of the witness --

THE COURT: To which witness are you referring?

MR. ROBSON: The expert. I understood his testimony as indicating that the German patent was anticipatory.

THE COURT: I was not quite clear about that. That is why I asked Mr. Hall the question, and he was very definite. He contends that it is prior art, so that the next step taken by Mr. Ploeger was obvious.

MR. ROBSON: In that connection I think certain things must be emphasized. I have mentioned to Your Honor and Mr. Hall has referred to the fact that the German patent talks about a manifold ribbon. In order to be certain that Your Honor realizes the big difference between a manifold ribbon, I would ask Your Honor to look at the diagrams on the Phelps patent, one of the patents that was considered. There you can see that the manifold ribbon functions in a very different fashion from a typewriter ribbon. It is just a

strip that runs along the back of the typewriter which moves with the carriage and which is inserted between the original and the first copy of the paper on which the printing appears. For use in that kind of an embodiment, you need a different kind of ribbon. It's a stiffer ribbon. It's a ribbon in which the ink should not be too profuse, because when the carriage moves the ink would smear onto the second page. So one looking at this, which requires a stiff ribbon, would not be very likely to consider this as a first step in arriving at a pliable typewriter ribbon to be rolled on a spool. They are just two completely different concepts.

The second factor which I mentioned before but really bears emphasis because it is important, the issues have narrowed so considerably, which is that in order for this to be clear -- or clearly referring to the use of two thermoplastics, it is necessary for one reading this patent to ignore the fact that it is a manifold and deals with a tissue which is generally understood to be paper, and deals with a stiff product; to ignore the fact that the word "thermoplastic" is never used to qualify the ribbon, and to ignore the fact that in those embodiments where they do talk about a fusing, which could conceivably bear on ours, they talk about a fusing between a ribbon which is not thermoplastic and a thermoplastic

and has a borderline which makes it a triple thickness instead of double thickness. And this could not conceivably work in a typewriter ribbon. Unless one used ingenuity and invention on his own part, he would not arrive at the point of our invention from that invention.

I think Your Honor has these points. I don't want to labor them further.

I do want to point out a couple of things for the record, just very briefly. And that is that the defendant does not really deny the construction of infringing ribbons. I had the funny feeling, listening to Mr. Hall, that I was the party that had caused somebody else -- when I say "I," I mean my client -- the defendant has admitted constructing infringing ribbons, and only complained about the fact that we have the wrong ribbon in court. The defendant says, "We infringed, we sent out a thousand ribbons, but we didn't find them." They came up with two other ribbons. Which I really think is a peculiar kind of argument to make, particularly in the light of the testimony of two people who examined these ribbons that the ribbons do, in fact, infringe, that they were not made by the plaintiff.

Likewise, the defendant doesn't really deny that these brochures falsely allege that they were patented

construction --

THE COURT: Oh, I don't think you can say "falsely allege." There are all sorts of patents that might perhaps be covered in various parts of this construction. I notice that they do not give the number of any patent. I think that if there is anything de minimis in this case, it is the second corner.

MR. ROBSON: Then I won't labor that point. On the trade secret, I don't think there is much more that has to be said.

I would like to make one thing clear that there has been reference to, although there is no evidence, and that is that the letters which were sent out were sent out almost immediately, they did not threaten anybody with --

THE COURT: I think that those letters should not have been sent out.

MR. ROBSON: All they did was to notify --

THE COURT: The reason that they should not have been sent out at least is the fact that the defendant had a lot of material on hand which he had purchased from the plaintiff, and the use of that material was not an infringement. Letters like this can destroy a person's business faster than a lawsuit.

MR. ROBSON: Your Honor, those letters were sent out immediately after the lawsuit, before we were given any information about material being on hand, and all the letters did was to advise of the institution of the suit. They did not threaten anybody.

THE COURT: Of course, they did not threaten anybody, but that is a way to kill a person's business, because the average business man is a timid person. He will say, "I don't want to get into a lawsuit, I will use somebody else's merchandise."

MR. ROBSON: How else does one protect one's patent?

THE COURT: That is what the courts are for.

MR. ROBSON: The trial today is four years after the infringement.

THE COURT: I did not realize until the defendant was putting on its case -- and I don't think it was brought out before -- that the defendant had on hand a large volume of material that it had previously purchased from the plaintiff at the time that this lawsuit was filed.

MR. ROBSON: But we were not aware of that. That notice was in August, three months after the lawsuit was filed.

THE COURT: Before such letters are sent, a person had better find out. Of course they have nothing to do with the issues of this case, and this is not an action for damages caused by these letters. However, if I were you, I would not try to justify them.

MR. ROBSON: What I would also like to point out to Your Honor was the fact that this defendant threatened, in the presence of two witnesses, one of them an attorney, that he was going to infringe, only a few months before the infringement.

THE COURT: It is very fortunate for the plaintiff that I am not trying the issue as to whether those letters were properly sent. They were not properly sent, after your client sold a large volume of material to the defendant which it should have known could not have all been used up by the time this suit was filed. However, if I were you, I would not refer to this issue any more, because I am not going to decide it. I am just of the opinion that those letters should not have been sent. It was reprehensible, because it is easier to ruin a person's business by sending a series of letters like that than it is by filing a lawsuit against him.

MR. ROBSON: Yet they have done it in every single case almost, Your Honor.

THE COURT: You have to be very careful to find out where you stand before you send such letters. Surely, there are cases in which such letters are proper, but this is not one of those cases.

Is there anything else?

MR. ROBSON: There is nothing else on any of the other issues, Your Honor, no, sir.

THE COURT: Very well.

(REPORTER'S NOTE: The opinion of the Court, given at the conclusion of the arguments, has been previously transcribed. The transcript, consisting of 18 pages, is filed under separate cover.)

- - -

I claim:

1. A ribbon comprising an elongated strip of a flexible, pliable, absorbent material, an elongated strip of a flexible, pliable, impervious material, said strips being in juxtaposed surface-to-surface relation along their entire length, and sealed together along their elongated edges.

2. A ribbon in accordance with Claim 1 in which the strips of material are sealed together only along their elongated edges.

3. A ribbon in accordance with Claim 1 in which an ink is impregnated in the absorbent strip.

4. A ribbon in accordance with Claim 1 in which the impervious strip is substantially thinner than the absorbent strip.

5. A ribbon in accordance with Claim 4 in which the absorbent strip is of a thickness of between .004 and .005 inches, and the impervious strip is of a thickness of between .001 and .002 inches.

6. A ribbon in accordance with Claim 1 in which at least one of the strips is of a fusible material, and the elongated edges of said strips are fused together.

7. A ribbon in accordance with Claim 6 in which the impervious strip is of ^a/fusible material, and the elongated edges of said impervious strip are fused into the elongated edges of the absorbent strip.

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8. A ribbon in accordance with Claim 7 in which the impervious strip is impervious nylon.

9. A ribbon comprising an elongated strip of a flexible, pliable, absorbent material, an elongated strip of a flexible, pliable, impervious material in juxtaposed surface-to-surface relation with said absorbent strip, one of said strips being of a fusible material, said strips being fused together only along their elongated edges, said impervious strip being substantially thinner than said absorbent strip, and an ink impregnated in said absorbent strip.

10. A ribbon in accordance with Claim 9 in which the impervious strip is of a transparent material.

add A'

add B'

7914

IN THE UNITED STATES PATENT OFFICE

In re: Patent application of
Walter Ploeger, Jr.

Serial No. 813,300

Filed: May 14, 1959

For: Printing Ribbon

Div. (17)

AMENDMENT

This is responsive to the Office Action dated September 24, 1959 (Paper No. 3).

Please amend the application, without prejudice, as follows:

Cancel Claims 1 to 10 and rewrite them as follows:

1. ~~A printing ribbon comprising an elongated strip of flexible, pliable, absorbent woven nylon, an elongated strip of a flexible, pliable, ^{imperforate ink} impervious nylon film, said strips being in juxtaposed surface-to-surface relation along their entire length, and fused together only along their ^{extreme} elongated edges, and with the absorbent woven nylon strip being impregnated with ink.~~

12. A ribbon in accordance with Claim 11 in which the impervious nylon film is transparent.

13. A ribbon in accordance with Claim 11 in which the impervious nylon film is substantially thinner than the absorbent strip.

14. A ribbon in accordance with Claim 13 in which the absorbent strip is of a thickness between 0.004 and 0.005 inches, and of the impervious strip is of a thickness between 0.001 and 0.002 inches.

5/15/59

IN THE UNITED STATES PATENT OFFICE

U.S. PATENT OFFICE

In re: Patent application of
Walter Ploeger, Jr.

Serial No. 813,300

Div. 17

Filed: May 14, 1959

For: Printing Ribbon

23 23

Division 17

SUPPLEMENTAL AMENDMENT

Please add the following claim to this application
so that an action on its merits may be rendered on the next Office
Action:

B *C* 2. ~~A~~ A printing ribbon comprising an elongated strip
of flexible, pliable absorbent material which is capable of being
fused to nylon, an elongated strip of a flexible, pliable, imperfor-
ate ^{ink} impervious nylon film, said strips being in juxtaposed surface-
to-surface relation along their entire length, and fused together
only along their ^{extreme} elongated edges, and with the absorbent material
being impregnated with ink.

REMARKS

Claim 15 has been added because there are materials,
as indicated in the specification (first sentence of second paragraph
of page 4) other than nylon which may be fused to the impervious
nylon film, and which may perform satisfactorily in the present
invention.

Accordingly, reconsideration and allowance of each
of the claims now present in the subject application is respectfully
solicited.

Respectfully submitted,

Arthur H. Seidel
ARTHUR H. SEIDEL
Attorney for Applicant

P
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U. S. DEPARTMENT OF COMMERCE

PATENT OFFICE
WASHINGTON

Paper No. 9

Arthur E. Scidol
50 Broad St.
New York 4, N.Y.

Applicant Walter Plooger, Jr.	
Ser. No. 813,300	MAILED FEB 21 1961 FBI DIV 6
Filed May 14, 1959	
For PRINTING RIBBON	

See find below a communication from the
EXAMINER in charge of this application.

Robert C. Weston

Commissioner of Patents

1. Responsive to amendment filed February 9, 1961

2. Claims 11 to 15 are rejected as unpatentable over the teachings of Phelps and the U.S. patent to Francis for reasons of record. The affidavit and samples submitted concurrently with the above amendment have been considered along with the remarks in support of the claims. Since these are products and not method claims, the technique used for adhering the two strips together is not in point. Nor does it matter that the Francis apparatus could not be used, since it is only the disclosure in the patent that nylon film is suitable as the ink impervious strip that is relied upon, along with the teaching that woven nylon may be used (as it is in Murphy et al and the British patent to Francis) as the ink absorbent strip. It is pointed out that fusing two nylon strips together only along their extreme elongated edges as disclosed herein is old, as in Murphy et al, for example.

3. With respect to Mr. Nagy's affidavit, the advantages set forth therein of having the inked ribbon backed by an impervious film are taught by Phelps, who also discusses the disadvantages of having such a film adhered across the entire width of the inked ribbon.

4. The cases cited by applicant have been considered.
It is thought, however, that the facts in this case are such
that the claims fail to define invention over the references.

5. Claims 1 to 10 are cancelled.

6. No claims are allowed.

7. This action is made FINAL.

DK
Exleim:mjp

R. G. Langley
Examiner

IN THE UNITED STATES PATENT OFFICE

U. S. PATENT OFFICE

re: Patent application of
Walter Ploeger, Jr.

Serial No. 813,300

Filed: May 14, 1959

For: Printing Ribbon

APR 26 1961

Div. (17)

DIVISION 17

AMENDMENT

This is in response to the Office Action dated February 21, 1961 (Paper No. 9) in the above-identified application.

Please amend the above-identified application, without prejudice, as follows:

In the Claims:

Claim 11, line 3; Claim 15, line 4, before "impervious" insert -- ink --.

Please cancel Claims 12-14.

REMARKS

Claims 11 and 15 remain in this application. It is respectfully submitted that Claims 11 and 15 patentably distinguish over the art of record.

As a result of an interview with the Examiner, the applicant is submitting herewith an affidavit attesting to the lack of advertising and identifying various letters indicating the commercial success and merits of the present invention. It is well known that commercial success not based on advertising is evidence which must be considered when determining the patentability of the

vention.

However, the applicant does not rely solely on commercial success for patentability. On the contrary, it is the position of the applicant that the claims remaining in this application patentably distinguish over the art of record. In this regard, it is respectfully submitted that the art of record completely lacks the "reservoir" concept of the present invention.

In the final Office Action, the Examiner relied on the patent to Phelps. Phelps discloses four species. In Figures 3 and 4 of Phelps, no provision is made for sealing the elongated side edges of the ribbon. Accordingly, it is only with the hindsight of the present invention that the Examiner is in a position to interpret the Phelps' patent in a manner which is considered anticipatory of the present invention. However, the interpretation of a reference which completely lacks the concept of the present invention is improper when such interpretation is based on hindsight. Accordingly, it is only after the Examiner's eyes have been opened by the applicant's disclosure that the Examiner has interpreted Phelps as providing for a reservoir between the ink impervious film and the ink absorbent fabric.

The patent to Francis completely lacks the concept of the present invention since the film is adhesively secured to the absorbent fabric across the full width thereof. Francis provides for a limited impregnation of the film in the fabric to a depth not exceeding one-fourth of the web thickness (column 6, lines 11-14). In column 5, line 10, Francis makes reference to the fact that the film should not impregnate the web by more than fifteen percent of

the thickness of the web so as to substantially maintain the ink-carrying capacity of the web.

As pointed out in numerous places in the record, the present invention is based on a novel concept in the ribbon art which increases the absorbency of the fabric by at least thirty percent. In this regard, it should be noted that the ink absorbent fabric of the present invention is nylon which is essentially a non-absorbent fabric. (see Claim 11)

In addition to the reservoir provided by a "tray effect", the present invention includes a film welded to the ink absorbent fabric along the extreme edges only thereof so as to maintain the laminated ribbon of the present invention in assembled relationship and simultaneously provide a seal for the reservoir. No reference of record discloses this concept or the elements structurally inter-related in this manner. It is only with the hindsight of the present invention that the Examiner is in a position to build the applicant's invention from references so as to obtain a resultant structure which not disclosed in any of the references nor obvious to a man skilled in the art.

As pointed out in Paper No. 10, the present invention offers many advantages to high speed computers and for the first time provides a printing ribbon which overcomes the disadvantages of ribbons used heretofore in computers. It should be obvious to those skilled in the art that none of the ribbons shown in the art of record solve the problems associated with ribbons used in high speed computers.

As pointed out in numerous places in the record, including affidavits, the ribbon of the present invention has a useful

life which is materially longer than the useful life of the ribbons in the art of record. In addition to eliminating the necessity for cleaning the faces of the type on the equipment using the ribbon of the present invention, the ribbon of the present invention provides a darker and sharper imprint.

The remarks relating to the Francis patent as set forth on page 6 of Paper No. 8 are repeated herewith.


The Examiner's attention is respectfully directed to patents 1,904,628 and 2,163,601 which were brought to the applicant's attention during an oral interview with the Examiner. Each of these patents discloses a film which is secured to the absorbent fabric across the full width thereof in the same manner as Francis. Neither of these patents provides a welded or fused joint along the extreme edges only. Murphy discloses a laminated ribbon fused along the extreme edges only. However, it is to be emphasized that none of these references disclose the reservoir concept of the present invention.

The present invention embodies a novel concept in the art of printing ribbons and advances the art relating to such ribbons. Such a concept embodied in elements structurally inter-related in the manner set forth in the claims is neither obvious to a man skilled in the art nor disclosed in the art of record. It is submitted that the advantages and merits of the present invention as substantiated by the affidavits and letters of record by those skilled in the art is of materially greater significance than a hypothetical combination of references based on hindsight. Accordingly, it is respectfully submitted that the claims remaining in this application patentably distinguish over the art of record.

At an oral interview with the Examiner on April 12, 1961, the Examiner did not make a positive commitment that Claims 11 and 15 are allowable. However, the substance of the present amendment was discussed with the Examiner and he stated that Claims 11 and 15 would probably be allowed. The applicant would like to take this opportunity to extend his appreciation to the Examiner for the courtesies exhibited by the Examiner during said interview.

In view of the above remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, an early notice of allowance is respectfully solicited.

Respectfully submitted,


ARTHUR H. SELDEL
Attorney for Applicant

IN THE UNITED STATES PATENT OFFICE
U.S. PATENT OFFICE

In re: Patent application of
Walter Ploeger, Jr.

APR 26 1961

Serial No. 813,300

DIV. 17 DIVISION 17

Filed: May 14, 1959

For: Printing Ribbon

AFFIDAVIT OF WALTER PLOEGER, JR.

I, Walter Ploeger, Jr., having been duly sworn, depose
and say as follows:

I am the inventor of the ribbon of the above-identified
patent application.

To date, the amount spent by me on advertising the
ribbon of the above-identified application is ZERO. To my knowledge,
no one connected with the ribbon of the above-identified application
has spent any monies whatsoever on advertising said ribbon.

The ribbon of the above-identified application is sold
under the trademark "Film-On".

Exhibit A, attached herewith, is a letter addressed to
the assignee of the above-identified application dated March 22,
1961 from The Schwarzenbach Huber Company. The Schwarzenbach Huber
Company is the largest distributor of typewriter ribbons. This
letter was solicited by me but the content of the letter is entire-
ly the work product of the writer. The ribbon referred to in this
letter is the ribbon of the above-identified application.

Exhibit B, attached herewith, refers to the ribbon of
the above-identified application by identifying it according to the

trademark under which it is sold. This letter was solicited by me but the content of the letter is entirely the work product of the writer.

Exhibit C, attached herewith, is an unsolicited letter. The ribbon referred to in this letter is the ribbon of the above-identified application.

Exhibit D, attached herewith, is a response from the publisher of "Changing Times", the Kiplinger magazine. In the April 1961 issue of this magazine, there is made reference to a new plastic-backed typewriter ribbon under the section "New Products" from the month ahead. This publication was completely unsolicited and is completely the product of the research department of the publisher of this magazine. The publication did not state the manufacturer or distributor of the ribbon. Exhibit D, received from the publisher, identifies the source of the ribbon as the New Era Ribbon and Carbon Company which is a distributor of the ribbon of the present invention. An affidavit of the President of this company is of record.

Further deponent sayeth not.

Walter F. Fieger, Jr.
WALTER FIEGER, JR.

State of *New York* : ss
County of *New York* :

April Sworn to and subscribed before me this *7* day of
1961.

Harold J. Fieger
Notary Public
Jed
NOTARY PUBLIC
NEW YORK STATE

SCHWARTZENBACH COUBIER CO.

SINCE 1829 470 PARK AVENUE SOUTH, NEW YORK 16, NEW YORK, MURRAY HILL 9-7600

March 22, 1961

Mr. William F. Brunner
The Edge-Craft Process Company
653 11th Avenue
New York 36, New York

Dear Bill:

Confirming our many telephone conversations relative to the progress we have made toward establishing "Film-On" as an integral part of the typewriter and machine ribbon business, interest is widespread. Initially, we sampled every ribbon inker known to me and, since the inception of this program, it has been growing rapidly. We have not, of course, scratched the surface due to the newness of the item. As with any completely new concept, we must educate the ultimate consumer before general acceptance is attained. This is being done by a number of reputable ribbon inkers but, as you are well aware, progress in this field is usually a slow process because of their reputed resistance to revolutionary ideas. Ultimately, we should probably do some advertising, but so far we have been highly successful without resorting to this expensive means of selling.

Those organizations with which we have gone beyond the sampling stage and who are beginning to gain its acceptance, are as follows:

Remington Rand
Division of Sperry Rand Corporation
Johnson Street
Middletown, Connecticut

Columbia Carbon & Ribbon Company
Glen Cove, New York

Mittag & Volger
Division of Burroughs Corp.
Park Ridge, New Jersey

Quest Manufacturing Company
220 West Monroe Street
Chicago, Illinois

New Era Ribbon & Carbon Company
1011 Cherry Street
Philadelphia, Pennsylvania

Leadall Products Manufacturing Company
130 Van Liew Avenue
Milltown, New Jersey

54

A

Mr. William F. Connor

Mar 1961

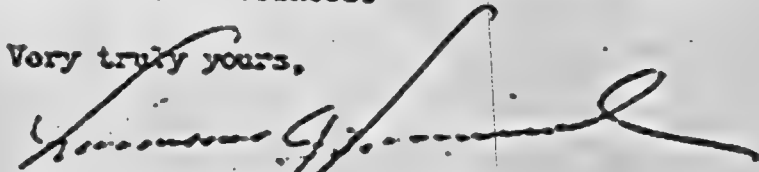
-2-

I might also add, confidentially, that I had a lengthy discussion with the Vice-President and General Manager, and the Vice-President in Charge of Sales of Old Town Corporation recently, in which they expressed the thought of incorporating "Film-On" in their line as their luxury brand of typewriter ribbon. As you know, this would be the beginning of the landslide we ultimately anticipate.

Aside from this, the item is currently proving itself in the addressograph field and in many other applications where the maintenance of clean type is a costly process, not only in salaries, but on down time. Furthermore, this material is lasting longer both from a wear and ink life point of view.

This is truly a good item. You and your organization should be congratulated for this highly unusual contribution to the industry. This is, as you know, a rare occurrence in our business.

Very truly yours,

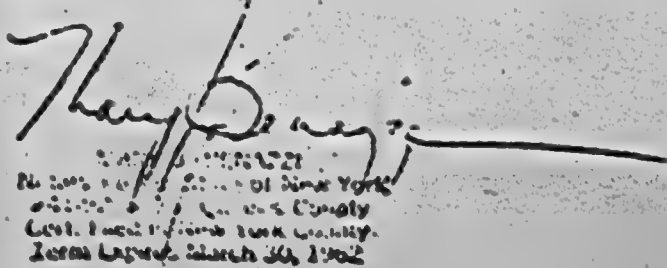


Laurence G. Rommel, Manager
Industrial Fabrics Division

LGH:fa

cc: to of New York
(cc: to of New York)

22nd March 1961



RECEIVED
MAR 22 1961
U.S. DEPT. OF JUSTICE
FEDERAL BUREAU OF INVESTIGATION
WASHINGTON, D.C.

HENRY J. KAUFMAN & ASSOCIATES

INVOICE

Advertising to Public Relations

1111 H STREET, N.W. • WASHINGTON 3, D.C.
 APPLICABLE OFFERS IN MAJOR U.S. & CANADIAN MARKETS
 DISTRICT 7-7400

Spell-Right Corp.
 c/o Mr. W. Wallowitz
 United Typewriter Co.
 813 - 14th Street, N. W.
 Washington, D. C.

March 31, 1962

PROMPT REMITTANCE APPRECIATED — WHEN WE PAY OUR BILLS ON THE 10th WE PAY YOURS

No.	Description	Cost	PAY LAST AMOUNT IN THIS COLUMN
	PREVIOUS BALANCE		
	RADIO-TV ADVERTISING (as per invoice herewith)		
	PUBLICATION SPACE (as per media invoice herewith)		
	SERVICES RENDERED		
068	Material for Stott's Catalog and folders Copy and layouts	<u>\$30 00</u>	\$30 00

PAID
 6/22 #271(C)

C. Sales and Use
 Tax Location: N. S.
 Invoice

HENRY J. KAUFMAN & ASSOCIATES

Advertising & Public Relations

1419 H STREET, N.W. • WASHINGTON 5, D.C.

AFFILIATED OFFICES IN MAJOR U.S. & CANADIAN MARKETS

DISTRICT 7-7400

FILMON ✓
1514-63

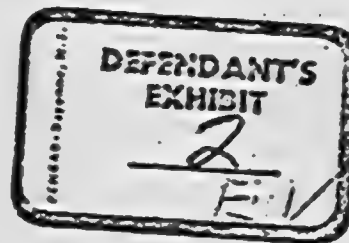
SPELL-RIGHT
INVOICE

September 30, 1961

✓
FILED

DEC 15 1967

ROBERT M. STEINBERG, CLERK



C/o Spell-Right Corp.
Mr. W. Wallowitz
United Typewriter Co.
813 - 14th Street, N.W.
Washington 5, D.C.

PROMPT REMITTANCE APPRECIATED — WHEN WE PAY OUR BILLS ON THE 10th WE PAY YOURS

No.	Description	Cost	PAY LAST AMOUNT IN THIS COLUMN
	PREVIOUS BALANCE		
	RADIO-TV ADVERTISING (as per invoice herewith)		
	PUBLICATION SPACE (as per media invoice herewith)		
	SERVICES RENDERED		
253	Copy and Rough Layout for Instruction Sheet.	20 00	20 00

PAID
10/10/61
120(A)

D. C. Sales Tax
included in this
invoice

hailed by the press

New Typewriter Ribbon Developed That 'Erases' Errors on Originals

Washington — **SPELLright** Corp. has developed a typewriter ribbon that can "erase" errors. The lower half of the new ribbon consists of a special strip of erasing tape incorporating a white chalk that covers up the original mistake.

The typist corrects a mistake by backspacing to the error, shifting the ribbon to the "red" position and retyping the mistake. The key pressure transfers the special chalk substance to the copy paper. The correction is then retyped over the error.

A similar system for correcting errors using perforated sheets of special chalk-coated paper was first introduced in this country 30 months ago by the German firm of Wolfgang Dabish under the trade name "Tipp Ex." A half-dozen U.S. firms now sell similar products under a variety of trade names.

SPELLright has priced its ribbons at \$29.50 a dozen for all model standard and electric typewriters except IBM which is tagged at \$39.50.

The black and erase sections of the ribbon are held together by a clear plastic tape that completely covers the side of the ribbon facing the keys. In addition to holding the sections together, the tape keeps the keys from coming in contact with the ink and getting dirty.

A **SPELLright** spokesman

old **PURCHASING WEEK** that "demand for the new ribbon has already outstripped supply." The company is producing 5,000 ribbons a day and hopes to eventually double production. The firm was set up expressly to manufacture and market the new ribbon and developed the machinery to produce it.

The \$29.50 a dozen **SPELLright** ribbons cost almost five times as much as conventional ribbons, according to industry experts. In addition, the 8-yd. correction ribbon is said to be substantially shorter than others, which may be as long as 18 yds.

Problem Areas

Quality of correction and "what to do about carbons" were pinpointed as potential problem areas for the new concept. The system works well on some surface finishes, doesn't do a good job on others. Carbons still must be corrected by erasing.

Regardless of the method used to apply the correction material—ribbon or sheet—almost all office supply firms say that the concept of correcting mistakes without erasing is catching on. Columbia Carbon & Ribbon reported sales of \$7,000 to \$8,000 a month for its roll form of correction media, while sales at another New York firm were said to be running close to \$20,000 a month.



promoted coast-to-coast

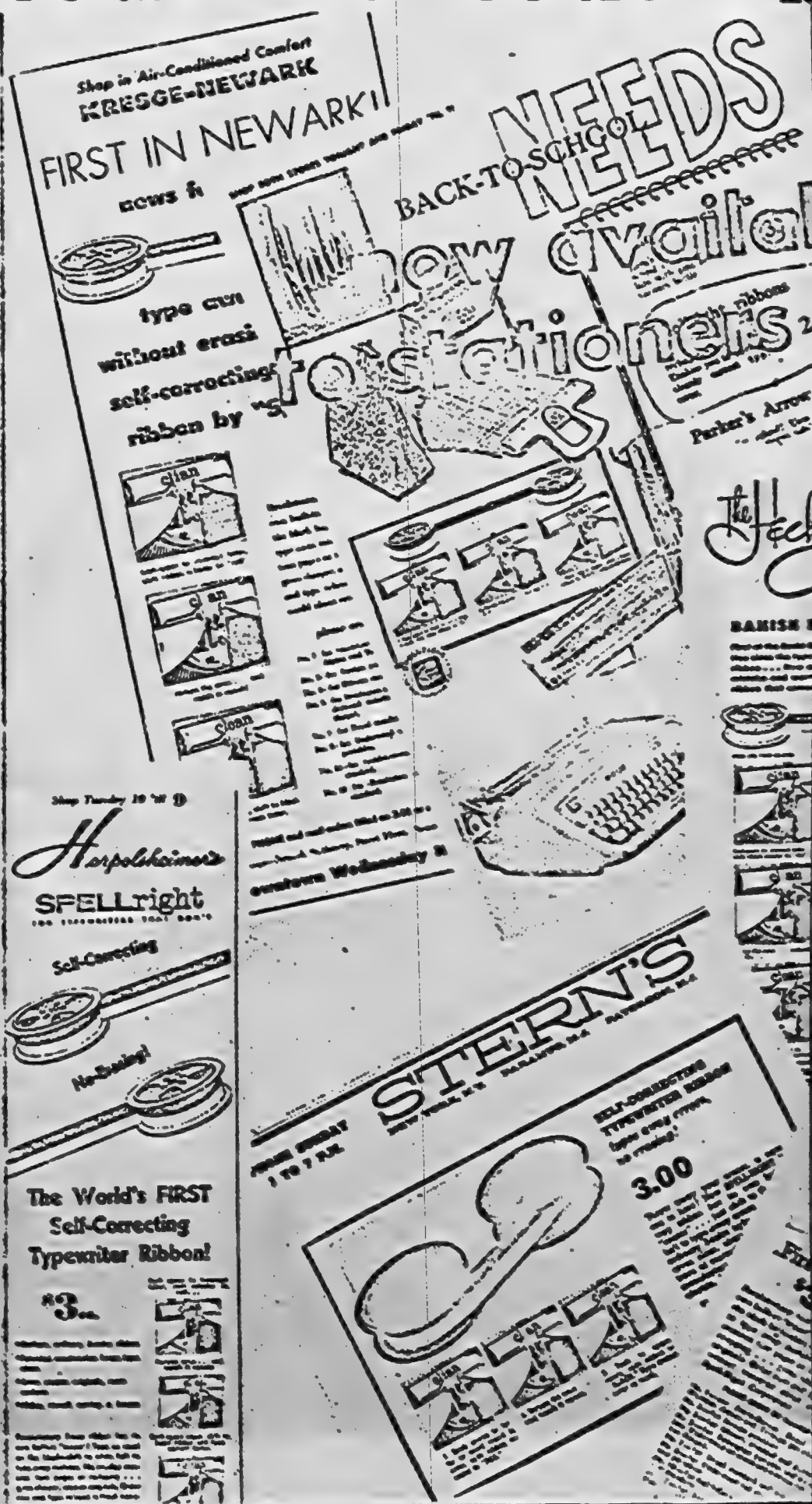
NOW CARRIED BY
MORE THAN
100 DEPARTMENT
STORES!

ONE LEADING STORE
RE-ORDERED
22 TIMES SINCE
MID-SUMMER!

ONE STORE SOLD
325 DOZEN—
SEVERAL STORES
MORE THAN
100 DOZEN!

PHONE AND MAIL
INQUIRIES RECEIVED FROM
ALL OVER THE WORLD!

Shop in Air-Conditioned Comfort
KRESGE-NEWARK
FIRST IN NEWARK!
news & **BACK-TO-SCHOOL NEEDS**
now available
type cut
without erasing
self-correcting
ribbon by **STATIONERS**
Parker's Arrow
The J...
BANISH
STERN'S
SELF-CORRECTING
TYPEWRITER
3.00
The World's FIRST
Self-Correcting
Typewriter Ribbon!
#3

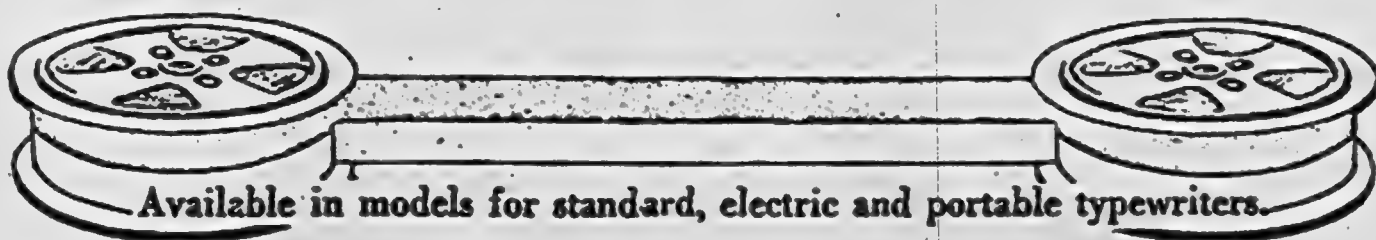


dealers—now you can cash in on

the demand created by these ads!

now available for
immediate delivery to stationers
and office machine dealers!

RETAILS AT \$3⁰⁰



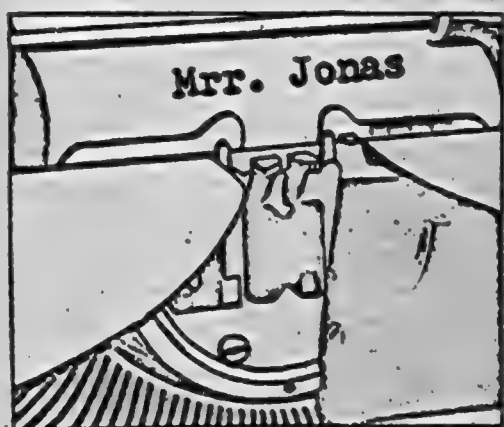
SPELLright Ribbon Style Chart

Name	Number	Name	Number	Name	Number	Name	Number	Name	Number
Adler	1	Faetl	2	Olympic	1	Royal Electric	7	Underwood Portable	8
Alpine	1	Forte	1	Optima	2	Stemas	2	Underwood Standard	8
Aztec	2	Grome	2	R. C. Allen	13	Smith-Corona Standard	10	Und. "150" (double flange)	9
Century	2	Hermes Ambassador	8	Remington Portable	5	Smith-Corona Elec. Std.	10	Und. "150" (no flange)	12
Cole	1	Hermes, all others	1	Remington Standard	12	Smith-Corona Elec. Port.	1	Und. Elec. (no flange)	5
Combine	2	I.B.M., models A & B*	11	Remington Electric	12	Smith-Corona Elec. Port.	1	Und. Elec. (double flange)	4
Diane	2	I.B.M., model C**	6	Remington Noleson	5	Terpede	1	Underwood Noleson	5
Ertke	2	Meteor	1	Rheinstahl	2	Triumph	1	Voss	1
Evered	1	Olivetti	3	Royal Portable	1			Woodstock	13
				Royal Standard	7				

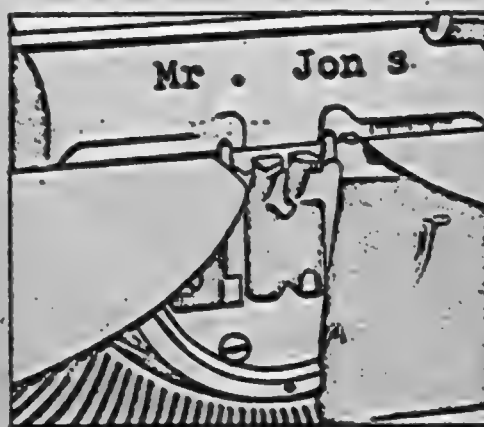
*IBM's with 4, 5, or 6-digits in serial #.

**IBM's with 7-digits in serial #.

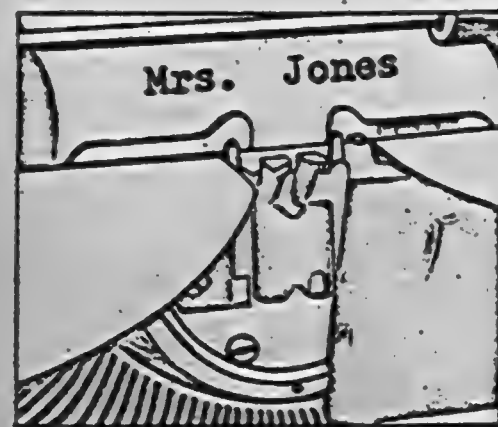
Here's the fastest, cleanest way to correct a typing error:



1. Back space to letter or word typed in error, shift ribbon selector to "RED".



2. Retype the error - - and watch it vanish.



3. Back space again, shift ribbon selector to "BLACK". Type correct letter.

USE THE ENCLOSED ORDER FORM TO ORDER YOUR STOCK TODAY!

DEC 15 1967

SPELLright CORPORATION

Edge-Craft Process Co.

Phone: PLaza 7-4176-7

653-659 ELEVENTH AVENUE

NEW YORK 36, N. Y.

December 18, 1961

Mr. William Wolowitz
Spellright Corporation
813 14th Street, N. W.
Washington 5, D. C.

Dear Mr. Wolowitz:

Enclosed is a sample roll of FILM-ON, fabricated
to give you the ink barrier between the two strips,
as we discussed when you were here.

Needless to say, you will know how to use this
sample to your best advantage.

With best regards, I am,

Very truly yours,

Walter Ploeger, Jr.
Walter Ploeger, Jr.

per EP

WP:ep

Enclosure

NELSON MOORE
WILLIAM D. HALL
ELLIOTT I. POLLOCK
GEORGE VANDE SANDE

LAW OFFICES
MOORE, HALL AND POLLOCK
1200 EIGHTEENTH STREET, N.W.
WASHINGTON 6, D. C.

PATENTS • TRADEMARKS

CABLE ADDRESS "MOORE"

FEDERAL 8-0020

June 27, 1963

Irvin A. Lavine, Esquire
Attorney at Law
801 Washington Building
Washington 5, D. C.

Re: Filmon Process Corp. v. SPELLright

Dear Mr. Lavine:

We would like to invite you and any expert employed by the Plaintiff to see that Defendant SPELLright has at this time still on hand approximately 200,000 yards of the material processed by Filmon and referred to in Paragraph 14 of the Complaint.

If you wish to accept our invitation, please let me know and a convenient time can be arranged.

It will save us all work if you acknowledge receipt of this invitation by signing a copy of this letter and returning the same.

Sincerely yours,



WDH/jw

William D. Hall

Receipt acknowledged June ____, 1963.

Attorney for Filmon Process Corp.

April 3, 1934.

R. A. STARK

1,953,316

TRANSFER ELEMENT

Filed Oct. 14, 1931

Fig. 1.

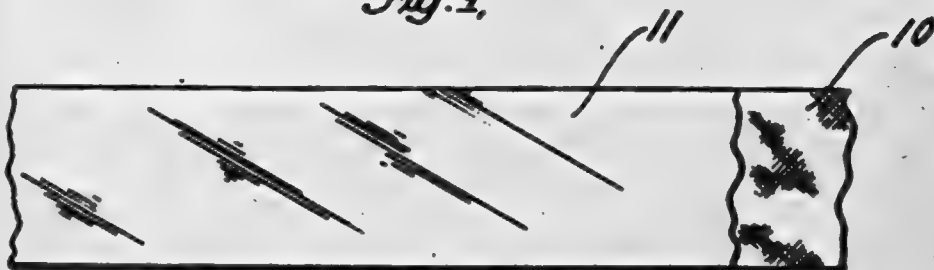


Fig. 2.

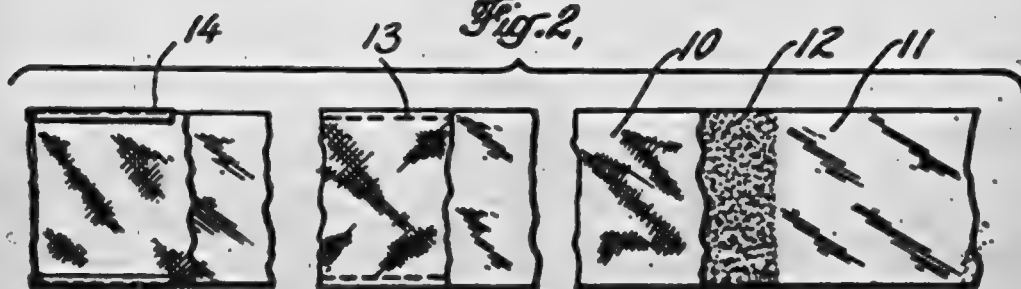
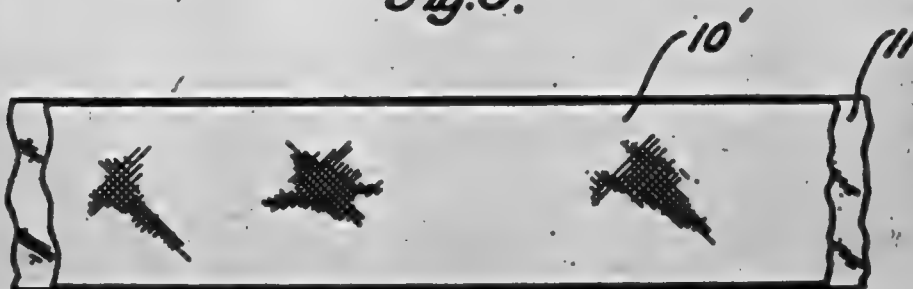


Fig. 3.



INVENTOR
Robert A. Stark
BY
Davis, Davis, Kinnier & Clark
ATTORNEYS

UNITED STATES PATENT OFFICE

1,953,316

TRANSFER ELEMENT

Robert A. Stark, Park Ridge, N. J., assignor to
Mittag & Volger, Incorporated, Park Ridge,
N. J., a corporation of New Jersey

Application October 14, 1931, Serial No. 568,765

3 Claims. (Cl. 197—172)

This invention relates to a transfer element and has particular reference to an element having ink or other transfer material only on one face thereof.

5 Inked ribbons used heretofore for transferring impressions from type or the like to a sheet of paper, frequently clog the type with ink, dirt and thread particles of the ribbon fabric if the type is applied directly to the ribbon, so that
10 the impression made by the type is not clear-cut and the type must be cleaned periodically. Also, if the ribbon is used for transfer purposes between two or more sheets of paper in place of the usual carbon paper, or the like, the back
15 of the sheet to which the type is applied or the surface of the sheets opposite the type sides thereof are smudged by the back of the ribbon so that a clean, clear-cut transfer job devoid of smudges cannot be obtained.

20 The so-called semi-inked ribbon used heretofore and consisting of a fabric ribbon inked only on one side is subject to the same objections outlined in connection with the usual form of fully-inked ribbon, except that the smudging of the
25 backs of the sheets, when the ribbons are used for transfer purposes between the sheets in place of carbon paper, is fainter than is the case with fully inked ribbons, notwithstanding general impressions to the contrary. It has also been pro-
30 posed to coat inked ribbons with an amorphous cellulose material on one or both sides either by applying cellulose solutions directly to the ribbon, or by applying a cellulose sheet, such as cellophane, thereto. While it might be possible
35 to make these cellulose coatings sufficiently dense to render them impervious to the ink on the ribbon, I have found that, at least in so far as a cellophane coating on one side of the ribbon is concerned, it will not produce a perfect arrange-
40 ment for the reason that the cellophane ripples and creeps relatively to the ribbon when the type is applied thereto. Furthermore, probably because of unequal expansion between the ribbon and the cellophane backing, the ribbon does
45 not lie flat but tends to curl at the edges and dish on the cellophane side, so that the ribbon is liable and likely to become misaligned in a transfer machine, such as a typewriter or the like. Also, it is difficult to secure a permanent
50 bond between the cellophane and the fabric, so that it will not loosen after a time and curl away from the fabric.

It is the principal object of this invention to provide an imperviously-backed transfer ele-
55 ment, which overcomes the aforementioned ob-

jection to the former types of inked ribbons and yet is inexpensive and simple to manufacture, readily handled, and extremely effective for transferring sharp, clean and clear-cut impres-
60 sions to a sheet of paper or the like without smudging the back of the front sheet, curling or wearing out rapidly, and which may be used over and over again without material damage or impairment.

In accordance with this object, the preferred
65 embodiment of the new transfer element of this invention comprises a web, ribbon, or sheet of porous material such as woven fabric, fully or partially impregnated with a suitable transfer
70 material, such as type ink, and applied to or having applied to the back or type side thereof a strip or sheet of special paper, which is thin so as not to interfere with the type impression and yet is strong enough to resist pulling or tear-
75 ing forces without rupturing; which is relatively stiff and tough so as to hold the fabric flat against curling and resist creasing or folding and especially puncturing; which is smooth so as
80 to offer little frictional resistance to passing between sheets of paper; which is impervious to the ink or other transfer material in the fabric, even if driven against the fabric by heavy blows
85 of the type; and which is unaffected by atmospheric changes and appears to have the same expansion as the fabric and be unstretchable or stretchable equally with the web so as to adhere
90 firmly thereto and not ripple or creep when struck by the type, whereby the element retains its original smoothness after being used many times.

For a better understanding of this invention, reference is made to the accompanying drawing, in which

Figure 1 illustrates the type or impression side of the new transfer element of this invention, the
95 impervious back of which is shown partially removed to expose the inked web;

Fig. 2 illustrates the transfer side thereof and three ways of securing the inked web and the
100 back together to form the unitary transfer element;

Fig. 3 illustrates a modified form of the new transfer element, in which the impervious back is of greater width or area than the inked web.

In Figs. 1 and 2 of the drawing, numeral 10
105 designates a web of porous material, preferably woven textile fabric or cloth of uniform texture, although it may be simply a porous felted material, or the like, which need not be self-supporting in itself since it is mounted on a self-supporting
110

back in a manner to be described. This web 10 is illustrated as being in ribbon or tape form, for transferring only one or a few lines of type impressions at a time to a paper sheet or the like, but it may be of any size or shape, such as of sheet or page size for transferring a greater number of lines or widely spaced lines of type impressions at a time to a paper sheet or the like, being usable instead of the usual sheet of carbon paper, for example.

The web 10 is fully impregnated with ink or other transfer material, or is semi-impregnated or coated with ink or other transfer material only on one surface, preferably before it is provided with the impervious back, although the inking of the web may be done after the backing step, especially when the web is made of the felted or other substantially non-self-supporting porous material described.

The impervious backing sheet or strip 11 of the web is made of a special paper, which is tough, strong, comparatively smooth, semi-transparent, relatively stiff, and impervious to the ink or other transfer material in or on the web or ribbon 10. The paper of which the backing sheet or strip 11 is made is manufactured from a hydrated pulp containing an excessive quantity of sulphite, and this pulp is given an additional beating to make it homogeneous, so that when it is calendered, it becomes a semi-transparent, artificial parchment, which is smooth and crackles and appears to have been treated with wax, paraffin or oil, although no such materials, which would tend to prevent permanent gluing to the web 10, are employed. The backing sheet 11 is accordingly substantially non-porous, i. e., there are no through or connecting pores of sufficient size to admit the ink or transfer material, either when the latter is forced against the sheet by heavy blows of the type or by capillary action.

The backing sheet 11 is applied to the web or ribbon 10, or vice versa, with a suitable adhesive or glue, and the web or ribbon 10 and the backing sheet 11 are pressed or rolled firmly together. This adhesive or glue, designated 12 in Fig. 2, preferably comprises a mixture of gum-arabic, dextrin and glycerin. If the web or ribbon 10 is semi-inked or coated with the transfer material on one surface, the backing sheet 11, is, of course, applied to the uninked surface thereof. Also the web or ribbon may be inked or coated with transfer material after the backing sheet 11 is applied thereto if desired, as aforementioned. Instead of securing the web or ribbon 10 and the backing sheet 11 together with an adhesive, they may be stitched together along their edges as indicated at 13 or clamped together along their edges with the metal clips 14, also shown in Fig. 2. These metal clips 14 are V-shaped in section when open and are slipped over the edges of the superimposed ribbon and backing sheet and flattened to clamp the ribbon and backing sheet together. These clips 14 also serve to stiffen the transfer elements.

It will be seen that the web or ribbon 10 and the backing sheet 11, so joined together, adhere permanently to form a unitary transfer element. The web or ribbon 10 and the backing sheet 11 appear to have substantially the same degree of elasticity so that they stretch or expand substantially equally and not relatively to each other, and so do not creep, or ripple relatively to each other, but remain flat and smooth at all

times under the severest usage and changing weather conditions, so that the new inked ribbon remains effective and may be used over and over again. The backing sheet 11 is relatively stiff so that it lends body to the web or ribbon 10, whereby it permanently holds its flat shape, resists creasing and, because of its toughness and strength, resists tearing and puncturing. Because the backing sheet 11 overlies the ribbon or web, the type is not clogged with ink, dirt or thread particles if applied directly to the ribbon and so the type remains clean and produces a sharp clear-cut impression at all times. Likewise, the backing strip 11 also prevents the new transfer element from smudging the back of the front sheet or page or sheets or pages if placed between sheets or pages instead of the usual carbon paper, and, because of its smoothness and anti-friction properties, the backing sheet does not cling to the front sheet.

In Figs. 1 and 2 the web or ribbon 10 and the backing sheet 11 are illustrated as entirely co-extensive. The modified form of Fig. 3 illustrates a backing sheet 11' having a greater area or width than the web or ribbon 10', so that the opposite edges of the backing sheet 11' extend beyond the corresponding edges of the web or ribbon 10'. With this arrangement, the edges of the web or ribbon 10' are protected against fraying or undue wear, and are prevented from spreading so that a uniform density of ribbon and ink is maintained. This modified form of the transfer element also has the same advantages of the first form illustrated by Figs. 1 and 2.

The new transfer element of this invention may be supplied in any size and shape, such as in ribbon, tape, band, sheet, or other forms, and, following the arrangement shown in Fig. 3, the backing sheet 11' may be larger than the web 10' to any desirable degree, such as a large backing sheet 11 of page size having one or more small webs 10' secured at various points thereon for tabulating purposes, for example, this arrangement being more durable and usable longer than the usual carbon-spotted forms or transfer sheets, since the backing sheet 11' is more durable and the web 10' holds more transfer material than the carbon spots can supply.

Various other arrangements and modifications of this invention lie within its scope and it is to be understood that the invention is not limited by the preferred embodiments illustrated and described herein.

I claim:

1. In a transfer element, the combination of a porous web at least partially impregnated with ink, a sheet of material impervious to the ink secured coextensively to one surface of said web, said sheet and web having substantially the same degree of elasticity.

2. In a transfer element, the combination of a porous web at least partially impregnated with ink, and a sheet of artificial parchment secured coextensively to one surface of said web and having substantially the same degree of elasticity as the web.

3. In a transfer element, the combination of a porous web at least partially impregnated with ink, and a sheet of impervious material overlying one surface of said web and having substantially the same degree of expansion as the web.

ROBERT A. STARK.

June 16, 1936.

J. PHELPS

2,044,630

MANIPOLD INKING RIBBON

Filed Feb. 2, 1932

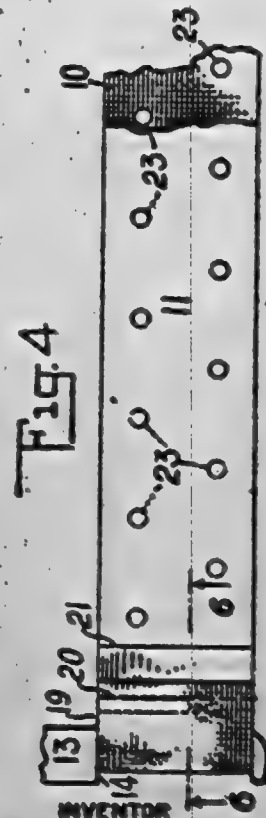
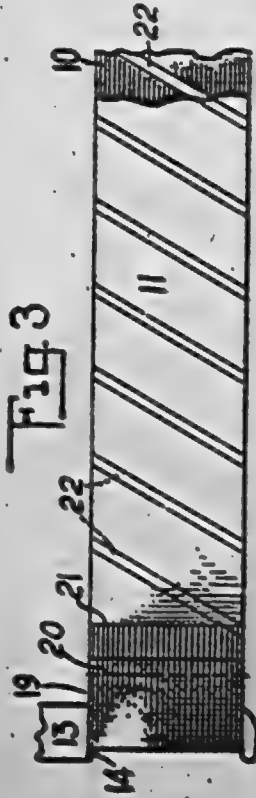
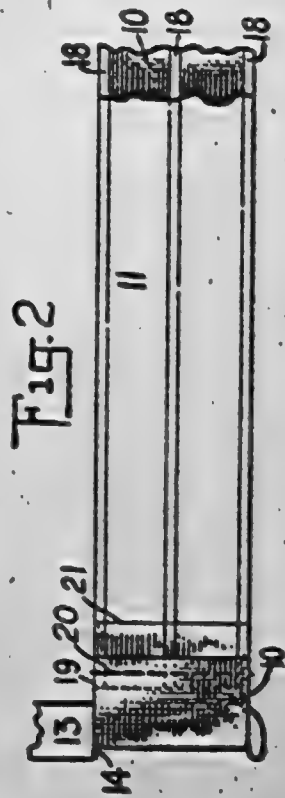
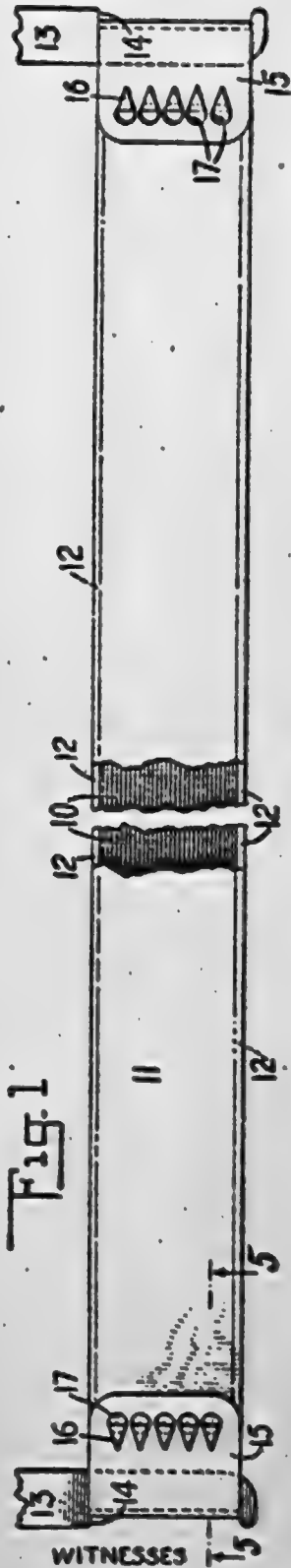


Fig. 5

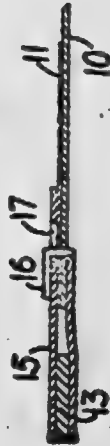
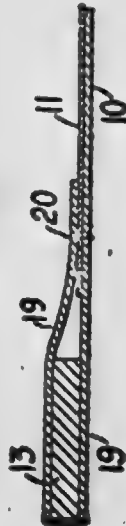


Fig. 6



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2,044,630

MANIFOLD INKING RIBBON

Joseph Phelps, Stamford, Conn., assignor to
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corporation of New York

Application February 2, 1932, Serial No. 590,292

6 Claims. (Cl. 197-172)

My invention relates to manifold inking ribbons for typewriting and like machines, such ribbon being interleaved between two work sheets to produce a manifold copy on the underlying sheet without producing an offset or imprint from such ribbon on the outermost sheet that receives its imprint from the ordinary inking ribbon of the typewriting or like machine.

The main object of my invention is to provide an improved manifold ribbon which is simple in construction, is comparatively inexpensive to manufacture, is highly efficient in use and may be used effectively to give clearer copies for a longer period than other manifold ribbons.

To the above and other ends which will hereinafter appear my invention consists in a manifold ribbon of the character hereinafter described and particularly pointed out in the appended claims.

Heretofore it has been customary in making manifold ribbons to coat the inking ribbon on one side with a non-permeable compound to prevent the ink from seeping through to the front face of the ribbon.

It also has been customary to cause an impermeable shielding strip to adhere to the front face of the inking ribbon throughout the entire extent of the shielding strip.

The result in both the above mentioned instances is to materially reduce the effectiveness of and to produce an unsatisfactory ribbon. It results in causing a "spread" or blurred imprint in a manifold copy; not giving a clear, sharply defined outline of each character written. Such ribbons also fail on repeated impacts of the types to give up the required quantities of ink for the production of good manifold copies, thus very materially reducing the life of the ribbon and rendering it useless for the production of clear manifold copies after it has been used only a few times.

The first mentioned of these disadvantages probably is due to the fact that the impermeable coating, or the adhesive by which the shielding strip is caused to adhere to the inked ribbon, hardens and prevents a clear definition of the outline of each character written; carrying a greater extent of ribbon at each impact against the paper than is necessary and causing a "spread" or imperfectly defined or blurred imprint. The second of the above mentioned disadvantages probably is due to the fact that the impermeable coating, or the adhesive by which the shielding strip is caused to adhere to the inked ribbon, reduces or partly destroys the capillary qualities of the inking ribbon and prevents the ink from readily

flowing or passing from one portion thereof to another so that the ink from an unstruck part of the ribbon cannot readily pass to and replace the ink removed therefrom at adjacent points which receive the impacts of the types. Moreover, it has been found that such manifold ribbons very soon dry out and become worthless even when not in use, probably by reason of the reduced ink carrying capacity of the inking ribbon due to the coating of ink repellent compound or the adhesive by which the shielding strip is caused to adhere throughout its extent to the ribbon.

I discovered that by causing the soft, pliable shielding strip of cellophane to adhere to the ribbon at intervals only, instead of over the entire surface of the shielding strip, all of the above mentioned difficulties are overcome, and a manifold ribbon is produced that is far superior in every respect to that having the shielding strip adhering throughout the entire extent thereof to the ribbon, or in which the ribbon is coated with an impermeable compound. The new ribbon of my invention gives far clearer or better defined imprints than the old during a far greater period of use; more than doubling the life of the ribbon, and the ribbon does not dry out so rapidly during non-use.

In the accompanying drawing I have shown several different forms of construction embodying my invention.

In the drawing—

Fig. 1 is an enlarged, detail, front face view of one form of duplicating ribbon embodying my invention; the view showing a portion of the shielding strip broken away to expose the inking ribbon, the duplicating ribbon as a whole being shown supported on arms of a frame carried by the carriage of a typewriting or like machine.

Figs. 2, 3 and 4 are similar views of modified forms of duplicating ribbons, each view showing but one half of the ribbon.

Fig. 5 is an enlarged, detail, sectional view of my preferred form of ribbon taken on the line 5-5 of Fig. 1 and looking in the direction of the arrows at said line.

Fig. 6 is an enlarged, detail, sectional view of a modified form of ribbon taken on the line 6-6 of Fig. 4 and looking in the direction of the arrows at said line.

The textile ink carrying ribbon, which may be of the usual or any suitable character, is designated in each instance by the reference numeral 10, whereas the separate shielding strip is indicated in each instance by the reference numeral 11. For the shielding strip I prefer

to use "cellophane" or some such equivalent impermeable, smooth surfaced, soft moisture and ink repelling substance devoid of any grain. In practice I have found that "cellophane" of slightly more than .001 of an inch in thickness or about one fifth the thickness of the inking ribbon, answers the purpose very well. When such a strip is attached to the ribbon only at intervals, and is not caused to adhere thereto throughout its entire extent, it aids materially in the production of clear cut, sharply defined, manifold imprints that are free from the "spread" or blur and imperfections produced with manifold ribbons in which a different character of shielding strip, and one which adheres to the ribbon throughout the entire extent thereof, is employed. In fact it has been found in practice that when the same character of shielding strip and the same character of ribbon is employed in both instances, but in one instance the shielding strip is caused to adhere throughout the entire extent thereof to the ribbon, whereas in the other instance the shielding strip is caused to adhere to the ribbon only at intervals as shown in the drawing, far superior results are obtained by the last mentioned ribbon; clearer and sharply defined imprints and a freedom from "spread" being attained, and the life of the ribbon being more than doubled.

In the manifold ribbon shown in Figs. 1 and 5 the extreme edges only of the shielding strip 11 are attached to the inking ribbon 10 by lines of adhesive material indicated at 12, leaving the entire intermediate portion of the shielding strip free from attachment to the ribbon. I regard this form of construction the most preferable since the types never impact against those portions of the ribbon where the parts 10 and 11 are united by the adhesive material and the edges of the parts 10 and 11 are firmly united and may be readily interleaved between the work sheets without affording an opportunity for the edges of the work sheets, or either of them, to pass between the shielding strip 11 and the inking ribbon 10.

Any suitable means may be provided at the ends of the manifold ribbon for detachably connecting it to the supporting means therefor. Said supporting means are represented in the present instance by arms 13 which are notched at 14 to receive the connecting devices or means at the ends of the ribbon and form part of a supporting frame detachably connected to the carriage of a typewriting or like machine.

In the construction illustrated in Figs. 1 and 5 the attaching means at the ends of the ribbon are in the nature of metal clips 15 each bent on itself into substantially U shaped formation and providing a looped portion at the outer end in which one of the arms 13 is received. One of the arms of each clip 15 is provided with a series of tines 16 adapted to be received through openings 17 in the other arm of the clip and to be bent or folded over into an engaging and clamping position, as shown in Figs. 1 and 5, after the tines have passed through the ribbon 10 and shielding strip 11 received between the two arms of the clip and clamped between them.

In the construction shown in Figs. 2 and 6 the shielding strip 11 is caused to adhere to the inking ribbon 10 by three parallel stripes of adhesive material 18, two of such stripes being provided at the edges of the ribbon as in the construction shown in Fig. 1, and the single inter-

mediate stripe being disposed lengthwise at the center of the ribbon.

In this construction I have shown the inking ribbon bent into the form of a loop at its outer ends as indicated at 19 to receive the supporting arms 13. The textile fabric of the ribbon at each looped end thereof overlaps the shielding strip 11 and a line of stitches, indicated at 20, unites the two layers of ribbon and the intermediate shielding strip. I prefer in this form of construction after opening the loops at the ends of the ribbon, to dip them in a fluid, say, to the depth indicated by the line 21. This fluid compound or solution in which the ends of the ribbon may be dipped is preferably a paint like substance of collodion or lacquer or some such suitable material that forms a coating on the outer looped ends of the ribbon which is impermeable when dry and constitutes a protection that prevents the operator's fingers from being smeared by the ink of the ribbon in placing it on and removing it from the supporting arms. Any suitable substance may be employed for this purpose. One of the advantages of this form of loop over the metal clip is that there is less liability of injury to the work sheets and type faces from the use thereof.

The construction shown in Fig. 3 is similar to that represented in Fig. 2 except that the stripes of adhesive by which the shielding strip 11 is secured to the ink ribbon 10 is in the form of narrow diagonal stripes 22 that extend from edge to edge of the ribbon.

The construction shown in Fig. 4 is similar to that shown in Figs. 2 and 3 except that the adhesive material 23 by which the shielding strip 11 is attached to the inking ribbon 10 is arranged in spots situated at widely separated intervals only throughout the length and width of the ribbon.

It will be understood that while the use of "cellophane" as a shielding strip in connection with an inking ribbon of textile fabric results in the two strips having different qualities from the point of view of their capability of stretching, the connection at intervals between the inking ribbon and shielding strip nevertheless unites them and maintains them sufficiently united for the purposes for which the manifold ribbons are used without appreciably detracting from the qualities and effectiveness of the inking ribbon to produce clearly defined manifold copies and without detracting from the substantially full capacity of the ink containing and capillary qualities of the inking ribbon.

It will be understood, moreover, that the freedom of the "cellophane", or an equivalent material, from all grain provides against any possibility of the transmission of any grain through the ribbon on the impact of the type in the production of the manifold copies. It has been found in practice that even a thin "laid" paper used as a shielding medium may transmit its "grain" through the ribbon and reduce the clearness of the manifold imprints and show the "grain" of the paper on the manifold copies. It will be understood, therefore, that in the use of material such as "cellophane" there is a complete freedom from any such grain or the transmission thereof to the manifold imprints.

Of course, by attaching the shielding strip to the inking ribbon in the manner described, the two are sufficiently united to make them in ef-

fect one part that may be readily introduced between the work sheets with which they co-act.

What I claim as new and desire to secure by Letters Patent is:

5 1. A manifolding ribbon comprising an inking ribbon, and a shielding strip attached thereto only at intervals throughout the extent of the shielding strip, said inking ribbon being folded on itself at the ends thereof and attached to the
10 body portion of the inking ribbon and over the intervening shielding strip thus forming loops by which the manifold ribbon may be detachably connected to its supporting means.

2. A manifolding ribbon comprising an inking
15 ribbon, a shielding strip attached thereto only at intervals throughout the extent of the shielding strip, said inking ribbon being folded on itself at the ends thereof and attached to the body portion of the inking ribbon and over the inter-
20 vening shielding strip thus forming loops by which the manifold ribbon may be detachably connected to its supporting means, said looped ends of the ribbon being coated with a moisture and ink repelling substance so as to protect the
25 hands of the operator from being smeared with ink in attaching the manifold ribbon to or removing it from its support.

3. A two ply manifolding ribbon for typewriting and like machines for use in interleaved relation between two work sheets to produce a
30 manifold copy on the underlying work sheet without producing an off-set or imprint from such ribbon on the outermost work sheet that receives its imprint from the ordinary inking ribbon of the typewriting or like machine, said manifold-
35 ing ribbon comprising an inking ribbon, and a shielding strip to prevent back printing on the overlying work sheet, said shielding strip being attached to the inking ribbon with an adhesive
40 only along the edges of said shielding strip.

4. A two ply manifolding ribbon for typewriting and like machines for use in interleaved relation between two work sheets to produce a manifold copy on the underlying work sheet with-

out producing an off-set or imprint from such ribbon on the outermost work sheet that receives its imprint from the ordinary inking ribbon of the typewriting or like machine, said manifold-
5 ing ribbon comprising an inking ribbon, and a shielding strip to prevent back printing on the overlying work sheet, said shielding strip being attached to the inking ribbon with narrow diagonal stripes of adhesive material that extend from edge to edge of the shielding strip. 10

5. A two ply manifolding ribbon for typewriting and like machines for use in interleaved relation between two work sheets to produce a manifold copy on the underlying work sheet without producing an off-set or imprint from such
15 ribbon on the outermost work sheet that receives its imprint from the ordinary inking ribbon of the typewriting or like machine, said manifold- ing ribbon comprising an inking ribbon, and a shielding strip of cellophane to prevent back print-
20 ing on the overlying work sheet, said shielding strip being attached to the inking ribbon with the aid of an adhesive material that extends along the edges only of the inking ribbon and shielding strip and unites them only at such points. 25

6. A two ply manifolding ribbon for typewriting and like machines for use in interleaved relation between two work sheets to produce a manifold copy on the underlying work sheet without producing an off-set or imprint from such
30 ribbon on the outermost work sheet that receives its imprint from the ordinary inking ribbon of the typewriting or like machine, said manifold- ing ribbon comprising an inking ribbon, and a shielding strip to prevent back printing on the
35 overlying work sheet, said shielding strip being attached to the inking ribbon by an adhesive only at intervals throughout the extent of the shielding strip, said shielding strip being made of relatively thin cellophane approximately one fifth the
40 thickness of the inking ribbon, and being smooth and free from grain and repelling moisture and ink.

JOSEPH PHELPS.

Oct. 27, 1953

C. S. FRANCIS, JR

2,657,157

INK TRANSFER ELEMENT

Filed June 2, 1950

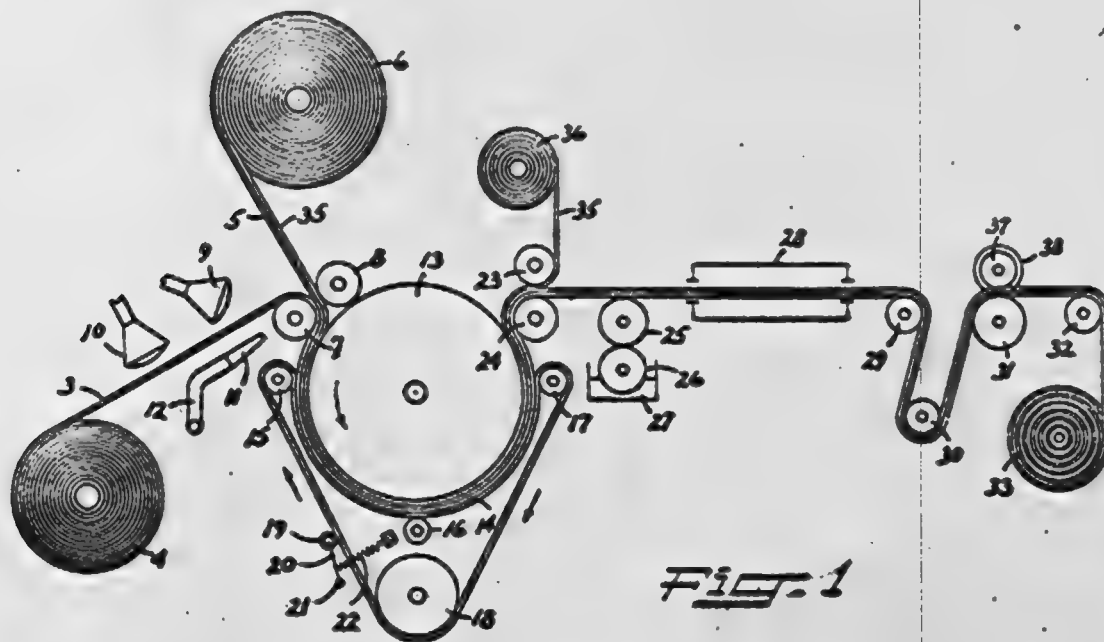


Fig. 1

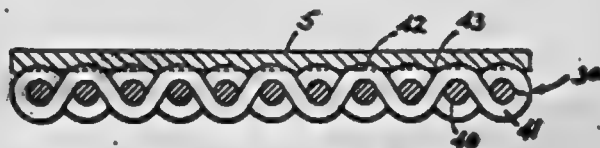


Fig. 2



Fig. 3

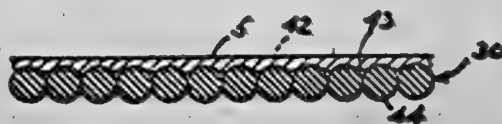


Fig. 4

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BY

Thomas R. Kelly

ATTORNEY.

UNITED STATES PATENT OFFICE

2,657,157

INK TRANSFER ELEMENT

Carleton S. Francis, Jr., West Harwich, Mass.,
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mington, Del., a corporation of Delaware

Application June 2, 1950, Serial No. 165,856

6 Claims. (Cl. 154—46.8)

1

This invention relates to typewriter transfer elements and in particular to a transfer element of this type provided with an impervious backing film.

Various expedients have been tried in an attempt to provide typewriter ribbons which when struck by the type face would not liberate ink, dust, or fiber particles which become lodged in the recesses of the type face and by accumulation build up so as to fill the recesses and blur the typed impressions. The coating procedures heretofore practiced have, however, the disadvantages that the impregnation of the ribbon cannot be adequately controlled, and a smooth plane in the rear of the coating cannot be obtained for several reasons. When a thin coating medium is employed, the impregnation is excessive and the ribbon is virtually completely impregnated by the entire substance of the film so that the back face of the film is for practical purposes the same as the back face of the ribbon and has the same irregularities. When a higher viscosity of coating is employed, the fine fibers projecting from the yarns in the back face of the ribbon tend to prevent impregnation to any extent whatsoever so that the coating has an irregular contour as determined by the roughness of the back face of the ribbon and yet has inadequate adherence. If pressure is employed to increase impregnation, the result is the same as if a thin low viscosity impregnating medium had been used. These faults of coating procedures result in several faults in the product. In the first place, the ribbon is so deeply impregnated by the low viscosity coating that its capacity for ink or other printing medium is seriously impaired. On the other hand, where a high viscosity is applied, the adherence is inadequate. In all cases, the back face of the coating has roughly the same irregularities as the back face of the ribbon. This results in severe indentation of the coating by the type face wherever the high points of the coating occur, thereby decreasing the durability of the product.

In accordance with the present invention, these disadvantages are overcome by the application of a thin pre-formed film to one face of the transfer element in such a manner as to preserve the smoothness of the rear face of the film and to obtain adequate adhesion by the substance of the film itself without excessive impregnation of the fibrous ink-receiving web. These and other objects and advantages of the present invention will be apparent from the

2

In the drawing, illustrative of the invention:

Figure 1 is a diagrammatic side elevation of one system adapted to produce the transfer elements of the invention.

Figure 2 is a transverse section through a transfer element of the invention.

Figure 3 is a transverse section through a modification, and

Figure 4 is a transverse section through another modification.

In general, a thin, tough, flexible, pre-formed thermoplastic film is placed in contact with the face of a fibrous web and the film is subjected to heat and pressure sufficient to render the film tacky and to adhere the film to the fibrous web. If desired, the film may be preheated and immediately after such preheating, the film is placed in contact with the web and the two are pressed together to cause the bonding by impregnation of the substance of the film at its surface into the adjoining surface fibers of the web. The pressure upon the assembled structure is exerted by a smooth-surfaced element, such as a heated roll against which the assembled structure is pressed by a belt so as to preserve the plane surface at the back of the pre-formed film. The assembly is then cooled after which the porous web is impregnated with ink and dried. In some cases the web may be inked before the adhesion of film to the web.

The preformed film may be made of any thermoplastic film-forming material such as synthetic resins, for example, polyvinyl resins such as polyvinyl chloride, polyvinyl acetate and the like; polystyrene, polymerized hydrocarbons such as polyisobutylene; copolymers, such as copolymers of vinyl halides and vinyl esters, vinyl derivatives and acrylonitriles, vinyl derivatives and styrene derivatives, acrylic acid esters of aliphatic and aryl alcohols. Thermoplastic cellulose derivatives may also be employed as the film-forming material such, for example, as cellulose esters of the higher fatty acids, such as cellulose stearate, cellulose palmitate, cellulose acetobutyrate; alkyl and aryl cellulose ethers of high degree of substitution, such as ethyl cellulose and the like. The following may also be used: sulfonamide-aldehyde resins; rubber hydrohalides; sulfur-olefin resins; cumarone resin; indene resin; condensation polymers such as the condensation products formed from di-basic acids and di-amines (nylon type), and polyhydric alcohols and polybasic acids; chlorinated biphenyls, as well as natural and synthetic gums and

tioned materials. Materials which are not inherently thermoplastic such, for example, as cellulose acetate, cellulose nitrate and the like, may be mixed in such proportions with inherently thermoplastic materials that the resulting mixture will be inherently thermoplastic and used in the practice of the present invention.

The fibrous webs which may be used in making the transfer element may be in the form of a woven fabric, such as the fine silk ribbons commonly employed or they may be formed of thin non-woven fabrics of felt-like or paper-like character. Besides woven and felt-like or paper-like webs, the fibrous web may comprise a simple warp sheet of twisted yarns. The woven or non-woven fabric may comprise fibers of paper making length or textile making length and a small proportion thereof may be inherently thermoplastic to provide autogenous bonds between the thermoplastic film and the fibrous web. When the non-woven web contains potentially adhesive fibers of this character, they may be formed of any of the materials listed above from which the preformed film may be formed, and the thermoplastic fibers in the web may be made from the same or different material as that of the preformed film.

The fibrous web may have any thickness from about 0.002 to 0.02 inch thickness, a common thickness for a woven ribbon being 0.015 to 0.020 inch. The preformed film is very thin and may have any dimension from 0.0005 to 0.002 inch.

The preformed film may be applied directly to the fibrous web if it is of sufficient thickness to be handled without distortion. However, with the thinner films, the films are first formed upon a temporary backing with which they may be transferred or applied to the fibrous web after which the temporary backing is stripped from them. This is also preferable with films of greater thickness within the range desired for the present invention.

Accordingly, the preferred procedure is to form the films upon a temporary backing which has little or no affinity for the thermoplastic material used in making the film. Such backing should not be affected by such solvents or plasticizers as are used in the casting of the film upon its surface. Examples of suitable materials are regenerated cellulose, metal foil, and thin sheets of infusible resins. Besides these materials of general applicability, cellulose esters, such as cellulose acetate and cellulose nitrate sheets may be employed for certain of the resins provided the solvents and plasticizers used for the resins do not affect the esters.

The preformed thermoplastic film may contain a pigment, dyestuff, or other filler to impart any degree of coloring or opacity desired since the striking action of the type characters cannot liberate such particulate material from the body of the film. For the maximum strength and toughness, however, it is preferred to omit any pigment, filler, or particulate material having a character such that it is not fused into the body of the film-forming material.

In Figure 1, a system is shown for producing transfer elements in which the fibrous web 3, such as a woven or non-woven web, in this case un-inked, proceeds from a supply roll 4 and a preformed film 5 proceeds from a supply roll 6 into the nip between a pair of rolls 7 and 8 where they are pressed together in the desired registry after their opposed faces have been preheated as by infra-red ray lamps 9 and 10. These lamps

are suitably disposed to preheat the surface of the film 5 to the desired temperature in the vicinity of its tacky point, just before the web contacts it in the nip between rolls 7 and 8. The lamps are also arranged to heat the opposed surface of the fibrous web 3 at least to the tacky temperature and within a few degrees above it. To prevent the roll 7 from becoming too hot, it may be cooled as by a blast of air extending axially of the roll across its entire width by means of nozzle 11 discharging from a cold air supply duct 12. The laminar structure immediately passes about a roll 13 which is internally heated, and pressure is exerted against the laminar structure by a continuous belt 14 carried about the structure on drum 13 under the guidance of rolls 15, 16, and 17. The heat and pressure on the laminar structure are sufficient to render the film tacky and to adhere the film to the fibrous web. The belt may be driven by means of roll 18 and tensioned by roll 19 rotatably mounted in arms 20 pivotally mounted at 21 and urged against the belt by means of spring 22. As the laminar structure leaves the drum 13, it passes between rolls 23 and 24 and over the ink-applying rolls 25 and 26. The fibrous web receives the layer of ink carried by roll 25 from roll 26 which runs in the supply bath 27. After inking, the laminar structure passes through a dryer housing 28 to remove volatile solvent. From the dryer, it passes over roll 29, tension roll 30, and over rolls 31 and 32 to a take-up at 33.

When the preformed film is carried on a temporary backing or support 35, the roll 6 delivers such backed film which proceeds through the normal course until roll 23 which may be internally cooled is reached. Instead of a cooling roller, a blast of cold air may be applied to the structure. At this point, after the structure is cooled, the backing 35 is stripped and rewound on a take-up device 36.

The system may be applied to fibrous webs and preformed films of any width. These widths may correspond to the final width of the transfer element or they may be much wider such as anywhere from 2 to 6 feet depending on the width of the fabric produced in the loom or the web-forming device used to produce the woven or non-woven fabric employed. When the web 3 and film 5 are wider than the final desired width of the transfer element, a slitting device comprising a roll 37 having outwardly extending circumferential slitting knives 38 is provided to cooperate with the roll 31. The knives 38 are spaced apart axially distances corresponding to the desired width or widths of the transfer element. If desired, slitting may be performed before the ink is applied to the fibrous web or after the wide transfer element is collected on take-up 33. In any event, the final element or elements collected on 33 may be subsequently unwound and cut to any length desired.

As an illustrative specific procedure, a coating of a copolymer of vinyl acetate and vinyl chloride containing 10% of a plasticizer and having a thickness of 0.001 inch was formed on a temporary backing sheet of smooth surfaced cellophane and passed through the system shown in Figure 1 in opposition to a woven fabric ribbon having a thickness of 0.015 inch. The width of the film and web was four feet. The surface of the film was heated to 160° C. and the surface of the ribbon was heated to 167° C. and subjected to a pressure of five pounds per square inch. After cooling, stripping, and impregnation

with ink, the laminar structure was cut into one-half inch widths.

Figure 2 shows a preferred embodiment comprising the preformed film backing 5 and a woven web 3a comprising warp threads 40 and filling threads 41. The filling threads are impregnated by the substance of the preformed film 5 to a slight depth indicated by the dotted line 42. This limited impregnation which generally amounts to less than 15% of the thickness of the web 3a, maintains substantially the entire ink-carrying capacity of the porous web 3a, the interstitial spaces 43 adjacent the back film 5 serving to provide capillary ink-retaining spaces which would ordinarily not contain ink in the absence of the film 5 and which compensate for the loss of porosity caused by the limited impregnation at 42. The film 5 retains its smooth rear or exposed surface and the laminar structure is essentially as flexible as the web 3a alone because of the limited impregnation of the film into the filling yarns 41. The smooth back surface of film 5 assures good distribution of pressure from the type character so that the extent of indentation is reduced and is less liable to become so excessive as to leave occasional permanent indentations, such as would occur when the back surface of the film has high spots initially.

Figure 3 illustrates a modification comprising the backing film 5 and the ink-retaining non-woven, paper-like web 2b. The interface 52 of the film 5 is adhesively joined to the fibers adjacent that face leaving the remainder of the non-fibrous web in its original inherently porous condition. In Figure 4, the non-woven fibrous web 3c comprises a plurality of twisted yarns 44 in the form of a warp sheet without any filling yarns. The backing film 5 is adhesively joined by impregnation of the web to the depth of the dotted line 42 as in the embodiment of Figure 2. As in that previous embodiment, the interstices 43 extending longitudinally between the adjacent yarns 44 and the interface of film 5 provides capillary ink retaining spaces adapted to compensate for the extent of impregnation at 42. In the embodiments of Figures 3 and 4, the back face of the film 5 is smooth as in Figure 2 and provides the same advantages.

It is to be understood that changes and varia-

tions may be made without departing from the spirit and scope of the present invention as defined in the appended claims.

I claim:

1. In a transfer element, a thin, porous fibrous web impregnated with an ink transfer medium, and a thin, tough, flexible, thermoplastic film impervious to the ink transfer medium adhesively joined by a portion of its own substance to one face of the web and having a smooth exposed face, the fibers of the web being also impregnated by the substance of the film at the adjoining surface of the web to a depth not exceeding one-fourth of the web thickness.
2. A transfer element as defined in claim 1 in which the film has a thickness of 0.0005 to 0.002 inch.
3. A transfer element as defined in claim 1 in which the web is a woven web having a thickness of 0.002 to 0.02 inch.
4. A transfer element as defined in claim 1 in which the web is a non-woven comprising yarns extending lengthwise of the web only and having a thickness of 0.002 to 0.02 inch.
5. A transfer element as defined in claim 1 in which the web comprises a non-woven felt-like mass of fibers having a thickness of 0.002 to 0.02 inch.
6. A transfer element as defined in claim 5 in which some of the fibers of the web are thermoplastic.

CARLETON S. FRANCIS, Jr.

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Certificate of Correction

Patent No. 2,657,157

October 27, 1953

Carleton S. Francis, Jr.

It is hereby certified that error appears in the printed specification of the above numbered patent requiring correction as follows:

Column 1, line 38, after "viscosity" insert *coating*; line 43, for "hight" read *high*; column 6, line 22, after "non-woven" insert *web*; line 47, list of references cited, for "2,407,459" read *2,407,549*;

and that the said Letters Patent should be read as corrected above, so that the same may conform to the record of the case in the Patent Office.

Signed and sealed this 12th day of January, A. D. 1954.

[SEAL]

ARTHUR W. CROCKER,

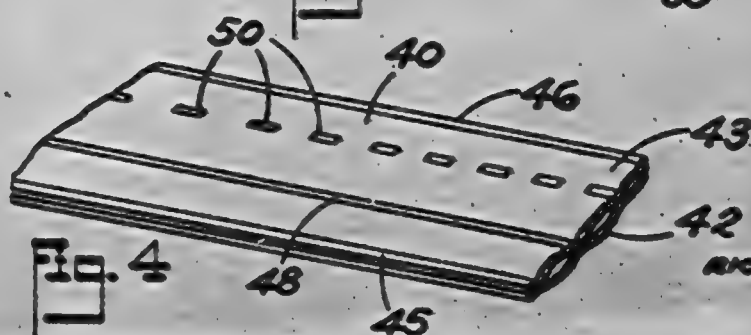
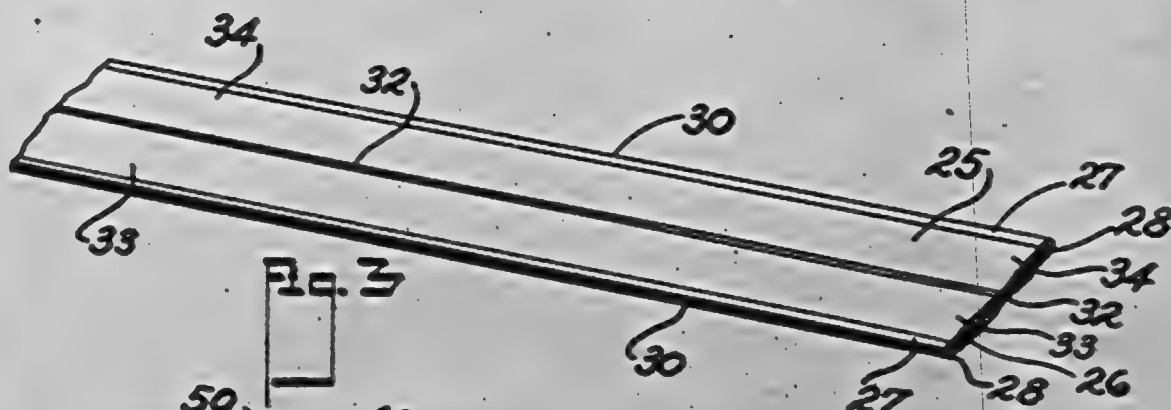
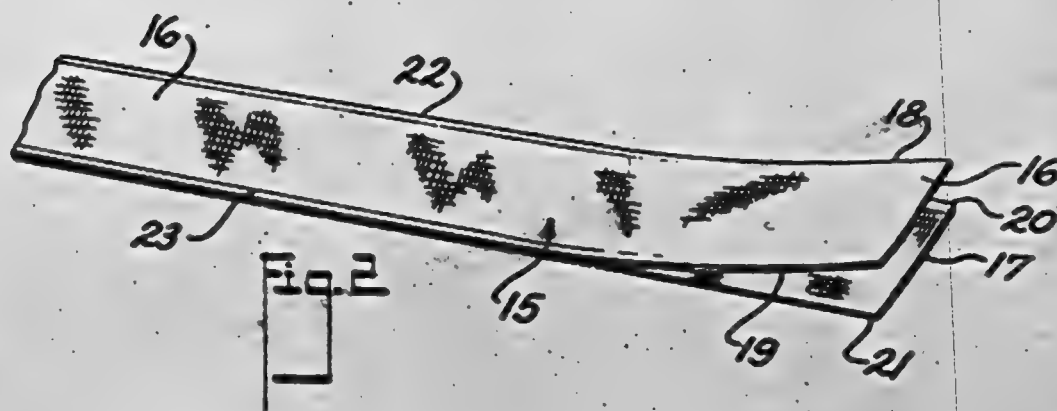
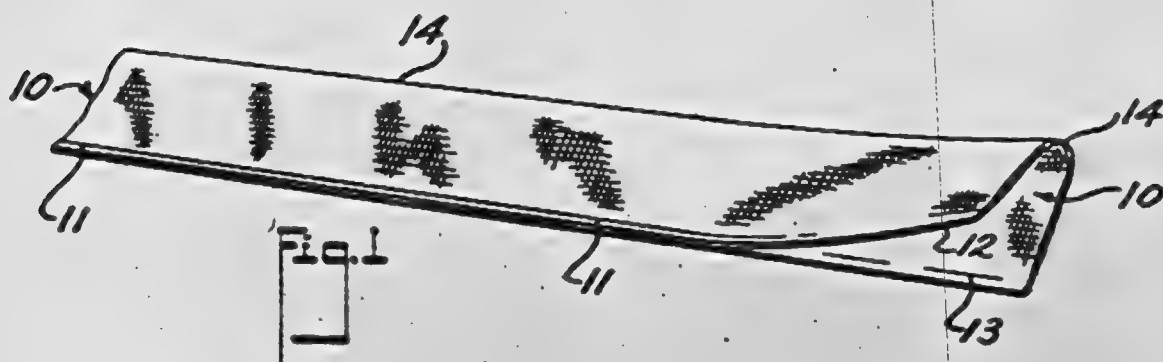
Dec. 27, 1955

H. P. MURPHY ET AL

2,728,439

TYPENWRITER RIBBON

Filed Aug. 26, 1954



INVENTOR
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STANLEY J. FRANK

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2,728,439

TYPEWRITER RIBBON

Harold P. Murphy, Willoughby, and Stanley J. Frank, Cleveland, Ohio, assignors to The Buckeye Ribbon & Carbon Company, Cleveland, Ohio, a corporation of Ohio

Application August 26, 1954, Serial No. 452,312

5 Claims. (Cl. 197—172)

The present invention relates generally to the printing art and is more particularly concerned with a novel, heavy-duty, typewriter ribbon which has unusually long useful life, even under the severest conditions, and which produces good, clear impressions over substantially its entire period of use regardless of the conditions of its use.

The conventional typewriter ribbons heretofore available on the market have left much to be desired from the standpoint of the average length of service and their ability to withstand the severe conditions of typing created by the present day electric typewriters and other modern business machines.

We are acquainted with efforts that have been made by others in the past to develop some means by which these ribbons could be conditioned for rigorous use and their average lives thereby materially prolonged. However, to the best of our knowledge, none of these efforts has resulted in either a satisfactory increase in the ruggedness of conventional ribbons or in the development of a new heavy-duty ribbon having any practical utility or value.

We have, by virtue of the present invention, eliminated the difficulties of the prior ribbons, including both conventional and non-commercial, or experimental types. Furthermore, we have accomplished this result without creating any significant offsetting disadvantage. Accordingly, as a result of this invention, it is now possible for the first time, to the best of our knowledge, to provide a typewriter ribbon which will last in use far longer under severe service conditions than the ribbons of the prior art.

Another unusual feature of our ribbon is its cushioning effect when struck a severe blow with the type of an electric typewriter. This cushioning effect results in the elimination or reduction of the tendency of the type to perforate or indent the original copy of the form being typed.

Other important advantages of the present invention will become clear to those skilled in the art, as will the particular nature of this invention, upon consideration of the detailed description set forth below, reference being had to the drawings accompanying and forming a part of this specification, in which:

Fig. 1 is a fragmentary, perspective view of a typewriter ribbon embodying this invention;

Fig. 2 is a similar view of a typewriter ribbon embodying this invention in preferred form;

Fig. 3 is a similar view of another typewriter ribbon representing a third embodiment of this invention; and,

Fig. 4 is a similar view of still another typewriter ribbon embodying this invention in another form.

In general, as is apparent from the drawings, a typewriter ribbon of this invention comprises an elongated, relatively-narrow, edge-welded, multi-ply, web-like body of fusible fabric such as nylon, the body being saturated with a non-drying fluid ink composition and having opposed longitudinal edge portions integrally united by a

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ravelling-proof, tear-resistant weld extending the full length of the body and constituting a narrow marginal zone of relatively dense, non-porous, substantially ink-impervious material.

With reference particularly to Fig. 1, the ribbon therein illustrated comprises an elongated strip or band 10 of nylon fabric which is doubled lengthwise and secured by means of a weld 11 along its free edge portions 12 and 13. In doubled form, ribbon 10 is substantially the width of the conventional typewriter ribbons so that it is adaptable to use in the ordinary machines. As indicated above, and shown in Fig. 1, weld 11 extends the full length of the ribbon body. Folded edge 14, as also indicated in this drawing, is creased sharply in any suitable manner in order that the ribbon will not tend to wrinkle or otherwise distort in ordinary use in such a manner or in such a degree that it would impair the operation of the machines on which it is installed. In the preferred practice of this invention, ribbon 10 is folded so that there is essentially no detectable difference in bulk or shape between its two longitudinal edge portions.

Ribbon 15 of Fig. 2 is composed of two relatively narrow, elongated strips of nylon fabric 16 and 17 which are disposed face to face and joined along opposed longitudinal edge portions (18, 19 and 21, 21) by two substantial continuous welds 22 and 23. Accordingly, ribbon 15 is of substantially the same width as ribbon 10 of Fig. 1 and heretofore conventional typewriter ribbons. It will be understood, however, that the width dimension of these ribbons may be varied to suit the needs of the user.

Welds 22 and 23 are preferably created in the same manner as weld 11 and the edge portions of this Fig. 2 ribbon are therefore essentially of the same bulk as the edges of ribbon 10. Consequently, in use, there is no problem of bulking or fouling of ribbon 15 in a typewriter and all the advantages stated above and inherent in the Fig. 1 ribbon are also to be obtained from this Fig. 2 ribbon.

In Fig. 3, the ribbon illustrated is, in fact, a variation of the one illustrated in Fig. 2. Consequently, the Fig. 3 ribbon comprises two relatively narrow, elongated strips 25 and 26 of nylon fabric joined along opposed longitudinal edge portions 27 and 28 by means of welds 30 extending substantially from end to end of the ribbon. Here again, as illustrated in Fig. 2, the two longitudinal edges of the ribbon are essentially of the same dimensions to assure that the ribbon will not foul in use or otherwise interfere with the operation of the machine upon which it is employed. This Fig. 3 article is provided in addition with an intermediate weld 32 extending the full length of the ribbon as a narrow band serving to divide the ribbon into two longitudinal segments 33 and 34 of substantially the same dimensions. Weld 32 serves to position the plies of strips 25 and 26 with respect to each other and to hold them in such position throughout the period of their use. Thus the tendency for the intermediate positions of the plies to shift about in use, particularly as the ribbon becomes worn substantially, is eliminated, making the use of such multi-ply ribbons applicable as a practical matter to two-color ribbon manufacture and use. In the two-color ribbons of this form of our invention, the intermediate weld is preferably located along the boundary between the colors, regardless of whether one color band is materially wider than the other. In single color ribbons the intermediate weld is preferably centered with respect to the ribbon for maximum stabilizing and supporting effect upon the portions of the two plies of the separate ribbon sections.

In Fig. 4, ribbon 40 is shown as being of the Fig. 2 type and comprising two elongated strips 42 and 43 of matching dimensions and shape joined along their longitudinal edge portions by continuous welds 45 and 46. A weld

48 extends the full length of ribbon 40 along a line to one side of the longitudinal center line and serves to hold the adjacent portions of strips 42 and 43 in assembled relation to each other. On the other side of the longitudinal center line the said strips are welded together and held in place by means of a plurality of spot or tack welds 50 which are substantially aligned lengthwise of the ribbon.

Welds 11, 22, 23, 30, 32, 45, 46, 48 and 50 may be provided or created in any suitable manner known to those skilled in the art. In accordance with our preference, however, the ribbon edge portions are joined by welds produced by the application of a hot element or iron against the parts to be welded together. A hot knife may be used for this purpose since nylon fabric can be fused readily under such circumstances and in fact is conventionally fused and cut in single ply by this means. Actually, in the drawings, the width of the weld in each instance has been exaggerated, as those skilled in the art will understand, in order to indicate more clearly the novel structure of our ribbons. It is, in fact, to be desired that the weld be as narrow as possible, particularly along the edge portions of the ribbon to avoid any tendency toward bulking, wrinkling or other deformation of the ribbon in use with resultant difficulty in operation of machines using these ribbons. Welds 32, 48 and 50 may suitably be substantially wider than the marginal welds if desired for any purpose, but it will be understood that their principal purpose will be served by a narrow weld as a seam or spot (50). These welds, accordingly, may be made by bringing into contact with ribbon 25 a heated element of working edge shape and dimensions substantially corresponding to the shape and dimensions of the weld desired.

From the foregoing description, those skilled in the art will understand that the ribbons of this invention afford substantial and important advantages over the prior art including the presently commercially employed ribbons as well as those ribbons which have been developed, tested and abandoned for one reason or another, or a combination of ribbons as mentioned above. Thus, for example, the multi-ply ribbons with stitched edge portions known in the prior art do not afford the trouble-free use that the ribbons of the present invention offer due largely to the fundamental difference between the construction of the marginal portions of these ribbons. Furthermore, in respect to the forms of this invention illustrated in Figs. 3 and 4, the multi-ply ribbons of the prior art do not have the long life of these ribbons and are not at all satisfactory for use as multicolor items.

The nylon fabric employed in the manufacture of the ribbons of this invention are preferably approximately the same weave and density as the nylon fabrics of the ribbons now in general commercial use. Typical fabric suitable for use in the manufacture of ribbons of this invention is of caliper (thickness) about 0.0040 inch and of thread count about 288 per square inch. However, it will be understood that fabrics of other weights and thread counts may be used to obtain the advantages of this invention and that the manufacturer of these ribbons may use materials other than nylon to obtain these advantages. The important thing is that the material or fabric be such that it can be welded and otherwise processed as described above to produce a ribbon having the structure defined in the claims and the special advantages of long service life under severe conditions.

The inks preferred for use in accordance with this invention are those conventional typewriter ribbon inks of commerce well-known to those skilled in the art. As described above, these inks are of the non-drying fluid type and it will be understood that any ink of this general description may be used for the purposes of this invention.

As used herein the word "multi-ply" means and includes two-ply and more than two-ply constructions.

Having thus described the present invention so that those skilled in the art may be able to understand and practice the same, we state, that what we desire to secure by Letters Patent is defined in what is claimed.

What is claimed is:

1. A heavy-duty typewriter ribbon especially adapted for use in electric typewriters and other business machines and having good clear impression qualities and unusually long useful life which comprises an elongated, narrow, edge-welded, multi-ply, web-like body of nylon fabric having superior ink capacity and absorbency characteristics, said body being saturated with a non-drying fluid ink composition and having opposed longitudinal edge portions integrally united by a ravelling-proof and tear-resistant weld extending substantially from end-to-end of the body and constituting a narrow marginal zone of relatively dense, non-porous, substantially ink-impervious material.

2. A heavy-duty typewriter ribbon especially adapted for use in electric typewriters and other business machines and having good clear impression qualities and unusually long useful life which comprises an elongated, narrow, edge-welded, two-ply, web-like body of nylon fabric having superior ink capacity and absorbency characteristics, said body being saturated with a non-drying fluid ink composition and having two ravelling-proof and tear-resistant welds extending substantially from end-to-end of the body along its lateral extremities and constituting a narrow marginal zone of relatively dense, non-porous, substantially ink-impervious material.

3. A heavy-duty typewriter ribbon especially adapted for use in electric typewriters and other business machines and having good clear impression qualities and unusually long useful life which comprises an elongated, narrow, edge-welded, two-ply, web-like body of nylon fabric having superior ink capacity and absorbency characteristics, said body being saturated with a non-drying fluid ink composition and having a folded and creased longitudinal edge portion and a second longitudinal edge portion having a ravelling-proof and tear-resistant weld extending substantially from end-to-end of the body and constituting a narrow marginal zone of relatively dense, non-porous, substantially ink-impervious material.

4. A heavy-duty typewriter ribbon especially adapted for use in electric typewriters and other business machines and having good clear impression qualities and unusually long useful life which comprises an elongated, narrow, edge-welded, two-ply, web-like body of nylon fabric having superior ink capacity and absorbency characteristics, said body being saturated with a non-drying fluid ink composition and having two ravelling-proof and tear-resistant welds extending substantially from end-to-end of the body along its lateral extremities and constituting a narrow marginal zone of relatively dense, non-porous, substantially ink-impervious material, and an intermediate weld extending substantially from end-to-end of the ribbon and bonding opposing intermediate portions of the two sides of the ribbon together.

5. A heavy-duty typewriter ribbon especially adapted for use in electric typewriters and other business machines and having good clear impression qualities and unusually long useful life which comprises an elongated, narrow, edge-welded, two-ply, web-like body of nylon fabric having superior ink capacity and absorbency characteristics, said body being saturated with a non-drying fluid ink composition and having two ravelling-proof and tear-resistant welds extending substantially from end-to-end of the body along its lateral extremities and constituting a narrow marginal zone of relatively dense, non-

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porous, substantially ink-impervious material, and a plurality of intermediate welds disposed substantially lengthwise of the ribbon and dividing said ribbon into a plurality of longitudinal sections and maintaining the opposite sides of the ribbon in predetermined fixed relation to each other in use.

6

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Nov. 28, 1961

W. PLOEGER, JR

3,010,559

PRINTING RIBBON

Filed May 14, 1959

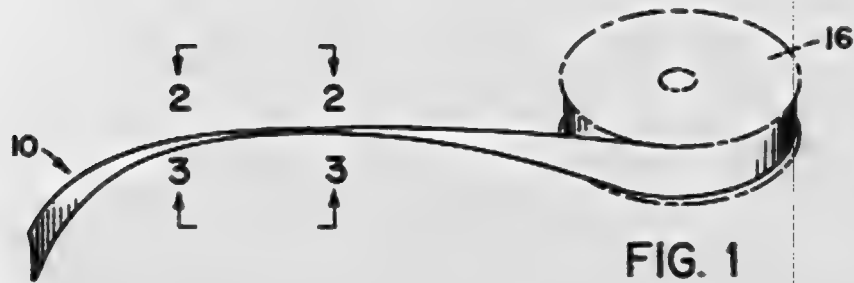


FIG. 1

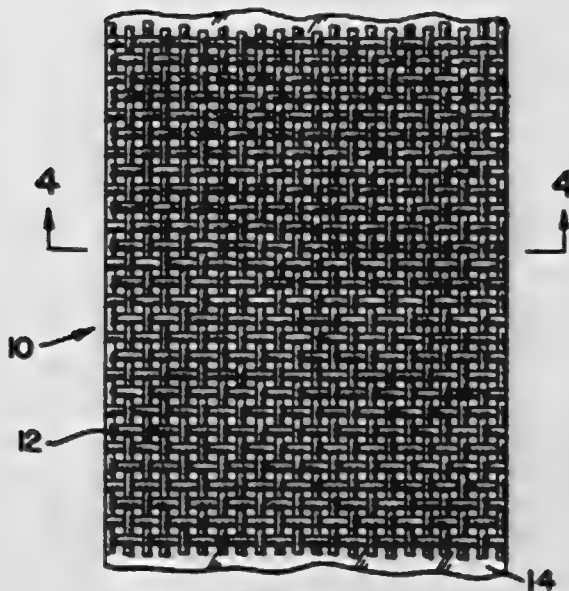


FIG. 2

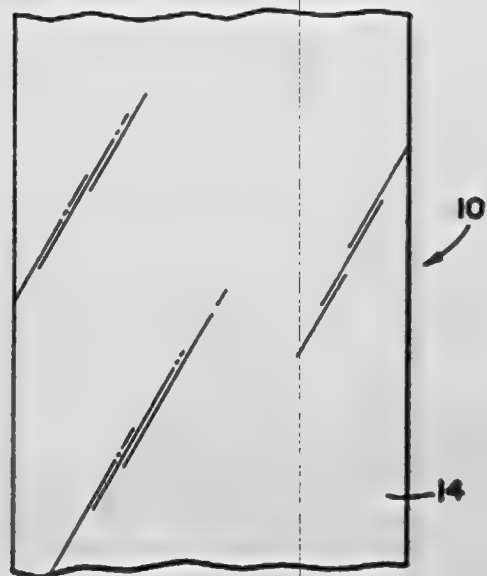


FIG. 3

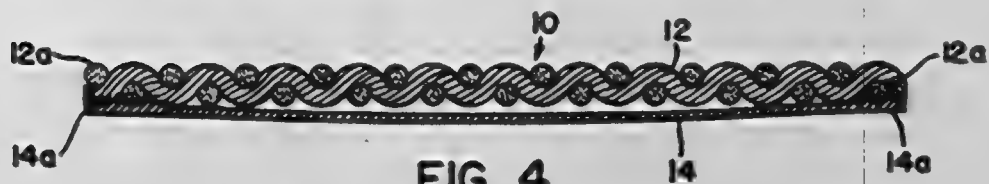


FIG. 4

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3,010,559

PRINTING RIBBON

Walter Floeger, Jr., North Bellmore, N.Y., assignor to The Edgcraft Company, New York, N.Y., a partnership

Filed May 14, 1959, Ser. No. 813,300
2 Claims. (Cl. 197-172)

The present invention relates to a printing ribbon, and more particularly to a printing ribbon for typewriters, adding machines, and similar machines which print characters on paper.

The printing ribbon generally used on typewriters and similar printing machines comprises a single ply ribbon of a flexible, absorbent material which is impregnated with an ink. A disadvantage of such a ribbon is that when the type of the typewriter or similar printing machine strikes the ribbon with sufficient force to print, the type penetrates into the ribbon, and tends to punch holes in the ribbon. In an attempt to overcome this disadvantage of the single ply printing ribbons, printing ribbons have been made of two plies of the absorbent material.

However, such double ply printing ribbons are of twice the thickness of a single ply ribbon so that the amount of the double ply ribbon which can be wound on a standard spool is cut in half. Thus, a standard spool of the double ply ribbon has a shorter useful life than a standard spool of a single ply ribbon. Another attempt to strengthen the single ply printing ribbon has been to coat the outer surface of the ribbon with a thin layer of a plastic material. However, since the plastic penetrates slightly into the pores of the absorbent ribbon, the amount of ink which such a plastic coated ribbon can absorb is drastically reduced. Thus, such a plastic coated ribbon has a shorter useful life than a single ply ribbon.

Another disadvantage of both a single ply printing ribbon and a double ply printing ribbon is that the type of the typewriter or similar printing machine contacts the ink in the ribbon. Thus, the type becomes coated with the ink so that the type must be cleaned periodically. Furthermore, the inks normally used in printing ribbons have a corrosive effect on the metal of the type which may damage the type.

It is an object of the present invention to provide a novel printing ribbon for typewriters, adding machines, and similar printing machines.

It is another object of the present invention to provide a printing ribbon for typewriters and similar printing machines which has great strength to prevent damage to the ribbon by the type.

It is still another object of the present invention to provide a printing ribbon for typewriters and similar printing machines which eliminates contact of the type with the ink in the ribbon.

It is a further object of the present invention to provide a double ply printing ribbon for typewriters and similar printing machines which is strong, eliminates contact between the type and the ink in the ribbon, and which contains a maximum amount of ink.

Other objects will appear hereinafter.

For the purpose of illustrating the invention there is shown in the drawings a form which is presently preferred; it being understood, however, that this invention is not limited to the precise arrangements and instrumentalities shown.

FIGURE 1 is a perspective view of a spool of the printing ribbon of the present invention.

FIGURE 2 is a plan view of one side of the printing ribbon of the present invention looking in the direction of arrows 2-2 in FIGURE 1.

FIGURE 3 is a plan view of the other side of the

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printing ribbon of the present invention looking in the direction of arrows 3-3 in FIGURE 1.

FIGURE 4 is a sectional view taken along line 4-4 of FIGURE 2.

Referring to the drawing, the printing ribbon of the present invention is generally designated as 10.

Printing ribbon 10 comprises an elongated strip 12 of a flexible, pliable, and absorbent material, such as a woven strip of cotton, silk, or nylon, and an elongated, thin strip 14 of a flexible, pliable, impervious material, such as impervious nylon. The absorbent material strip 12 and the impervious material strip 14 are arranged in juxtaposed surface-to-surface relation along their entire length. The elongated edges 12a of the absorbent strip 12 and the elongated edges 14a of the impervious strip 14 are sealed together. As shown in FIGURE 4, the impervious strip 14 is of a fusible material, and the edges 12a and 14a of the strips 12 and 14 are sealed together by fusing the edges 14a of the impervious strip 14 to the edges 12a of the absorbent strip 12. When the edges 14a of the impervious strip 14 are fused to the edges 12a of the absorbent strip 12, some of the material of the impervious strip 14 penetrates into the edges 12a of the absorbent strip 12 to provide a strong bond between the edges 12a and 14a. In addition, the fused seal between the edges 12a and 14a provides the ribbon 10 with ravel-proof edges. Although in the illustrated embodiment of the ribbon 10 of the present invention, the edges 14a of the impervious strip 14 are shown to be fused to the edges 12a of the absorbent strip 12, if the absorbent strip 12 is made of a fusible material, the edges 12a of the absorbent strip 12 may be fused to the edges 14a of the impervious strip 14.

As shown in FIGURE 4, the thickness of the impervious strip 14 is substantially less than the thickness of the absorbent strip 12. For example, the absorbent strip 12 is preferably between .004 and .005 inch in thickness, and the impervious strip 14 is preferably between .001 and .002 inch in thickness. The absorbent strip 12 of the ribbon 10 is impregnated with an ink, such as an oil base ink commonly used in printing ribbons for typewriters and similar printing machines. When the absorbent strip 12 is impregnated with the ink, some of the ink will flow into the space between the absorbent strip 12 and the impervious strip 14 to provide a reservoir of ink for the ribbon 10. The impervious strip 14 is preferably made of a transparent material so that the absorbent strip 12 can be viewed through the impervious strip 14.

In the use of the ribbon 10 of the present invention, the ribbon 10 is wound on a spool 16 as shown in FIGURE 1. The ribbon 10 is inserted in a typewriter, adding machine, or similar printing machine with the absorbent strip 12, which contains the ink, facing the paper to be printed on, and with the impervious strip 14 facing the type of the printing machine. In the use of the printing machine, the type of the machine engages the impervious strip 14 of the ribbon 10. Since the impervious strip 14 is of a tough material, the type does not penetrate the impervious strip 14, so that the absorbent strip 12 is not damaged by the type. Thus, the ribbon 10 of the present invention has a longer usable life than the printing ribbons heretofore used. In addition, since the ink in the ribbon 10 cannot penetrate the impervious strip 14, the type does not come into contact with the ink in the ribbon 10. Thus, the type is maintained clean, and is not subject to being damaged by the corrosive action of the ink.

The present invention may be embodied in other specific forms without departing from the spirit or essential attributes thereof and, accordingly, reference should be made to the appended claims, rather than to the foregoing specification as indicating the scope of the invention.

I claim:

1. A printing ribbon comprising an elongated strip of

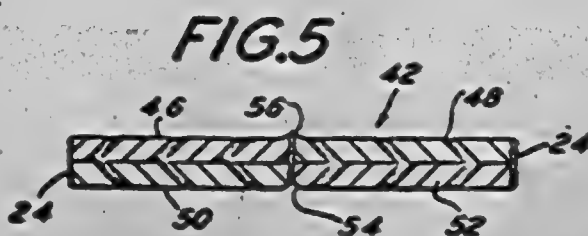
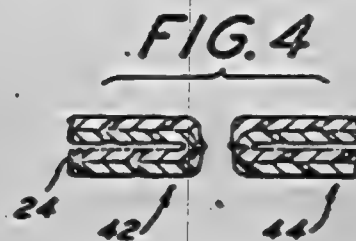
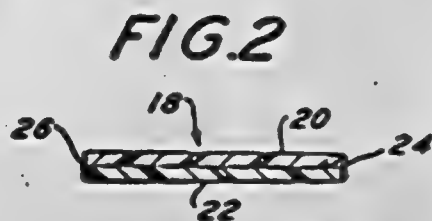
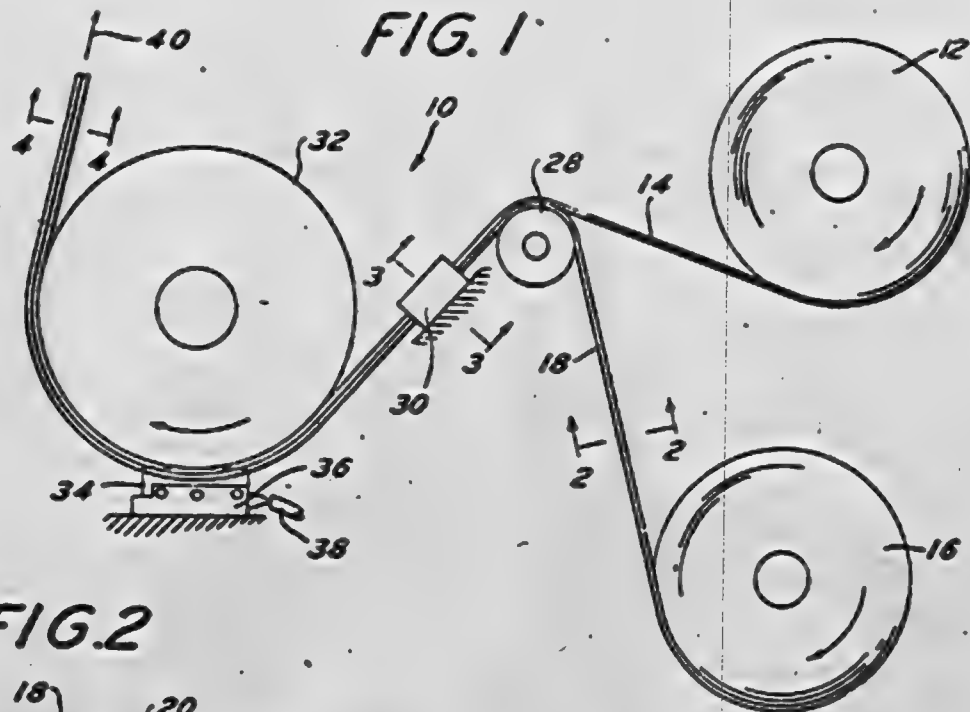
Sept. 20, 1966

W. PLOEGER, JR

3,274,039

METHOD OF MAKING PRINTING RIBBON

Original Filed April 16, 1962



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3,274,039

METHOD OF MAKING PRINTING RIBBON

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Original application Apr. 16, 1962, Ser. No. 187,736.
Divided and this application Jan. 25, 1965, Ser. No.
427,744

9 Claims. (Cl. 156-251)

This invention relates to a novel printing ribbon and
a method of making the same.

The application is a division of my copending appli-
cation Serial Number 187,736 filed April 16, 1962, now
abandoned.

In my prior Patent No. 3,010,559 there is disclosed a
printing ribbon which is based on a principle which results
in a printing ribbon structurally interrelated in a manner
resulting in numerous advantages with respect to the
printing ribbons proposed theretofore. The present in-
vention is directed to a printing ribbon which is an
improvement over the ribbon disclosed in the above-
mentioned patent and a method for making the improve-
ment ribbon. The printing ribbon disclosed in my above-
mentioned patent has performed excellently and is being
utilized in a wide variety of printing equipment. The
present invention results in a printing ribbon which has
an even greater field of use.

The printing ribbon of the present invention includes
a foolproof dividing line extending along the length there-
of between and parallel to the side edges thereof. One
face of the ribbon is an impervious flexible plastic mate-
rial which is heat-sealable and inert to ink. The other
face of the ribbon includes a portion on one side of the
dividing line which is capable of bearing a printing ink.
The portion of the ribbon on the opposite side of the
dividing line from said last-mentioned portion may be
an ink bearing member, carbon paper, type correcting
material, or type obscuring material, etc. The dividing
line is a solid homogeneous ink impervious weld which
prevents transmission of ink across the dividing line by
way of osmosis along the fibers of the ink bearing portions
of the ribbon.

Heretofore, a multicolor ribbon capable of causing
characters to be imprinted in two different colors, such
as red and black, were manufactured by using inks which
repelled each other. In other words, the inks utilized
heretofore in a multicolor ribbon were inks which would
not run together. The foolproof dividing line of the
ribbon of the present invention enables ordinary inks
which normally run together to be utilized. The dividing
line of the ribbon of the present invention also enables
a multilith ink to be utilized on one portion of the ribbon
and a conventional printing ink on another portion of
the ribbon.

The ribbon of the present invention may have the
layers secured together only along the side edges by a
weld as per the ribbon disclosed in my above-mentioned
patent. A ribbon constructed in this manner provides an
ink reservoir which materially increases the life of the
ribbon. Where ink capacity is not important, the layers
may be secured together across their full face in addition
to the foolproof dividing line. Alternatively, the side
edges of the two layers may be adhesively secured to-
gether along their extreme side edges where ink capacity
and long life are not of great importance.

It is an object of the present invention to provide a
novel method of making a printing ribbon.

It is another object of the present invention to provide
a novel method for making a laminated printing ribbon.

It is yet another object of the present invention to
provide a novel method for manufacturing a ribbon
adapted to be utilized in office machinery.

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It is still another object of the present invention to
provide a novel method for manufacturing two printing
ribbons at the same time.

It is a still further object of the present invention to
provide a novel method for making a laminated printing
ribbon which facilitates inking of the layers of the ribbon
prior to lamination thereof or after lamination thereof.

Other objects will appear hereinafter.

For the purpose of illustrating the invention there is
shown in the drawings forms which are presently pre-
ferred; it being understood, however, that this invention
is not limited to the precise arrangements and instrumen-
talities shown.

FIGURE 1 is a schematic illustration of the apparatus
for making the ribbon of the present invention.

FIGURE 2 is a sectional view taken along line 2-2
in FIGURE 1.

FIGURE 3 is a sectional view taken along line 3-3
in FIGURE 1.

FIGURE 4 is a sectional view taken along line 4-4
in FIGURE 1.

FIGURE 5 is a sectional view of a completed ribbon
of one embodiment of the present invention.

FIGURE 6 is a cross-sectional view of a completed
ribbon in accordance with another embodiment of the
present invention.

FIGURE 7 is a cross-sectional view of a completed
ribbon in accordance with a further embodiment of the
present invention.

Referring to the drawings in detail, wherein like numer-
als indicate like elements, there is shown in FIGURE 1
a schematic illustration of apparatus designated generally
as 10. The apparatus 10 includes a roll 12 which is
rotatably supported for movement in the direction of
the arrow thereon. The roll 12 contains a laminated
ribbon 14 having a width corresponding to the width of
the end product as will be made clear hereinafter. A
second roll 15 is rotatably supported adjacent the roll 12
for rotation in the direction of the arrow thereon. The
roll 16 contains a laminated ribbon 18 having a width
corresponding to the width of the end product as will be
made clear hereinafter.

Each of the ribbons 14 and 18 are identical. Accord-
ingly, only the ribbon 18 will be described in detail and
corresponding primed numerals will be applied to the
ribbon 14 where applicable. As shown more clearly in
FIGURE 2, the laminated ribbon 18 includes a layer of
plastic material 20 having a thickness of approximately
one-thousandth of an inch. The layer 20 is an impervious
flexible plastic material capable of being heat sealed,
is abrasion resistant, and is chemically inert to inks. The
preferred embodiment of the present invention includes
the making of the layer 20 from nylon. However, mylar
or polyethylene may be utilized.

The layer 20 is juxtaposed to and secured to a layer
22. The layer 22 is indicated in FIGURE 2 as being
secured to the layer 20 along the extreme side edges by
welded joints 24 and 26. The provision of welded joints
24 and 26 only along the side edges provides space for
a reservoir of ink between the layers 20 and 22 as per
the ribbon in my above-mentioned patent. Where ink
capacity is not important, the layers 20 and 22 may be
adhesively secured to each other across the full width
and length thereof.

The ribbons 14 and 18 are fed in overlapping relation
around the guide roller 28 and through an alignment guide
30. The alignment guide 30 is fixedly supported in a
position whereby the ribbons 14 and 18 may be fed there-
through. The guide 30 assures that the side edges of the
ribbons 14 and 18 are in alignment with one another.
The ribbons 14 and 18 are fed through the guide 30 with
the layer 20 of each ribbon juxtaposed to each other.

In other words, the layer of impervious plastic material on the ribbons 14 and 18 are juxtaposed to each other when fed through the guide 30. This relationship is critical since I have determined that the desirable results of the present invention cannot be obtained unless this relationship exists.

A back up roller 32 is rotatably supported in any convenient location. The back up roller is provided with a recess on its periphery in a conventional manner. A knife blade 34 is supported by a support block 36 and is connected to a source of electrical potential by electrical cable 38. The edge of the knife blade 34 is adapted to extend into the recess on the back up roller 32. The superimposed laminated ribbons 14 and 18 are fed between the back up roller 32 and the knife blade 34. The hot knife blade 34 slits the superimposed laminated ribbons 14 and 18 and simultaneously forms a welded joint as will be made clear hereinafter.

Thereafter, the ribbons are fed upwardly in a direction of arrow 40. As shown more clearly in FIGURE 4, the ribbons 14 and 18 have been separated into ribbons 42 and 44. The ribbons 42 and 44 are U-shaped at this point. The ribbons are then fed to a wind-up roll (not shown). Before being wound on the wind-up roll, the ribbons will be fed through a guide means which will flatten each ribbon to the disposition illustrated in FIGURE 5. Each of the ribbons 42 and 44 are identical. Accordingly, only ribbon 42 will be described in detail.

As shown more clearly in FIGURE 5, ribbon 42 includes a first layer and a second layer. The first layer has a portion 46 and a portion 48. The portion 46 was formerly a part of layer 22 on ribbon 14 and portion 48 was formerly a part of layer 22 on ribbon 18.

The second layer of ribbon 42 is juxtaposed to the first layer thereof. The second layer includes portions 50 and 52. Portion 50 was formerly a part of layer 20 on ribbon 14 and portion 52 was formerly a part of layer 20 on ribbon 18. The ribbon 42 is provided with a weld 54 extending the full length thereof substantially parallel to and spaced from the side edges of the ribbon. The weld 54 was formed by the hot knife 34 when the superimposed laminated ribbons were slit thereby. The weld 54 is provided with a readily distinguishable sharp ridge 56.

The weld 54 and the ridge 56 are a zone of impervious plastic material formed during the weldment and consists of the material of the layers 20 on each of the ribbons 14 and 18. If the layers 20 on the ribbons 14 and 18 were not juxtaposed to one another prior to the slitting operation, the weld 54 would not extend through the entire thickness of the ribbon 42 and the ridge 56 would not be provided. The ridge 56 and weld 54 are an ink impervious zone which prevents ink or other liquids from traveling across the weld from portion 46 to portion 48 by osmosis through the thread fibers.

In FIGURE 6, there is disclosed another embodiment of the present invention designated generally as 58. The ribbon 58 is identical with the ribbon 42 except as will be made clear hereinafter. In ribbon 58, the portion 60, which corresponds with the portion 48, may be carbon paper. Hence, it will be noted that the original ribbons 14 and 18 from which the ribbon 58 was made were not identical. One of the ribbons would be identical with ribbon 14 while the other ribbon would be a laminate of carbon paper and a layer of plastic material corresponding to layer 20. Otherwise, the ribbon 58 is made in the identical manner described above.

In FIGURE 7, there is disclosed another embodiment of the present invention designated generally as 62. The ribbon 62 is identical with ribbon 42 except that portion 64, corresponding to portion 48, is made from a layer of material sold commercially under the name Ko-Rec-Type. Ko-Rec-Type is a correction sheet which corrects mistakes made on a typewriter without removing the copy from the typewriter. In order to accomplish this desirable result, the correction sheet has a white powder impregnated

thereon which covers the typewritten letters in a well known manner.

Heretofore, it has been impossible to utilize the Ko-Rec-Type in a strip form such as a typewriter ribbon because the powder surface of the Ko-Rec-Type would erase or smear previously typewritten letters. Smearing or erasing is precluded by the ridge 56' on ribbon 62. The ridge 56' maintains the portion 64 spaced from the paper a sufficient distance so as to prevent smearing or erasing except when desired.

The ink bearing portions of the ribbons of the present invention may be inked prior to being unwound from the rolls 12 and 16. This is the preferred embodiment. Alternatively, the ink bearing portions of the ribbons 42, 58 and 62 could be inked subsequent to the manufacture thereof by the slitting operation. The knife blade 34 is preferably reciprocally mounted on the support block 36 so that the knife blade 34 may be reciprocated with respect to the roller 32. In this manner the location of the weld 54 may be varied so as to produce ribbons of diverse widths. When the ink bearing portions, such as portions 46 and 48 of ribbon 42, are made from a woven nylon material, the nylon material thereof is blended into the weld 54 and forms a part thereof. No difficulties were encountered in providing the weld 54 and ridge 56' when one of the portions of the first layer of the ribbons was a paper material such as in ribbons 58 and 62.

I have found that a true weld such as weld 54 cannot be obtained merely by superimposing two layers of material and causing the same to be passed beneath a heated pressure roller. The last-mentioned roller merely embosses the two layers and joins the same with a joint. However, such joint is not a true weld which is capable of preventing osmosis of the ink from one side of the ribbon to another across the weld through fibers disposed in a central plane of the ribbon. Also, the utilization of a hot pressure roller does not result in a thin hairline weld having a ridge thereon as illustrated in the drawings.

The woven fabric portions adapted to bear ink may be nylon, dacron, silk, etc. The ink bearing portions may have different color inks of the same type or may have completely different inks which heretofore could not possibly be utilized in a multicolored ribbon. The ribbons of the present invention may have conventional ink on one portion and lithographic ink on another portion. The lithographic ink may be of the same color as the conventional printing ink on the other portion of the ribbon. In this manner, it will be possible to accentuate a word in a sentence by typing that word only on the lithographic portion of the ribbon. It will be obvious that the ability of the ribbon of the present invention to utilize two different inks which are normally capable of being mixed will materially reduce the cost of a multicolor ribbon.

The present invention may be embodied in other specific forms without departing from the spirit or essential attributes thereof and, accordingly, reference should be made to the appended claims, rather than to the foregoing specification as indicating the scope of the invention.

I claim:

1. A method of making a laminated printing ribbon comprising the steps of overlapping first and second laminated ribbons each of which has a layer of impervious flexible plastic material which is heat sealable and inert with respect to ink, said overlapping step being accomplished in a manner so that the layers of impervious flexible plastic material of each ribbon are overlying one another in direct abutting contact and extending in the same direction, then heat sealing an ink impervious weld through each layer of each ribbon substantially parallel to and spaced from side edges of each ribbon, cutting the ribbons along the weld to provide third and fourth ribbons with each of the third and fourth ribbons containing a part of the first and second laminated ribbons and then flattening said third and fourth ribbons so that the third and fourth ribbons are substantially planar.

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2. A method in accordance with claim 1 including the step of aligning the side edges of said first ribbon with respect to the side edges of said second ribbon, said aligning step being accomplished prior to the step of providing an ink impervious weld.

3. A method in accordance with claim 1 wherein said step of providing a weld and said step of cutting the ribbons are accomplished simultaneously by moving the ribbons relative to a heated cutting tool.

4. A method in accordance with claim 1 including the step of inking at least one of said first and second ribbons prior to said step of overlapping said first and second ribbons.

5. A method in accordance with claim 4 including the step of inking each of said first and second ribbons with different non-repelling inks prior to the step of overlapping said first and second ribbons.

6. A method in accordance with claim 1 wherein one layer of said first laminated ribbon is a layer of paper material.

7. A method in accordance with claim 6 wherein said paper material has a material associated therewith capable of obscuring type of a typewritten page.

8. A method in accordance with claim 1 wherein said first and second layers are of the same width, and aligning the side edges of said first and second ribbons prior to said step of providing a weld.

9. In a method of making printing ribbon comprising

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unwinding a first strip of impervious polymeric plastic material from a roll, unwinding a second strip of material capable of transmitting an impression from a roll, aligning said first and second strips so that the side edges of said strips are substantially parallel and said strips are in juxtaposed abutting relationship, unwinding a third strip of polymeric plastic material from a roll, unwinding a fourth strip of woven nylon fabric from a roll, aligning said third and fourth strips so that the side edges of said strips are substantially parallel, juxtaposing said first strip against said third strip, said juxtaposing step being accomplished in a manner so that said first strip is in direct abutting contact with the third strip, cutting the strips with a heated tool and simultaneously welding a cut edge of said polymeric plastic materials to the cut edges of each of said second and fourth strips, said cutting step being accomplished by simultaneously moving said strips relative to said tool in a direction substantially parallel to the side edges of said strips, and inking said woven nylon fabric.

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Jan. 11, 1955

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RIBBON PROTECTOR

2,699,244

Filed March 15, 1950

2 Sheets-Sheet 1

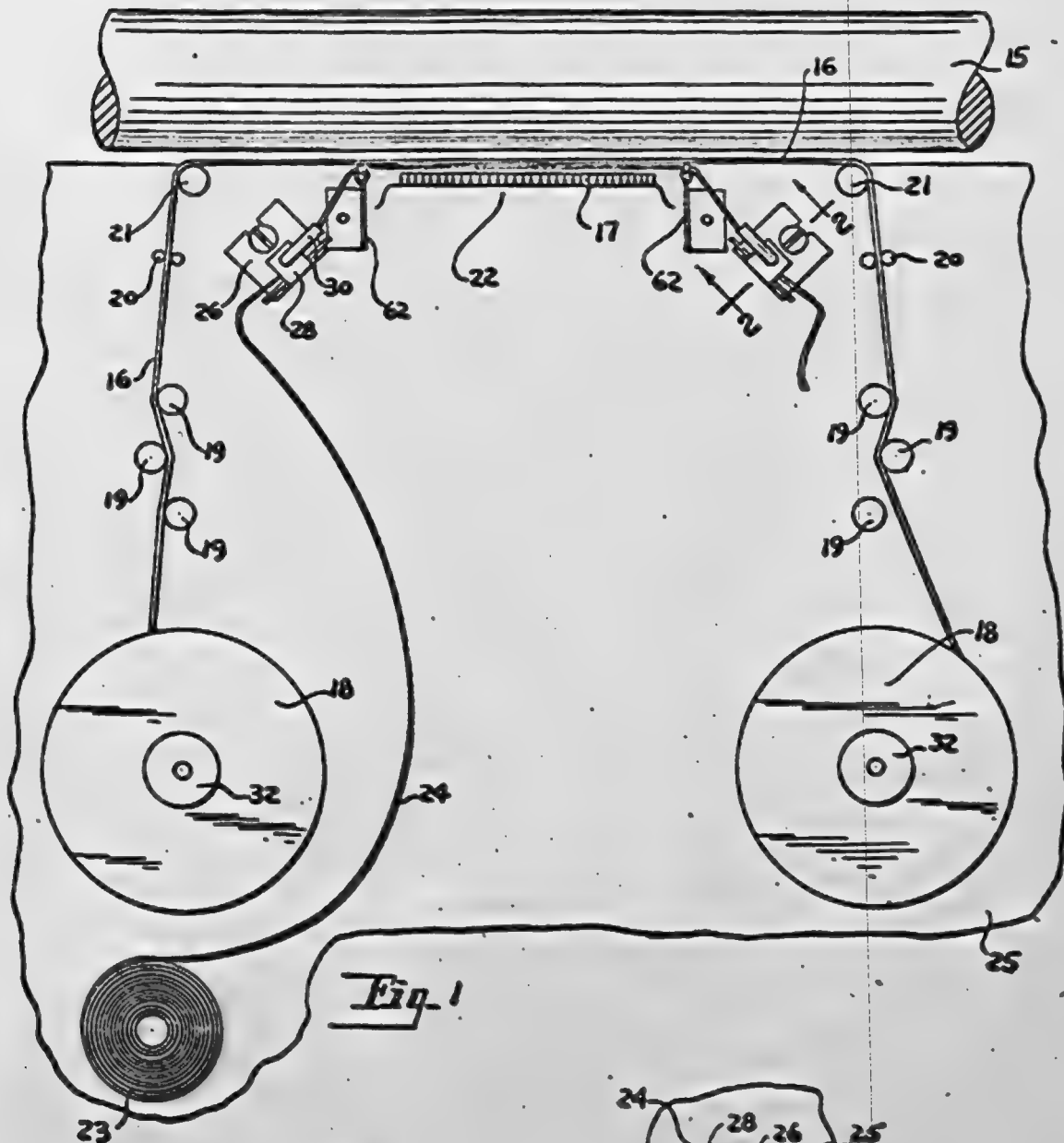


Fig. 1

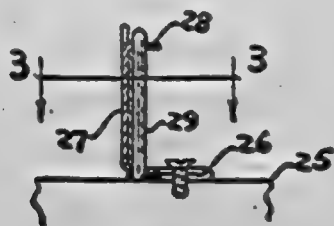


Fig. 2

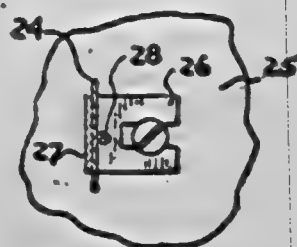


Fig. 3

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2 Sheets-Sheet 2

Fig. 4

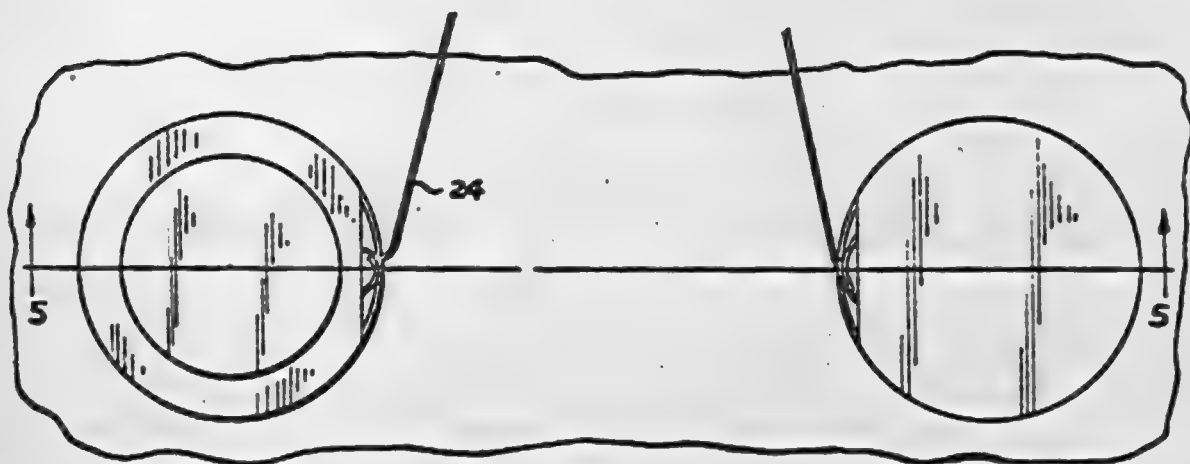


Fig. 5

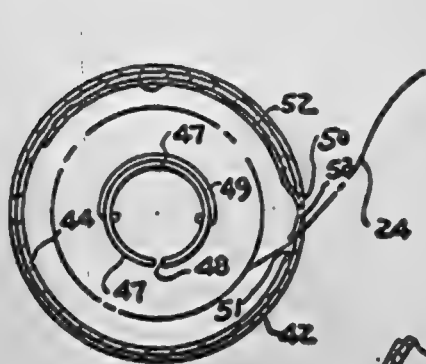
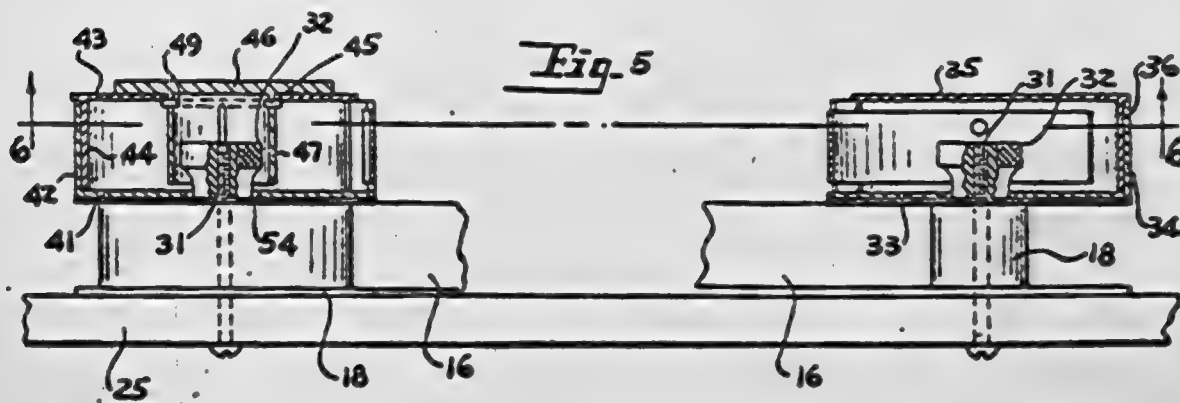


Fig. 6

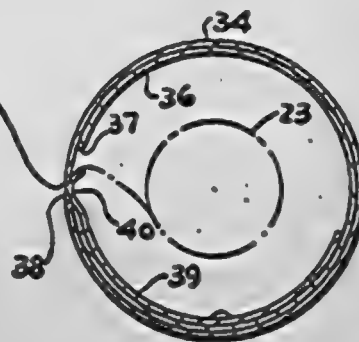


Fig. 7



Fig. 8

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2,699,244

RIBBON PROTECTOR

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Application March 15, 1950, Serial No. 149,666

2 Claims. (Cl. 197—151)

My invention relates to a new and useful improvement in a ribbon protector and is adapted for that class of machines in which a type bearing bar is used in such a manner that the type strikes the ribbon to make the impression on the paper or other material on which the typing is to be done. The invention is adapted for use on adding machines, calculating machines and so forth in which the ribbon impression is made.

In such types of machines there are several disadvantages. Among these are that the ribbon becomes worn out quite rapidly by being struck by the type. Another is that, particularly on calculating machines, the striking of the type against the ribbon will cause a spreading or splattering of the ink. Another disadvantage is that the type becomes clogged with dust or dirt together with ink thus making it impossible to obtain a clear impression even though the ribbon itself may be a new one.

The present invention has as one of its objects the protection of the type from contact with the ink bearing ribbon reducing to a large extent the dirtying of the type and maintaining a clear impression at all times.

Another object of the invention is the provision in machines of this class of a device whereby the splattering or spreading of the ink will be prevented and whereby the wear on the ribbon will be considerably reduced.

Another object of the invention is the provision of a device adapted for use in machines of this type which will eliminate considerable smeary work in pre-inking ribbons and removing and replacing ribbons as well as cleaning the type when it becomes dirty.

Other objects will appear hereinafter.

It is recognized that various modifications and changes may be made in the detail of structure illustrated without departing from the invention and it is intended that the present disclosure shall be considered but the preferred embodiment.

Forming a part of this specification are drawings in which,

Fig. 1 is a top plan schematic view illustrating the invention,

Fig. 2 is a fragmentary sectional view taken on line 2—2 of Fig. 1,

Fig. 3 is a sectional view taken on line 3—3 of Fig. 2,

Fig. 4 is a top plan schematic view illustrating a modification,

Fig. 5 is an elevational view of the structure shown in Fig. 4 with parts being shown in elevation and parts in section,

Fig. 6 and Fig. 7 are sectional views taken on line 6—6 of Fig. 5,

Fig. 8 is a fragmentary sectional view taken on line 6—6 of Fig. 5 showing one of the spools moved to unlocking position.

In the drawings I have illustrated a platen 15 which is a roller of well known type and construction used on typewriters, calculating machines and the like. This platen forms the backstop of the papers, cards or the like upon which the typing is to be done. An inked ribbon 16 is wound upon the spools 18 and in the ordinary operation of the machine winds on the one spool while it unwinds from the other. This ribbon 16 passes around the guide rollers 19, the pins 20, the guide plates 21 and thru the retainer 22.

The ribbon protector is a non-inked body which is placed between the ribbon 16 and the type 17 so that as the type is moved out to strike the ribbon 16 it will first strike the protector 24 which may be unwound from a

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suitable roll 23 or it may be formed of individual lengths so that when it is necessary to remove and replace the protector the individual lengths may be removed or replaced. Where a roll is used another section would be unwound from the roll to span the space at which the type are adapted to operate. This protector may be of the same width as the inked ribbon 16 or it may be of a different width. It is necessary, however, that it be of sufficient width to receive the impression from the type whether this type be an individual type or an impression plate such as are used on addressing machines. The protecting members 24 may be made from any suitable material which is sufficiently flexible and which has long wearing qualities. Experience has shown that a ribbon formed from nylon is quite satisfactory for this purpose as it has the necessary thinness, flexibility and durability. This protector, of course, is maintained in a fairly taut condition in front of the inked ribbon 16, the tautness of the protector corresponding substantially to the tautness of the inked ribbon 16.

In the drawings I have illustrated a bracket 26 having an upstanding plate 27, the base of this bracket 26 being mounted upon a suitable support 25 which is customarily found on machines of this nature. An outwardly projected tongue 28 is formed on the upper end of the plate 27 and extended thru this tongue is a pin 29 having the angularly turned portion 30 at its upper end. As shown in Fig. 3, the pin 23 is cut away at one side so that it will serve the purpose of a cam clamp. The ribbon 24 is fed between the plate 27 and the pin 28 while the cut away side of the pin 28 is faced toward the plate 27. One of the pins 28 is then turned into the position shown in Fig. 3 so that the ribbon is clamped tightly against the plate 27. The ribbon is then passed around the guide posts 62 and drawn taut in front of the type 17. The opposite end of the ribbon is similarly drawn into position and clamped on the other clamping bracket. In Fig. 1 I have shown this protector 24 unrolled from a roll 23. However, the ribbon itself may be cut to various lengths so that it reaches only from one clamping member to the other.

In Fig. 4, Fig. 5, Fig. 6, Fig. 7 and Fig. 8 I have shown a different method of supporting the roll 23 of the protector. The ribbon spools 18 shown in Fig. 1 are mounted on the support 25 by means of the screw 31 on which is threaded a nut 32 which bears against the upper side of the spools 18. As shown in Fig. 5 I provide a pair of spools, each consisting of a cup shaped member. One of these has a base 41 and the wall 42. Telescoping with this cup shaped member is a similar cup shaped member having a top 43 and a wall 44. The top 43 is provided with an opening 45 in which a sleeve 47, split as at 48, is adapted to project. This sleeve is formed preferably integral with the disk 46 and held in position by the wire 49. The wall 42 is provided with a slot as at 50 thru which the protector 24 may be extended. The wall 44 is provided with a slot 51. When these slots are brought into registration the protector 24 may be fed inwardly and outwardly of this spool. Mounted on the inner surface of the wall 44 adjacent one of its ends is a leaf spring 52 having a bowed out portion 53. When the walls 44 and 42 are moved relatively to each other, this bowed out portion will serve to clamp the protector 24 and hold it tight so as to prevent its being fed inwardly or outwardly of the spool. This spool is held in position by being placed over the nut 32, the base 41 having an opening 54 thru which the nut 32 may be extended so that this nut serves as a support to prevent lateral movement of the base 41. A cooperating spool is provided having a base 33 and a wall 34 and telescoping with this cup shaped member is a similar cup shaped member having the top 35 and the wall 36. A slot 37 is formed in the wall 36 and a slot 38 is formed in the wall 34. Mounted at one end on the inner surface of the wall 36 is a leaf spring 39 having the outwardly bowed portion 40 so arranged that when these slots are moved out of registering position this bowed portion will serve to clamp the protector and hold it in position as already described. The protector 24 fed from these spools would, of course, pass around the clamping mechanisms shown clearly in Fig. 1 and the protector brought into taut position in

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front of the type. When it is desired to change the protector and move another section to operative position, the clamping mechanisms would be released and the disk 46 could be rotated so as to rotate the sleeve 47. The ribbon protector would, of course, be inserted in the slit 48 so that as the tube or sleeve 47 is rotated the protector would be wound upon this member.

It is believed obvious that if desired the protector may be moved with each operation of the type as is customary in some machines with the inked ribbon. It is believed obvious that other forms of securing the protector at opposite sides of the type may be resorted to instead of using the clamping mechanism illustrated as it is but necessary that this protector be sufficiently taut to be retained in front of the inked ribbon and not to interfere with the operation of the machine.

A protector of this type has proved quite efficient in use as it does prolong the life of the inked ribbon and prevents the undesirable splattering or spreading of the ink. At the same time the face of the type is kept clean and efficient operation of the type bars becomes possible. Without the use of the protector dirt and foreign material and particularly dust mixed with the ink will interfere with the proper operation of the type bars until eventually these type bars begin to stick resulting in an imperfect operation of the machine. The protector also serves to protect the ribbon from wearing and prevent the platen from hardening and wearing.

What I claim is:

1. In a writing machine embodying an inked ribbon and a plurality of type bearing members arranged in a bank and positioned in straight lineal alignment, normally in spaced relation to the inked ribbon and selectively individually movable into engagement with the inked ribbon for forcing an impression therethrough: a pair of supporting bodies at opposite sides of said bank, a post on each of said supporting bodies at opposite sides

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of said bank; a pair of clamps each positioned at one side of said bank on said supporting bodies; and a protective ribbon of flexible non-inked material engaging said posts and extending between the inked ribbon and said bank and held in taut condition against said posts by said clamps, said clamps being movable into operative position and inoperative position and each movable independently of the other.

2. In a writing machine embodying an inked ribbon and a plurality of type bearing members arranged in a bank and positioned in straight lineal alignment, normally in spaced relation to the inked ribbon and selectively individually movable into engagement with the inked ribbon for forcing an impression therethrough: a pair of supporting bodies at opposite sides of said bank; a post on each of said supporting bodies at opposite sides of said bank; a pair of engagement members each positioned at one side of said bank on said supporting bodies; and a protective ribbon of flexible non-inked material engaging said posts and having a portion extending between the inked ribbon and said bank and engaged and held in taut condition against said posts by said engagement members, said engagement members being movable to engaging and non-engaging position against said non-inked ribbon whereby said non-inked ribbon, upon movement of said engagement members to non-engaging position, may be moved longitudinally for locating another portion thereof between said inked ribbon and said bank.

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11. JULI 1957

DEUTSCHES PATENTAMT

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Nr. 966 174

KLASSE 15g GRUPPE 3707

INTERNAT. KLASSE B 41j ———

W 14658 XII/15g

Richard Willi Gründel, Hannover
ist als Erfinder genannt worden

Fa. Günther Wagner, Hannover

Einseitig gegen Farbabgabe abgedecktes Farbband

Patentiert im Gebiet der Bundesrepublik Deutschland vom 14. August 1954 an

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Patenterteilung bekanntgemacht am 27. Juni 1957

Für besondere Zwecke, z. B. bei Buchungs- und Tabelliermaschinen, verwendet man seit geraumer Zeit gern für die Herstellung einer Zweitschrift, die etwa ein »zweites Original« darstellen soll, an Stelle des allgemein üblichen Kohlenpapiers ein zweites Farbband, das hinter dem »ersten Original« durch die Maschine geführt wird bzw. bei einigen Maschinensystemen an dieser Stelle fest angeordnet ist.

Für solche Bänder, die teilweise auch besser als Farbtücher angesprochen werden müßten, ist es nicht nur zweckmäßig, sondern geradezu erforderlich, daß sie nur einseitig ihre Farbe abgeben können. Bei zweiseitiger Farbabgabe würde ja nicht nur die Durchschrift (das zweite Original) beschrieben werden, sondern darüber hinaus auch die Rückseite des ersten Blattes.

Man hat nun schon auf verschiedene Weise versucht, Farbbänder einseitig abzudecken, um die

Farbabgabe ausschließlich nach der dem Typen-
anschlag entgegengesetzten Seite zu ermöglichen.
So wurden Farbbänder schon einseitig mit geeig-
neten Mitteln imprägniert oder beschichtet. Solche
Mittel wurden aufvulkanisiert bzw. mit ihnen
wurde das Farbband kaschiert. Soweit es sich da-
bei um die Verwendung thermoplastischer Kunst-
stoffolien handelte, wurden diese mit dem Farb-
band durch thermoplastisches Verkleben verbun-
den. In allen diesen Fällen fand also eine innige
Verbindung des Farbbandes mit dem Abdeckmittel
in der ganzen Fläche statt, was stets zur Folge
hatte, daß die Farbaufnahmefähigkeit und damit
auch die Ergiebigkeit der Bänder in mehr oder
weniger starkem Maße gemindert wurde. Zum
Ausgleich dieses Nachteils verwendete man vor-
zugsweise Gewebe groberer Struktur, wobei aller-
dings wiederum die Feinheit der Schrift wesent-
lich verschlechtert wurde.

Man hat deshalb auch schon den Vorschlag gemacht, für den oben beschriebenen Zweck ein gewöhnliches Farbband zu nehmen und mit diesem ein zweites farbloses bzw. ungefärbtes und gegen Farbe möglichst indifferentes Band aus z. B. Cellophan (eingetr. Wz.), Gelatine od. dgl. typen-
 5 seitig durch die Maschine laufen zu lassen. Lediglich an den beiden Enden konnten diese Bänder miteinander verbunden sein. Hierbei traten zwar
 10 die vorgenannten Nachteile nicht auf, statt dessen machte jedoch die Bandführung als solche gewisse Schwierigkeiten, die ein wirklich sauberes »zweites Original« nur sehr schwer möglich machten. Solche Schwierigkeiten und die damit verbundenen be-
 15 trächtlichen Nachteile traten z. B. schon durch die verschiedene Länge von Farbband und Abdeckband auf, einer Erscheinung, die ja bei Maschinen mit doppelter Bandführung bereits Anlaß zu
 20 grundlegenden Verbesserungen (Gleitschnalle) gegeben hat, der im vorliegenden Falle jedoch nicht auf die gleiche oder ähnliche Weise begegnet werden kann. Darüber hinaus geschah es sehr leicht,
 25 daß beim Anheben des Bandes mit dem Bandheber Verschiebungen der beiden Lagen gegeneinander vorkamen.

Es ist nun gefunden worden, daß man all diesen Schwierigkeiten auf einfache Weise dadurch aus dem Wege gehen kann, daß man zum Abdecken
 30 des Farbbandes nach einer Seite hin eine thermoplastische Folie verwendet und diese Folie an den beiden Längsseiten der Bänder bzw. Farbtücher in einem ganz schmalen Streifen mit dem Band in thermoplastischer Verklebung fest verbindet.
 35 Auf der gesamten Fläche des Farbbandes bzw. Farbtuches wird damit das farbtragende Gewebe nur durch eine lose aufgelegte Folie abgedeckt, die jedoch infolge der thermoplastischen Verklebung an den Rändern sicher mit dem Gewebe verbunden ist, so daß ein Verrutschen ausgeschlossen
 40 wird und wirklich einwandfreie Originale bzw. Durchschriften erzielt werden. Die innige Verbindung der beiden Bänder (Farbband und Folie) an den Rändern mittels thermoplastischer Verklebung beseitigt die Probleme einer unterschied-
 45 lichen Bandlänge, da ja tatsächlich nur noch ein Band vorhanden ist. Die auf diese Weise gewonnene Stabilität des Produktes gewährt darüber hinaus eine einwandfreie Bandführung. Es können ferner ohne weiteres feinste Seidengewebe Ver-
 50 wendung finden, die ihrerseits eine Schrift ergeben, deren Feinheit und Exaktheit nichts zu wünschen übrig läßt.

Die erwähnte thermoplastische Verklebung kann erfindungsgemäß nun in verschiedener Weise
 55 durchgeführt werden:

1. Niederschmelzen der thermoplastischen Folie auf die Ränder des farbtragenden Gewebes.

2. Auflegen eines schmalen farblosen Gewebestreifens auf die Ränder der thermoplastischen Folie, so daß an den Rändern des Bandes drei

Schichten übereinanderliegen: Farbträger, Abdeckfolie, Gewebestreifen. In der Wärme werden alle drei fest miteinander verschmolzen und ergeben einen besonders sauberen, gleichmäßigen und stabilen Rand, der die Arbeit mit dem doppelten
 65 Band ganz erheblich erleichtert.

3. Auflegen eines Textilfadens an Stelle des farblosen Gewebestreifens und im übrigen Verfahren nach 2. Auch hierbei erreicht man einen besonders gleichmäßigen, sauberen und stabilen, je-
 70 doch noch schmalen Rand.

In der Zeichnung ist der Erfindungsgegenstand beispielsweise dargestellt.

Fig. I zeigt ein Farbband mit teilweise darauf-
 75 liegender, in der Fläche loser und nur an den beiden Rändern verbundener Abdeckfolie;

Fig. II zeigt das gleiche Band im Schnitt a-a;

Fig. III stellt ein Farbband mit Abdeckfolie dar, bei dem beide Teile mit Hilfe eines aufgelegten
 80 schmalen Gewebestreifens thermoplastisch verbunden wurden;

Fig. IV zeigt das gleiche Band im Schnitt b-b;

Fig. V stellt ein Farbband mit Abdeckfolie dar, bei dem beide Teile mit Hilfe eines Textilfadens
 85 miteinander thermoplastisch verbunden worden sind;

Fig. VI zeigt das gleiche Band im Schnitt c-c.

Übereinstimmend in allen Figuren bedeutet 1 das farbtragende Gewebe, 2 die thermoplastische
 90 Abdeckfolie, 3 die Stellen bzw. Streifen der thermoplastischen Verklebung, 4 die schmalen farblosen Gewebestreifen und 5 die verwendeten Textilfäden.

Es muß noch erwähnt werden, daß nach Bedarf selbstverständlich eine der erfindungsgemäßen Be-
 95 festigungen nur an einer Seite des Bandes angewendet werden kann und daß außerdem eine Kombination zwischen den aufgeführten Möglichkeiten dadurch entstehen kann, daß man den einen Rand nach der einen, den anderen Rand nach einer der
 100 anderen Möglichkeiten befestigt.

PATENTANSPRÜCHE

1. Einseitig mit einer thermoplastischen Kunststoffolie abgedecktes und mit dieser Folie
 105 durch thermoplastisches Verkleben verbundenes Farbband, dadurch gekennzeichnet, daß die Folie (2) mit dem Farbband (1) ausschließlich entlang den Rändern (3) verbunden ist.

2. Einseitig mit einer thermoplastischen Folie abgedecktes Farbband nach Anspruch 1, dadurch gekennzeichnet, daß auf der Seite der
 110 Abdeckfolie (2), die dem Farbband (1) abgewandt ist, entlang einer oder beider Kanten schmale, farblose Gewebestreifen (4) oder Textilfäden (5) thermoplastisch auf die Folie aufgeklebt sind.

In Betracht gezogene Druckschriften:
 115 USA.-Patentschrift Nr. 2 657 157.

Hierzu 1 Blatt Zeichnungen

Fig. I



Fig. II

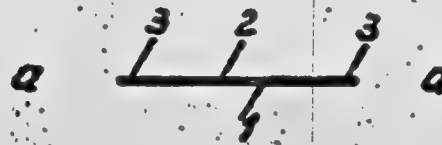


Fig. III

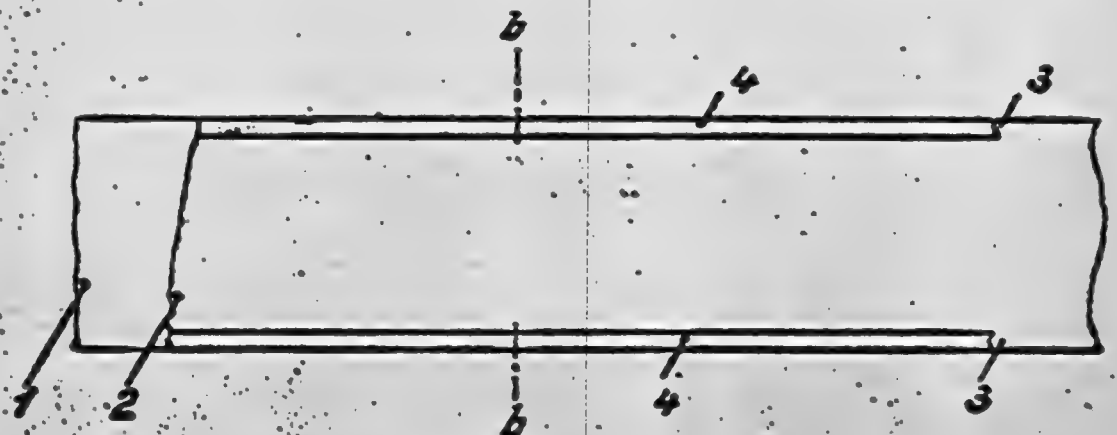


Fig. IV

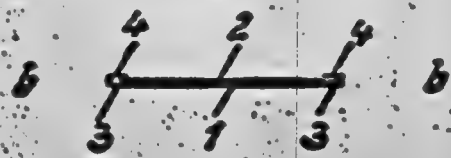


Fig. V

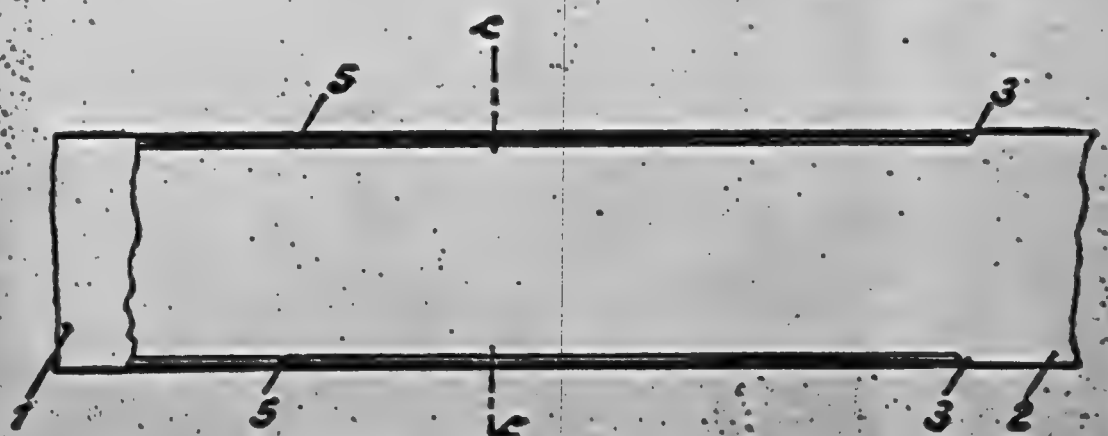
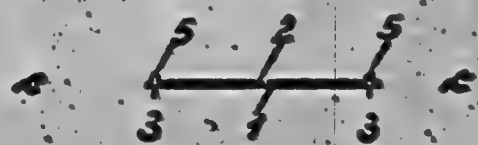


Fig. VI



TRANSLATION: GERMAN to ENGLISH.

PATENT Nr. 966,174 FEDERAL REPUBLIC OF GERMANY

INVENTOR: Richard Willi GRUENDEL, Hannover (Germany)
assigner to Firma GUENTHER WAGNER, Hannover

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INK RIBBON COVERED ON ONE SIDE AGAINST INK RELEASE

For particular purposes, such as for accounting machines and tabulating machines, it has become advantageous to use a second ink ribbon in the place of the conventional carbon paper to produce a duplicate imprint intended to be a "second original". With certain machines this second ribbon is guided across the machine behind the "first original", and with other machine systems it occupies this place in a stationary arrangement.

For such ribbons, which sometimes may more accurately be designated as ink screens, it is not only advantageous, but even necessary, that ink is released on one side only. With ink being released on both sides, not only the duplicate (the second original) would be imprinted, but also the reverse side of the first sheet.

Various attempts have been made in the past to cover one side of ink ribbons in order to restrict the ink release to the side opposite the type impact. Ink ribbons have thus been impregnated on one side or coated with suitable means. Such means have been applied through vulcanization or bonding. Inasmuch as thermoplastic plastic films have been used they were joined by thermoplastic bonding. In all of these cases an intimate bond between the ink ribbon and the covering means was obtained over the whole area, with the result that the ink-holding capacity, and consequently the productive output of the ribbons, was always

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from the original bound volume

reduced by a smaller or larger amount. Tissues with a coarser structure were used in most cases to compensate for this shortcoming, but this in turn resulted in a deterioration of the fineness of imprint.

It has therefore already been suggested to use for the above-stated purpose a conventional ink ribbon and running it through the machine together with another ribbon which is ink-free, or non-inked and possibly indifferent to ink, made of Cellophane (registered trademark), Gelatine, or a similar material, for example, and placed so that it faces the types. These ribbons could only be joined at both ends. The earlier-mentioned shortcomings did not show here, but certain problems arose instead with the ribbon transport itself, making it very difficult to get a clean "second original". Such difficulties, and the considerable shortcomings connected with them, were caused by a difference in lengths of the ink ribbon and the backing ribbon. This phenomenon has already been the cause for basic improvements applied to machines with dual ribbon transport (the guide buckle), but in the present case it cannot be met in an identical or similar manner. In addition, it has happened frequently that the two layers of ribbon would shift out of place when the ribbon was raised by the ribbon lifter.

It has been found that these problems can be solved in a very simple way by using a thermoplastic film to cover one side of the ink ribbon, joining this film to the ink ribbon, or ink screen respectively, by thermoplastic bonding on a very small strip along the longitudinal edges. The ink-carrying tissue on the entire surface of the ink ribbon, or ink screen, is thus covered by only a loosely touching film, yet, through thermoplastic bonding, this film is firmly joined at its borders to the tissue, thus preventing any shifting and assuring perfect

originals or duplicates. The intimate junction by thermoplastic bonding at the borders of the two ribbons (ink ribbon and film) eliminates the problems stemming from unequal lengths of ribbons, as there is actually only a single ribbon. In addition, the stiffness of the product achieved in this way assures a problem-free ribbon transport. Also, it is now possible to use the finest silk tissues which in turn produce imprints, the fineness and precision of which leaves nothing to be desired.

The thermoplastic bonding mentioned can be achieved in various ways, in accordance with the present invention:

1. The thermoplastic film is melted into the borders of the ink-carrying tissue.
2. A narrow ink-free strip of tissue is placed over the borders of the thermoplastic film to produce three overlaying layers at the borders of the ribbon: the ink-carrier, the cover film, and the strip of tissue. The three are firmly welded together under heat, resulting in a very clean and regular and resistant border, greatly facilitating work with the double ribbon.
3. A textile thread takes the place of the ink-free strip of tissue, otherwise using the method under 2. This, too, results in a very regular and clean and resistant border which is narrower still.

The drawing shows the subject of this invention in an exemplary way.

Fig. I shows an ink ribbon with a partially overlaying cover film, which is loose on its surface and joined at the borders only;

Fig. II shows a cross-section of the same ribbon at a-a;

Fig. III shows an ink ribbon and a cover film, both parts being joined thermoplastically by means of an overlaying narrow strip of tissue;

Fig. IV shows a cross-section of the same ribbon at b-b;

Fig. V shows an ink ribbon with a cover film, both parts having been joined thermoplastically by means of a textile thread;

Fig. VI shows a cross-section of the same ribbon at c-c.

In the figures, the numbers designate correspondingly:

1 the ink-carrying tissue, 2 the thermoplastic cover film, 3 the points, or strips respectively, of thermoplastic bonding, 4 the narrow ink-free strips of tissue, and 5 the textile threads used.

Finally, it must be mentioned that, if desired, any one of the joining methods of the present invention may be used on one side of the ribbon only, and that a combination of the possibilities mentioned may also be achieved by joining one border in accordance with one method and the other border in accordance with another method.

CLAIMS:

1. An ink ribbon, covered on one side by a thermoplastic film and joined to said film by thermoplastic bonding, characterized in that the film (2) is joined to the ink ribbon (1) along the borders (3) only.

2. An ink ribbon, covered on one side by a thermoplastic film as set forth in claim 1, characterized in that ink-free strips of tissue or textile threads are bonded to the cover film (2) alongside one or both edges, on the side which is facing away from the ink ribbon (1).

References to other printed materials:

US Patent Nr. 2,657,157

tive colours, and any capillary or similar transfer of either ink to the strip of the other colour would result in destruction of the colours and of the ribbon's utility. It has therefore been necessary to provide some kind of impervious barrier along the line of division between the strips, and then saturate the two fabric regions independently with their respective colours; or to use inks of mutually-repelling characteristics. The necessary operations are critical, difficult and expensive, and the process is far from infallible, leading to a considerable percentage of imperfect ribbons. The difficulties of the process also impose certain limitations on the nature of the inks employed, for example, upon the colour strengths which can be obtained.

In order to overcome this difficulty the invention further provides a ribbon consisting of two side-by-side independent fabric or like strips together having the total width of a conventional ribbon, these two strips being integrally connected along their common margin by a synthetic plastic heat-sealed connecting and saturant-isolating joint or seam.

This seam can be accomplished by the simultaneous severing and line-welding of a pair of superposed ribbons along their common median line, each of the severed halves of this "sandwich" thus yielding a composite ribbon having independent but connected lengthwise sections. Such sections may be thereafter independently saturated with inks of the respective colours, or the original ribbons forming the pair referred to above may have been individually inked prior to the severing and line-welding operation.

The invention will now be described by way of example with reference to the accompanying drawings, in which:

Figure 1 is a fragmentary perspective view of one form of the composite ribbon shown installed for use on a conventional typewriter,

Figure 2 is a perspective view, partly exploded and partly in section, of a portion of the ribbon shown in Figure 1,

Figure 3 is a view similar to Figure 2 showing a modified form of the ribbon,

Figure 4 is a view similar to Figure 2 of a further modification.

Figure 5 is a schematic perspective view of a known arrangement for producing single-colour ribbons which form a convenient starting material for the present invention,

Figure 6 is a transverse sectional view of a typical known single-colour ribbon produced by the arrangement of Figure 5,

Figure 7 is a similar sectional view showing the superposing of two ribbons of the Figure 6 type, and representing a first stage in the carrying out of one embodiment of the present invention,

Figure 8 is a similar view illustrating the simultaneous heat-sealing and severing of the superposed ribbons along a longitudinal median line of the superposed assembly,

Figure 9 is a schematic view, also in section, illustrating the separating and unfolding of two complete two-colour ribbons so produced,

Figure 10 is a similar sectional view illustrating the final unfolding and flattening of those two complete ribbons,

Figure 11 is a view similar to Figure 7 showing the invention applied to the making of a combined inking and error-obliterating ribbon.

Figure 12 is a view similar to Figure 10 of the product of the Figure 11 modification,

Figure 13 is a view similar to Figure 11 showing the possibility in some cases of eliminating a great portion of one of the layers, and

Figure 14 is a sectional transverse view of a product incorporating both inked fabric and carbon-printing sections.

Referring first to Figures 1 and 2 of the drawings, the former shows a composite effect (inking and correction) ribbon 10 installed in a usual form of typewriter having a roller platen 12 and ribbon vibrator 14. The ribbon 10 has (at least with reference to the side thereof facing the paper 16) separate vertically-spaced portions comprising a marking or inking section A and an obliterating or camouflaging section B. Both of these sections extend longitudinally the full length of the ribbon, and either section may be in the "upper" position when the ribbon is installed.

Figure 2 shows the construction of the ribbon 10 in greater detail. As there shown, the inking section 18 is constituted by an inked fabric strip having a width substantially one-half that of the whole ribbon, while the camouflaging section is constituted by a strip 20 of approximately the same width, preferably of paper carrying the camouflage transfer coating 22. These sections are held in edgewise-assembled configuration by being adhered to a common lengthwise strip 24 of very thin material, which may be a synthetic plastic such as "Mylar" (Registered Trade Mark), regenerated cellulose or the like.

The layers or sections 18 and 20 just described are secured to the strip 24 by an intervening adhesive indicated generally at 26. This adhesive may secure the layer 24 and the paper base layer 20 throughout their mutually confronting areas, but the inking ribbon 18 is secured to strip 24 only along its opposite edges, as otherwise the ink carried thereby would be "killed" or contaminated by the adhesive. The ink ribbon section 18 is protected from adhesion to the strip 24 for a major portion of the facial width of

PATENT SPECIFICATION

DRAWINGS ATTACHED

961,108

961,108



Date of Application and filing Complete Specification Feb. 7, 1963.

No. 5044/63.

Two Applications made in United States of America (Nos. 171963 and 171964) on Feb. 8, 1962.

Complete Specification Published June 17, 1964.

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Index at acceptance:—B6 F2A

International Classification:—B 41 j

COMPLETE SPECIFICATION

Improvements in or relating to Typewriter Ribbons and Methods of Manufacturing the Same

I, WILLIAM HOWARD WOLOWITZ, a citizen of the United States of America, of 1742 Holly Street, Northwest, State of Washington D.C., United States of America, do hereby declare the invention, for which I pray that a patent may be granted to me, and the method by which it is to be performed, to be particularly described in and by the following statement:—

This invention relates to ribbons for typewriting machines and to methods for fabricating ribbons.

The ribbons with which the invention is concerned are of the composite type (by which term is meant a ribbon having separate length-wise extending portions having different marking effects). For example, the portions may be inked or coated to transfer visible impressions of different colours to the writing paper, or one portion may be inked or coated to transfer a visible impression to the writing paper and the other portion may be capable of transferring a blank-out or camouflage material to the paper to cover up or obliterate an erroneous imprint and leave a surface suitable to receive a correct imprint, if desired.

One object of the invention is to provide a composite typewriter ribbon in which the portions are secured to one another by means forming a protective backing for the ribbon; such protective backing serving multiple functions which include the protection of the ink-depositing portion or portions from depletion or contamination, and of protecting the type faces of the typewriter against the build-up of ink or lint residues which normally require periodic removal.

The desirability of keeping the type faces of a typewriter clean and free from deposits of lint or ink is generally recognized, and inked fabric ribbons having a buffer layer on the type-face side have been proposed,

the buffer layer being for example an impervious synthetic plastic strip or deposit to prevent actual contact between the type face and the inked fabric. In a composite ribbon of the type having an inked portion and a camouflage strip, there is a special reason for such buffering or isolating layers. While the type faces never directly strike the camouflage substance carried on the opposite face of the composite ribbon, they would ordinarily strike the inked fabric, and any ink thus deposited on the type face might later be re-transferred to the back of the camouflage strip and thence be again transferred to the adjacent camouflage-face of the strip as the ribbon is reeled and re-reeled in the normal mode of ribbon winding in a typewriter. Ultimately, the camouflage substance itself will be darkened or deteriorated by this ink (or lint), and the life of the composite ribbon thus shortened. A protective or buffering layer for isolating the inked ribbon portion from the type faces thus also directly protects the integrity of the camouflage section, during normal use of a typewriter with a composite ribbon.

According to the invention there is provided a composite typewriter ribbon having two strips of which at least one is an inking strip, said strips being secured in length-wise side by side relationship to an ink impervious support strip, with the inking strip being attached to the support strip solely along opposite longitudinal edges of the inking strip.

Another problem met in the manufacture of composite ribbons has been the need for isolating or insulating the different marking or colouring components from one another. In the most typical case of a black and red typing ribbon, for example, lengthwise half-width strips of a single fabric ribbon are individually saturated with ink of the respec-

[Price 4s. 6d.]

the section 18, by an intervening protective non-absorbent layer 27, which again may be of "Mylar" (Registered Trade Mark), regenerated cellulose or the like.

5 A convenient method of making the composite ribbon of Figure 1 is to provide the common support 24 as a strip of so-called pressure-sensitive tape with the adhesive coated on side 28, and to laminate the camou-
10 flage strip 20 (already bearing its transfer coating 22) thereto during a continuous re-winding operation; and simultaneously feeding the inked fabric ribbon section 18 also into edge-adhered relation with the remain-
15 ing longitudinal portions of tape 24, while feeding the protective strip 27 therebetween to protect the major part of the ribbon against contact with the adhesive 26.

20 An alternative construction of a composite effect ribbon is illustrated in Figure 3 of the drawings. Here again the common mounting strip may be a length of tape 24 having adhesive layer 26 on one side, with the camou-
25 flage transfer section 20 adhered thereto. The inked fabric ribbon 30 is again of substantially half the vertical width of the assembly, but is provided previously with a protective layer 32 of thin "Mylar" (Registered Trade Mark) or the equivalent, which is fused to
30 the ribbon 30 solely along their common lengthwise boundary edges. In this case, the fabric of the ribbon 30 will be woven "Nylon" or equivalent fusible material, the edgewise adhesion being attained by a heat sealing
35 process well known to those skilled in the art.

Figure 4 of the drawings illustrates a modification of the Figure 3 construction which permits a multiplication of the ink-
40 containing capacity of the inked ribbon; for example, to increase the ink storage writing life of a composite-effect ribbon half of whose area is devoted to correction or camou-
45 flage material. In this case, a full-width inked ribbon 34 is doubled along its longitudinal centreline to form a half-width strip, and this half-width strip is fused to the protective layer 36 solely along the common
50 boundary edges of the strip and the protective layer.

Referring now to Figure 5 of the drawings, there is shown a known arrangement for producing single-colour printing ribbons from wide strips of fabric and synthetic
55 plastic barrier material. Briefly, a wide strip 110 of woven fusible fabric material such as "Nylon" (polyamide) or the like has superposed thereon a wide strip 112 of thin, tough, flexible, fusible synthetic plastic mem-
60 brane such as a polyamide film or the like. These superposed but unconnected layers are then fed, as a sandwich, over a suitable support 114 and cut into strips as by sharp knives or knife rollers 116 which are main-
65 tained at a sufficiently high temperature to

cause the materials at the severed edges of the resulting ribbon strips 118 to be fused to one another. One of the resulting ribbons is shown in Figure 6, comprising the fabric layer 110 and the loosely superposed syn-
70 thetic plastic lamina 112 the two layers being heat fused together along their common longitudinal margins as at 120 and 122.

In order to provide, for example, a two-
75 colour ribbon according to the present invention, there are first superposed two independent ribbons of the type shown in Figure 6. The fabric portions 110 and 110' of these ribbons may already have been saturated respectively with inks or equivalent materials
80 of the desired colours. However, as will appear, either or both of these ribbons may also be un-inked at this stage. Even if inked, the respective synthetic plastic barrier mem-
85 branes 112 and 112' will prevent any unwanted transposition or migration of the saturants at this stage of the process. The superposed ribbons in Figure 7 are shown slightly separated for clarity, but in practice they are held in contact with one another
90 during the next stage.

Figure 8 illustrates the following stage of the process, the upper ribbon of Figure 7 being designated by the letter "R" merely
95 to indicate that it may have its fabric layer then or thereafter saturated as with a red printing ink; similarly, the lower one of the two ribbons is designated by the letter "B" for black. In this Figure, the super-
100 posed ribbons are shown as being simultaneously severed along their longitudinal median lines as by a heated knife 124 co-operating with a support plate or roller 126. Conveniently, this operation may be
105 performed in a manner similar to that shown in Figure 5, the heated knife 124 being stationary or a sharp-edged disc or roller, between which and the plate 126 the super-
110 posed ribbons are fed. In the act of severing the ribbons, the heated knife simultaneously fuses the respective adjacent margins lying to either side of the sever-
ing plane.

Figure 9 illustrates schematically the con-
115 dition of the parts following the stage just described. What were therefore independent upper and lower "red" and "black" ribbons have now become independently side-by-side two-colour ribbons, one lateral half of a red ribbon having been longitudinally attached to
120 an underlying lateral half of a black ribbon. At the same time, the two sections forming the left ribbon in Figure 9 have been provided with the integral fused joint 128
125 which acts as a positive barrier against any migration of colouring matter or other saturant which was, or which may later be, applied to the side-by-side fabric halves. The right ribbon has this same fused joint at
130

Figure 10 illustrates the result of fully flattening out the two ribbons of Figure 9. These are shown adjacent one another with a small horizontal separation, to emphasize the relationship with respect to the showing in Figure 9, but it is obvious that the two independent two-component ribbons produced by the operation indicated in Figure 8 may be fed over entirely separate paths to suitable guiding and reeling mechanisms as well understood by those skilled in the art of ribbon manufacture. In all of the drawings, the thickness of the ribbon components has been exaggerated in the interest of clarity.

Where the two superposed ribbons of Figure 7 were not already saturated (in their fabric portions) with the respective colours, the ribbons shown in Figure 10 will of course have their fabric portions unsaturated. The heat-seamed or fused centreline region of each ribbon obviously permits the operation of applying the respective saturants to the ribbons, on opposite sides of that centreline, without any danger of intermingling of the colouring materials; either within the ribbon, or between different parts of the saturating equipment. For example, the saturant may be applied safely to the respective fabric portions by entirely separate applicators spaced lengthwise in the ribbon-feeding direction.

Since the making of multi-colour ribbons by this process utilizes full-width single-colour (or even un-inked) ribbons as a starting material, requirements for any combination of different colours can readily be met from a minimum inventory of fully manufactured single-colour ribbons. Also, the process provides a complete freedom from all limitations heretofore imposed by the known inking procedures, materials and equipment.

It will be observed that each of the ribbons produced as described above embodies the advantages of the laminar construction of single-colour ribbons such as shown in Figure 6. Both of the respectively coloured or saturated ribbon-strips are provided with the synthetic plastic lamina, for typing or printing machine cleanliness, improved ink storage capacity, and long operating life.

There is no essential reason why the superposed ribbons indicated in Figure 7 may not be superposed with their fusible fabric portions in contact. This is particularly evident for the case in which the fabric portions have not been inked at that stage. Such a variation is, of course, not excluded from the scope of the invention, the resulting product being indistinguishable after the ribbons have been unfolded and flattened.

The method as described above is generally applicable where an ink or saturant barrier is required between two strips of a ribbon; not only to prevent migration of ink from

one strip into a different kind of layer on the other strip, but also to prevent ink migration into the material of such other strip. Thus, the two-component ribbon may carry printing ink on one longitudinal strip, and a coating of transferable "camouflage" material on the other strip, to provide a combined printing and error-correcting ribbon for typewriters or the like.

In Figure 11, there is shown the superposition (in a manner similar to the showing of Figure 7) of a paper or synthetic plastic support 132 having a coating 134 of the transferable material such as error-obliterating or camouflage material, and the protective film 112 edge-welded thereto, and a second ribbon including the inked or inkable fabric strip 110' having a similar protective film layer 112'. After the simultaneous severing and heat-seaming operation carried out exactly as shown in Figure 8, the result is the pair of composite ribbons shown in Figure 12.

Each of the duplicate ribbons so illustrated comprises a longitudinal strip of the camouflage carrying support, welded to a fabric strip which is or may thereafter be inked. The longitudinal barrier seams are again indicated at 128 and 130.

It is not essential, for all purposes, that both the "fabric" and the membrane be of fusible material; where only one is fusible, it is of course necessary that the fusible materials be adjacent one another in the stages of Figures 7 and 8. For example, what has been denoted as a saturable fabric 110 and 110' may be a paper support, or a non-fabric carrier for a waxy (carbon paper) ink deposit; or, as indicated, a support for a camouflage material which may be a white pigment for making corrections on white paper.

The isolating membrane, where employed, may also be applied to only one of the ribbons 110, 110', so long as it will successfully seal to the materials of both of such ribbons. The criterion in all cases is the "mutual" heat-sealing properties of the layers involved. Thus, for woven fabric ribbons, the fabric material need not be fusible, but may be silk or cotton and so on, to which the synthetic plastic membrane is readily attachable in the manner described. Obviously, the original ribbons need not be severed and sealed along a median line; the line may be shifted sidewise to yield multi-component ribbons having more area to one side of the division line than to the other.

Figure 13 shows a modified "pile-up" as in Figure 7, but in which only a small, median strip of the material 112 is applied to the support 132 since the layer 112' provides any required surface barrier for the strip 110'. The narrow strip 112 adhered

to the support 132 ensures a good fused joint at the seamed-and-severed edges.

In Figure 14, there is illustrated a single composite ribbon one-half of which is a conventional ink-saturated woven fabric 136 with an impervious layer 138 edge-welded thereto. The other half is a synthetic plastic, such as "Mylar" (Registered Trade Mark), tape 140 carrying a waxy colour deposit 142 such as used in so-called carbon paper ribbons. The two halves are joined by a fused edge joint by a process perfectly analogous to that already described, from a pile-up of one full-width saturable ribbon and one full-width "Mylar" (Registered Trade Mark) tape, to yield two composite ribbons of the type shown in Figure 14.

WHAT I CLAIM IS:—

1. A composite typewriter ribbon having two strips of which at least one is an inking strip, said strips being secured in lengthwise side by side relationship to an ink impervious support strip with the inking strip being attached to the support strip solely along opposite longitudinal edges of the inking strip.

2. A ribbon as claimed in claim 1, wherein a continuous protective layer is disposed longitudinally between the support strip and at least a major portion of the area of the inking strip.

3. A ribbon as claimed in claim 2, wherein the protective layer is adhered to the support strip.

4. A ribbon as claimed in claim 2 or claim 3, wherein the protective layer is integrally secured to the edges only of the inking strip.

5. A ribbon as claimed in any of claims 2, 3 or 4 wherein the protective layer is constituted by a strip of ink impervious material.

6. A ribbon as claimed in any one of the preceding claims wherein the inking strip comprises a strip of material folded along a lengthwise line to define a multi-ply layer.

7. A ribbon as claimed in any one of the preceding claims, wherein the inking strip is constituted by a fabric strip saturated with ink.

8. A ribbon as claimed in any one of the preceding claims, wherein the second strip is a camouflage-depositing strip.

9. A composite typewriter ribbon comprising individual lengthwise strips connected together along a common margin of each by an ink impervious line-weld.

10. A ribbon as claimed in claim 1, wherein the two strips are connected together along a common margin of each by a line-weld along the ink-impervious support strip.

11. A ribbon as claimed in claim 10, wherein the support strip is secured to the

strips along their respective outer margins and along the line-weld.

12. A ribbon as claimed in claim 10 or claim 11, wherein the strips comprise individual lengthwise strips of heat-sealable material and the fused common marginal edges provide an inter-strip barrier against migration of saturants from one strip to another.

13. A ribbon as claimed in claim 10 or claim 11, wherein the strips comprise individual lengthwise strips of woven fusible material and the fused common marginal edges provide an inter-strip barrier against migration of saturants from one strip to the other.

14. A method of making a two-component printing ribbon for type printers and the like, comprising making a pair of ribbons each including an inkable strip and an overlying edge-welded support layer, superposing said ribbons in face-to-face contact with one another, simultaneously severing the superposed ribbons into two longitudinally extending partial-width ribbon strips of double thickness while edge-welding together the margins of the common severed edges, and flattening out the respective ribbon strips to provide a pair of full-width ribbons each longitudinal strip of which is composed of the inkable strip and overlying support layer of a portion of one of said original ribbons, with a fused ink barrier mechanically connecting said strips but isolating them against saturant migration.

15. A method of making a two-component ribbon, comprising making a pair of single-component ribbons, superposing said ribbons in face-to-face contact with one another, simultaneously severing the superposed ribbons into two longitudinally extending partial-width ribbon strips of double thickness while edge-welding together the margins of the common severed edges, and flattening out the respective ribbon strips to provide a pair of full-width ribbons each longitudinal strip of which is composed of a portion of one of said original ribbons, with a fused ink barrier mechanically connecting said strips but isolating them against saturant migration.

16. A method of making a two-component printing ribbon, comprising edge-welding two longitudinal strips of material which are mutually heat-sealable and in face-to-face contact with one another, to provide a fused saturant barrier along the line of said edge-welding.

17. A composite typewriter ribbon substantially as hereinbefore described with reference to and as illustrated in Figures 1 to 4 and Figures 7 to 14 of the accompanying drawings.

18. A method of making a composite typewriter ribbon substantially as hereinbefore

described with reference to and as illustrated in Figures 1 to 4 and Figures 7 to 14 of the accompanying drawings.

WILLIAM H. WOLOWITZ,
Per: Boulton, Wade & Tennant,
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Chartered Patent Agents.

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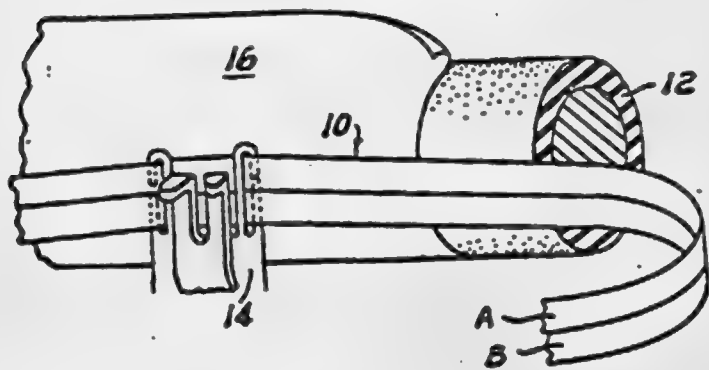


Fig. 1

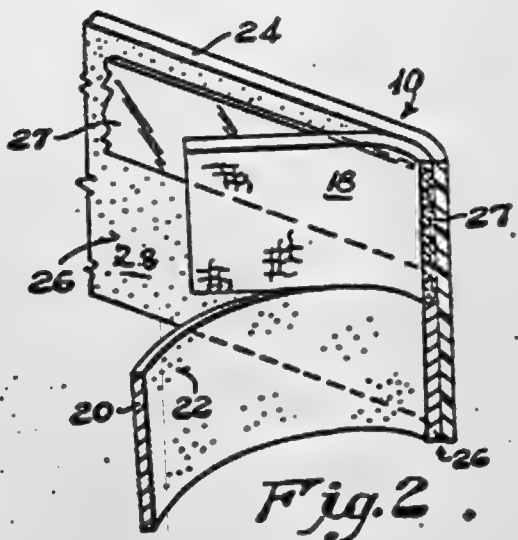


Fig. 2

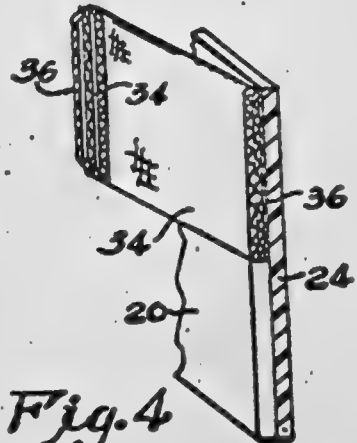


Fig. 4

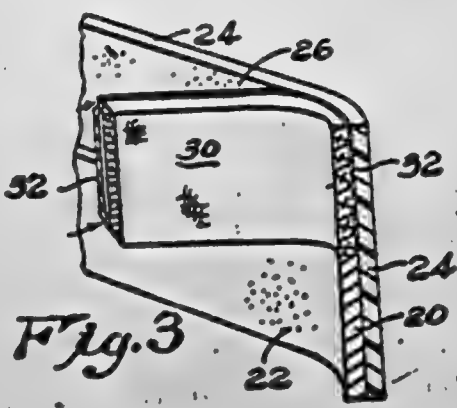


Fig. 3

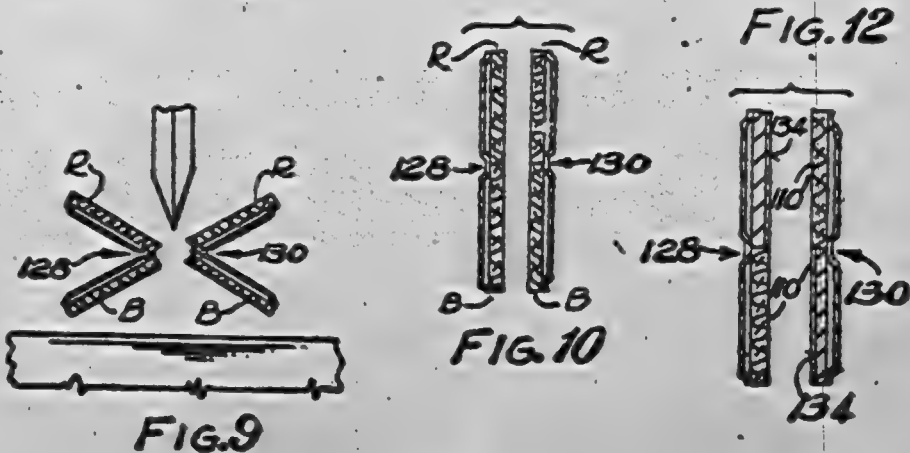
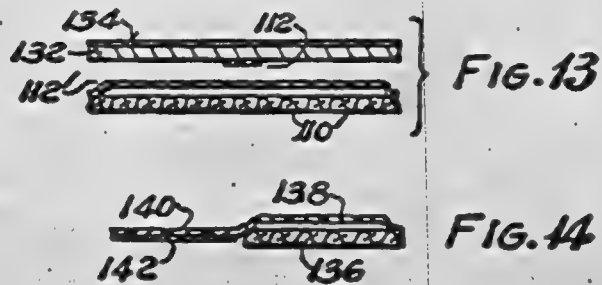
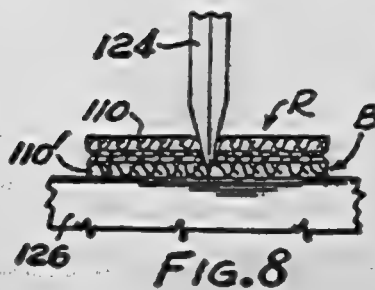
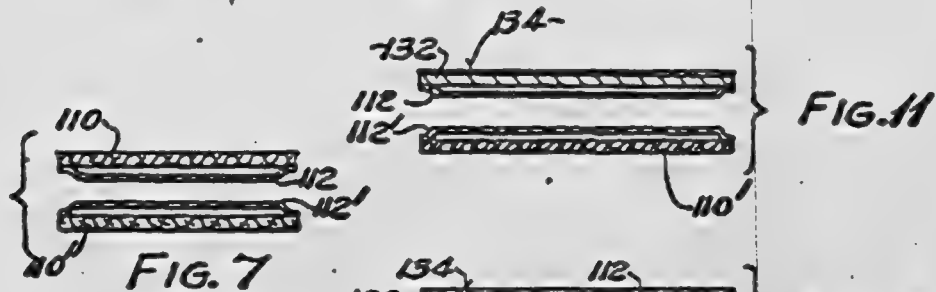
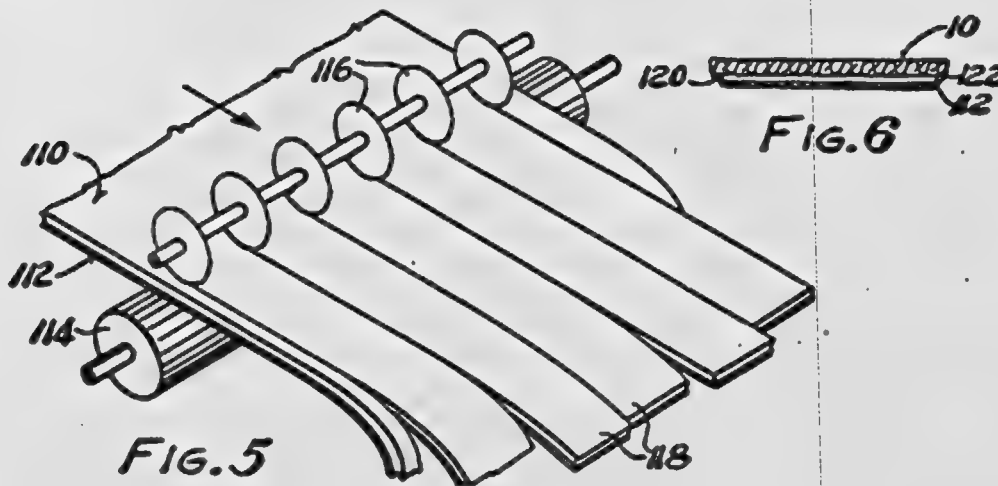
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COMPLETE SPECIFICATION

2 SHEETS

This drawing is a reproduction of the Original on a reduced scale

Sheets 1 & 2



IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.)

Plaintiff)

v.)

Civil Action No. 1514-63

SPELLRIGHT CORP.,)
et al.)

Defendants.)

OFFICIAL TRANSCRIPT

OPINION OF THE COURT

DATE: October 9, 1967

PAGES: 1 - 18

KATHERINE K. BYRHOLDT

Official Reporter

4824 U. S. Court House

Washington 1, D. C.

STerling 3-5700 Ext. 292

Copy for:

Plaintiff's Counsel
(Mr. Gonda)

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.)

Plaintiff)

v.)

Civil Action No. 1514-63

SPELLRIGHT CORP.,)
et al.)

Defendants.)

Washington, D. C.

Monday, October 9, 1967.

The above-entitled cause came on for further trial
before the HONORABLE ALEXANDER HOLTZOFF, UNITED STATES
DISTRICT JUDGE, at 10:09 a.m.

Appearances:

For the Plaintiff:

MORTON ROBSON, ESQ. and
EDWARD C. GONDA, ESQ.

For the Defendants:

WILLIAM D. HALL, ESQ.

OPINION OF THE COURT

P R O C E E D I N G S

*

*

*

HOLTZOFF, J.: This is an action arising in part out of the patent laws and in part involving an improper revelation of a trade secret.

The principal cause of action is one for patent infringement, contained in the first count of the complaint.

The patent claimed to be infringed is a patent to W. Ploeger, Jr., No. 3,010,559, issued on November 28, 1961. The title to this patent was assigned to the plaintiff by mesne assignments.

The name of the invention as given in the patent is for a "Printing Ribbon."

The invention consists of a specific type of printing ribbon, namely, a ribbon consisting of two layers; one being a layer of material that absorbs the ink, and the other being a layer of nylon film lying back of the first layer. The two layers are fused together solely along their extreme elongated edges.

There are two principal issues. The first is whether the patent is valid, and the second is whether the patent is infringed.

The defendants claim that the patent is invalid

in the light of the prior art, in that the step taken by the inventor does not constitute the product of the inventive faculty but merely the result of mechanical skill by a person who is reasonably skilled in the art.

No doubt the inventor had a desirable and a constructive and useful idea. Unfortunately, the hopes and aspirations of many a worthy inventor are frequently dashed to pieces when it is discovered that, unbeknownst to him, someone else had previously trodden the same path and had made the same discovery and contribution to the sum of human knowledge.

In this respect, of course, the patent law differs from the law of copyright. A person has to be the first inventor as well as the original one in order to be accorded or granted the monopoly of the patent involved. That is as far as patent law extends. The discovery of the activities of a prior inventor is a disaster that brings grief to many a person who feels that he has conceived a new and novel invention; and if he gets a patent, the patent just keeps the word of promise to his ear and breaks it to his hope.

In the course of the prosecution of the application for a patent, a number of items of prior art were cited

by the Examiner as bases for the rejection of the application.

In a recent case in the Court of Customs and Patent Appeals, Application of Winslow, 365 F.2d 1017, 1020, Judge Rich of that Court gave a very graphic and vivid explanation of how to analyze prior art in connection with determining the validity of a patent. He said:

"We think the proper way to apply the 103 obviousness test to a case like this is to first picture the inventor as working in his shop with prior art references -- which he is presumed to know -- hanging on the walls around him."

The principal patent cited by the Examiner in the course of the prosecution of the application was the patent to Phelps, No. 2,044,630, issued on June 16, 1936. At a later stage of the proceeding in the Patent Office, a patent to Francis, No. 2,657,157, issued on October 27, 1953, was cited.

Each of those two patents disclosed a ribbon consisting of two strips or layers, one an inking ribbon and the other a shielding strip, attached together.

It was apparently the view of the Patent Office that these two patents met Claim 1 of the application in its

original form. That claim read as follows:

A ribbon comprising an elongated strip of flexible, pliable, absorbent material, an elongated strip of flexible, pliable, impervious material, said strips being in juxtaposed surface-to-surface relation along their entire length and sealed together along their elongated edges.

Phelps disclosed a structure in which the two strips or layers were fastened together at intervals.

Francis described a structure in which the two layers were joined together adhesively by a portion of their own substance.

The applicant for the patent in suit then differentiated his application from these two references by narrowing his claim down to the feature of fusing the two elements or layers together solely along their edges.

With that limitation, the patent was granted.

The result is that the first claim of the patent in suit was modified, in order to secure favorable action, to read as follows:

A printing ribbon comprising an elongated strip of flexible, pliable, absorbent woven nylon, an elongated strip of a flexible, pliable, imperforate ink, impervious

nylon film, said strips being in juxtaposed surface-to-surface relation along their entire length, and fused together only along their extreme elongated edges, and within the absorbent woven nylon strip being impregnated with ink.

In other words, the patent actually granted is a very narrow one, and is limited to a ribbon consisting of an absorbent nylon strip and an impervious nylon film, fused together only along their extreme elongated edges.

The inventor cannot claim any more than the narrow claim that he accepted, obviously, as a condition of the granting of his patent.

It is well established that what is surrendered by an applicant in the course of the prosecution of his application in the Patent Office cannot later be recaptured by construction.

This principle of law was summarized by Mr. Justice Stone in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211. At page 220, he said:

"It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed

cannot by construction be read to cover what was thus eliminated from the patent." Cases cited.

Then he continued:

"The patentee may not, by resort to doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer."

Of course we are confronted with a very narrow patent, receiving its life solely from the one limited feature of fusion along the edges, and solely along the edges, of the two strips.

The defendant relies on a German patent to Gruendel, No. 966,174, issued on June 27, 1957.

The defendant claims that this feature which was the carrying element of the plaintiff's patent was disclosed by Gruendel.

The Gruendel patent was not cited by the Patent Office. Thus circumstances give it greater weight than a citation referred to by the Patent Office which was overcome by the applicant in the course of the prosecution at the Patent Office.

It is no reflection on the Patent Office, because it happens very frequently, that the original search in the

Patent Office did not lead to the discovery of this German patent.

Gruendel refers to the fact that inked ribbons, consisting of more than one layer, had been used in the past, and he states that:

"In all of these cases an intimate bond between the ink ribbon and the covering means was obtained over the whole area."

He indicates as an element of his invention that the two layers, the inked ribbon and a thermoplastic film, should be bonded together thermoplastically on a very small strip along the longitudinal edges.

He states further that Figure 1 of his patent "shows an ink ribbon with a partially overlaying cover film, which is loose on its surface and joined at the borders only."

His claim likewise points to this feature as being the carrying element of the invention.

Claim 1 reads as follows:

"An ink ribbon, covered on one side by a thermoplastic film and joined to said film by thermoplastic bonding, characterized in that the film (2) is joined to the ink ribbon (1) along the borders (3) only."

It is clear, therefore, that the carrying elements

of Ploeger's invention, and the basis on which he was awarded his patent had been previously disclosed and emphatically disclosed by the German patent to Gruendel that was issued several years prior to the time that Ploeger made his application for a patent in the United States.

To be sure, the Gruendel patent does not refer to nylon. The only material referred to in the text of his patent is silk, as being the material of which the ribbons are to be made.

The Court reaches the conclusion, however, that in view of the fact that nylon was being developed in the intervening years for various uses, and in view of the fact that nylon is referred to in the patent to Francis and others in the prior art, that it was obvious to substitute nylon for silk; and that, therefore, the step taken by Ploeger is not a product of the inventive faculty but merely the result of the mechanical skill of a person ordinarily skilled in the art.

The mere fact that Gruendel might have been working on a different problem than the one in which Ploeger was interested and that possibly he did not foresee all of the uses and the benefit of the step that he took, if it be true, does not detract from the value of his patent as a grant of a monopoly or as an anticipatory reference.

This Court had occasion to refer to this matter in another connection. In *Werner v. Watson*, 128 F. Supp. 471, 472, the Court stated:

"Patents, however, are granted on structures rather than on ideas under our patent law, and the mere fact that an inventor is unable to foresee the possibilities of the structure that he devises does not detract from its force and effect as prior art.

"Perhaps one of the most striking illustrations of this principle is found in the case of *Radio Corporation of America v. Radio Engineering Laboratories*, 293 U.S. 1, at page 14. That celebrated case involved the prolonged litigation between De Forest and Armstrong over the right to priority of invention of the so-called feed back radio circuit. The fact that De Forest's work was earlier than Armstrong's was not disputed. It was claimed, however, that De Forest's work should not receive full weight because he did not realize what the circuit that he accidentally hit upon could be used for and practically laid it to one side. The Supreme Court held that this was immaterial and awarded the palm of victory to De Forest."

I might add that in that litigation it appeared

that De Forest was working on an entirely different problem than Armstrong. And yet he was awarded priority.

The Supreme Court, in the decision in which that long history culminated, *Radio Corporation of America v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1, at page 14 indicated that it was immaterial that the inventor was unaware of the potencies and values more important than the uses which were immediately apparent and that these potencies and values were dimly apprehended.

The Supreme Court concluded with this statement:

"The benefit of all alike belonged to the inventor."

The Court, therefore, reaches the conclusion that, for the reasons summarized, the Ploeger patent is invalid, in that, in light of the prior art, the additional step taken by the inventor was obvious and not the product of inventive faculty.

There remains now the question of infringement.

This Court is of the opinion that it is sound judicial administration for a trial court to pass upon all of the principal issues of a case instead of disposing of it on one issue, if it can be done.

The reason for that is obvious. The Court had

occasion to do that in the past two or three weeks in an action pertaining to an entirely different field.

Several years ago in a patent infringement case, *Trenton Industries v. A. E. Peterson Manufacturing Co.*, 165 F. Supp. 523, at page 529 the Court said:

"It is the view of the court that while this conclusion" -- namely, adjudication of the invalidity -- "might in itself be sufficient to dispose of the first count of the complaint, it is desirable, generally, for a District Court, whenever possible, to dispose of all of the issues of the case, for reasons that are obvious. Consequently, the court will proceed to determine the issue of infringement, that is, whether the defendant must be deemed to have infringed the patent if the patent were held valid."

On this basis, the Court will proceed to adjudicate this issue, that is, the issue of infringement.

Two exhibits were introduced by the plaintiff which originated from the defendant. Each of these exhibits was a ribbon that apparently was being sold by a customer of the defendant.

The ribbon consisted of two halves, One half of the ribbon was what is known as a correcting strip, to be

used for the purpose of making corrections. The other half was a printing strip, consisting of a nylon fabric backed by nylon film, fused together at the edges.

The Court concludes that this structure reads on the plaintiff's patent.

The mere fact that something else was added, namely, the correcting strip to the original structure covered by the plaintiff's patent, does not save the structure from a charge of infringement if the charge otherwise can be sustained.

In *Marston v. J. C. Penney Company, Inc.*, 353 F.2d 976, the Court of Appeals for the Fourth Circuit said:

"One cannot avoid infringement by an addition to a patent, even though the addition is important to the use intended for the resulting article."

It is claimed, however, on behalf of the defendant that during the period in which the defendant is charged with infringing the plaintiff's patent that the defendant had on hand a great deal of material which it had purchased from the plaintiff.

Obviously, the use of that material cannot constitute and does not constitute infringement.

It is also admitted by the defendant that, in

addition to articles so manufactured, the defendant manufactured other ribbons out of materials that were purchased elsewhere.

It is claimed by the defendant that the ribbons in this last group did not infringe the patent. However, no specimens of the ribbons of this last class were produced, and the Court cannot dismiss the charge of infringement on any such basis as that at this time.

The question of damages for infringement is one for accounting, and the Court will not pass upon it at this time. It merely concludes that the two specimens of the defendant's products produced at this trial do read upon the plaintiff's patent.

The Court is not in a position to determine at this stage of the litigation -- and it may not be necessary to decide at all -- whether those specimens were fabricated out of material originating from the plaintiff or out of material purchased by the defendant elsewhere.

As stated before, those are matters to be considered if accounting should follow, and only then.

Accordingly, the Court will render judgment on the merits in favor of the defendant on the first cause of action in the complaint, in view of the fact that the patent is adjudicated invalid.

The second cause of action is one for false marking, under Title 35, United States Code, Section 292.

That statute provides as follows in subsection (a):

"Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the word 'patent,' 'patentee,' or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee, shall be fined not more than \$500.00 for every such offense."

Subsection (b) provides that:

"Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States."

The specific charge under this section is that the defendant, in selling its typewriter ribbons, distributed a leaflet containing the following statement, "Patented Construction backing keeps type clean."

It should be noted that neither the name of the patentee nor the number of any patent is stated. There is

no imitation of the name of a patentee or any counterfeiting or imitating of his mark.

The evidence leads the Court to the conclusion that there was no intent either to counterfeit or imitate the mark of the patentee to deceive the public or to induce the public to believe that a "thing was made or sold by or with the consent of the patentee."

It should be borne in mind that this statute is a very drastic one. It is a penal statute.

The Court is of the opinion that a cause of action has not been made out and will render judgment in favor of the defendant on the merits on the second cause of action.

The third cause of action involves the alleged breach of a trade secret. It is claimed that the plaintiff disclosed a trade secret to the defendant which the defendant improperly used.

Both the plaintiff and the defendant are business concerns. The defendant is a customer of the plaintiff.

The plaintiff's principal business is cutting ribbon from fabric for manufacturers who, in turn, fabricate the ribbon into its ultimate uses.

Accepting the plaintiff's testimony, the defendant

came to him, and in the course of a conversation mentioned to him that he was having difficulty in fusing the two elements of the ribbon together. The plaintiff then told him that he had a way of doing it, and showed him a method of using what is called the "hot knife," that is a knife raised to a very high temperature by electricity, cutting the ribbon with that knife, and at the same time heating it to a point where it melts and the two elements become welded.

It is claimed that after this disclosure the plaintiff asked the defendant to keep the matter confidential. The fact of this request is denied. However, even if it were made, obviously it cannot be construed to mean that the defendant should not use this process, for the very purpose of disclosing it was to help the defendant in its own business, the defendant being a customer of the plaintiff.

The most favorable construction, from the plaintiff's standpoint, that can be placed upon the request was that the defendant should not disclose it to other persons and make this process public, because the plaintiff was intending to apply for a patent.

Under those circumstances, there is no violation of a trade secret in this case, and the Court will render judgment on the merits in favor of the defendant on the

third cause of action.

This opinion will constitute the findings of fact and conclusions of law.

Counsel may submit an appropriate order.

*

*

*

In The United States District Court for the District of Columbia

CERTIFICATE OF OFFICIAL COURT REPORTER

I, Katherine K. Byrholdt, official court reporter for The United States District Court for the District of Columbia, do certify that the foregoing is the official transcript of the proceedings had in said Court in C. A. 1514-63, *Film on Process Corp. v. Spellbright Corp., et al.*, on 10-9-67, pp. 1-18, *with*.

Katherine K. Byrholdt
Official Court Reporter

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

ETHICON PROCESS CORPORATION, :
Plaintiff, :
v. : C. A. No. 1514-'63
SPELLRIGHT CORP., et al., :
Defendants. :

FINAL JUDGMENT

This cause having come on for trial before the Court sitting without a jury, the parties having stipulated waiver of the right of trial by jury; was tried from October 2 to 6, 1967; was duly submitted to the Court for consideration and decision; and the Court, after due deliberation having rendered its oral opinion on October 9, 1967;

HON, THEREFORE, pursuant to said opinion, which includes the Court's Findings of Fact and Conclusions of Law, and which is incorporated herein by reference, it is

ORDERED, ADJUDGED AND DECREED, that:

1. Claims 1 and 2 of United States Patent #3,010,539 to Walter Ploeger, Jr., which was assigned to Plaintiff, is hereby declared invalid, and the Complaint is dismissed with prejudice as to each and every count thereof.

2. Plaintiff is to pay the taxable costs of this action.

ENTERED this 20 day of October, 1967.

Holtzoff

JUDGE

Approved as to form:

Irvin A. Lavine
Attorney for Plaintiff

Attorney for Defendants

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORPORATION,	:	
Plaintiff,	:	
v.	:	C. A. No. 1514-'63
SPELLRIGHT CORP., et al.,	:	
Defendants.	:	

NOTICE OF APPEAL

Notice is hereby given that Filmon Process Corporation appeals to the United States Court of Appeals for the District of Columbia from the final judgment in this action on October 20, 1967.

IRVIN A. LAVINE
Attorney for Appellant

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

FILMON PROCESS CORP.,

Plaintiff,

v.

SPELLSIGHT CORP.,

et al.,

Defendants

:

:

:

:

:

Civil Action

No. 1514-62

O R D E R

WHEREAS, the Court of Appeals for the District of Columbia Rule 12(b) requires the transcript of testimony to be filed with the Court of Appeals within twenty days after filing Notice of Appeal,

WHEREAS, the appellant, Filmon Process Corp., will not be able to file the transcript within such twenty day period which expires on December 6, due to the fact that the court reporter is presently occupied on criminal cases and has indicated that the transcript will not be completed prior to that time, but will be completed no later than December 20, 1967.

NOW, THEREFORE, IT IS ORDERED that appellant shall have up to and including December 21, 1967 within which time to file with the Clerk of the District Court the transcript of the testimony.

Judge

Approved and Consented To:

Irvin A. Lavine
Attorney for Plaintiff

William D. Hall
Attorney for Defendants

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA

Appeal No. 21527

257

FILMON PROCESS CORPORATION,
Appellant,

v.

SPELLRIGHT CORPORATION, *et al.*,
Appellee.

BRIEF FOR APPELLANT

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA

FEB 18 1968

IRVIN A. LAVINE,
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Noted
EDWARD C. GONDA, Esq.,
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Philadelphia, Pa. 19110,
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Statement of Questions Presented.

Question 1

The question is whether in a patent infringement suit the Court applied the correct legal standard when it ruled that the statutory presumption of validity is only entitled to "lip service" and that the burden of proof to invalidate the patent in suit is a mere preponderance of the evidence which need not be clear and convincing.

Question 2

The question is whether the Court applied the correct legal standard with respect to the prior art reference, German patent No. 966,174 to Gruendel, and whether it is vague, indefinite, and when taken as a whole teaches anything different from the file wrapper references.

Question 3

The question is whether as a matter of law the prior art reference, German patent No. 966,174 to Gruendel, was properly interpreted and when taken as a whole, can be modified by the Francis patent to render the claimed invention obvious without resorting to invention.

Question 4

The question is whether unexpected, unexplainable results, on which the Court made no findings, satisfy the requirements of patentability.

Question 5

The question is whether in a patent infringement suit the Court applied the correct legal standard when it held

that the patent in suit received its life solely from one limited feature on the basis of file wrapper estoppel and then found that the feature is taught by a non-file wrapper reference.

Question 6

The question is whether in a suit for false marking under 35 U. S. C. 292, evidence showing authorized and then non-authorized usage of the phrase "Patented Construction Keeps Type Clean" by defendants, who had no patent at the time of unauthorized usage; coupled with defendants' repeated requests for a license under the patent in suit, which plaintiff refused, and defendants' assertion that they would "infringe and break" the patent in suit; created a presumption of intent to deceive requiring defendants to go forward with plausible evidence refuting the presumption.

Question 7

The question is whether in a suit for false marking under 35 U. S. C. 292 plaintiff is required to show defendant's statement or imitation of the name of a patentee, or the number of a patent or the counterfeiting or imitation of a patentee's trademark, or whether the false use of the word "Patented" with the intent of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee constitutes a violation of the statute.

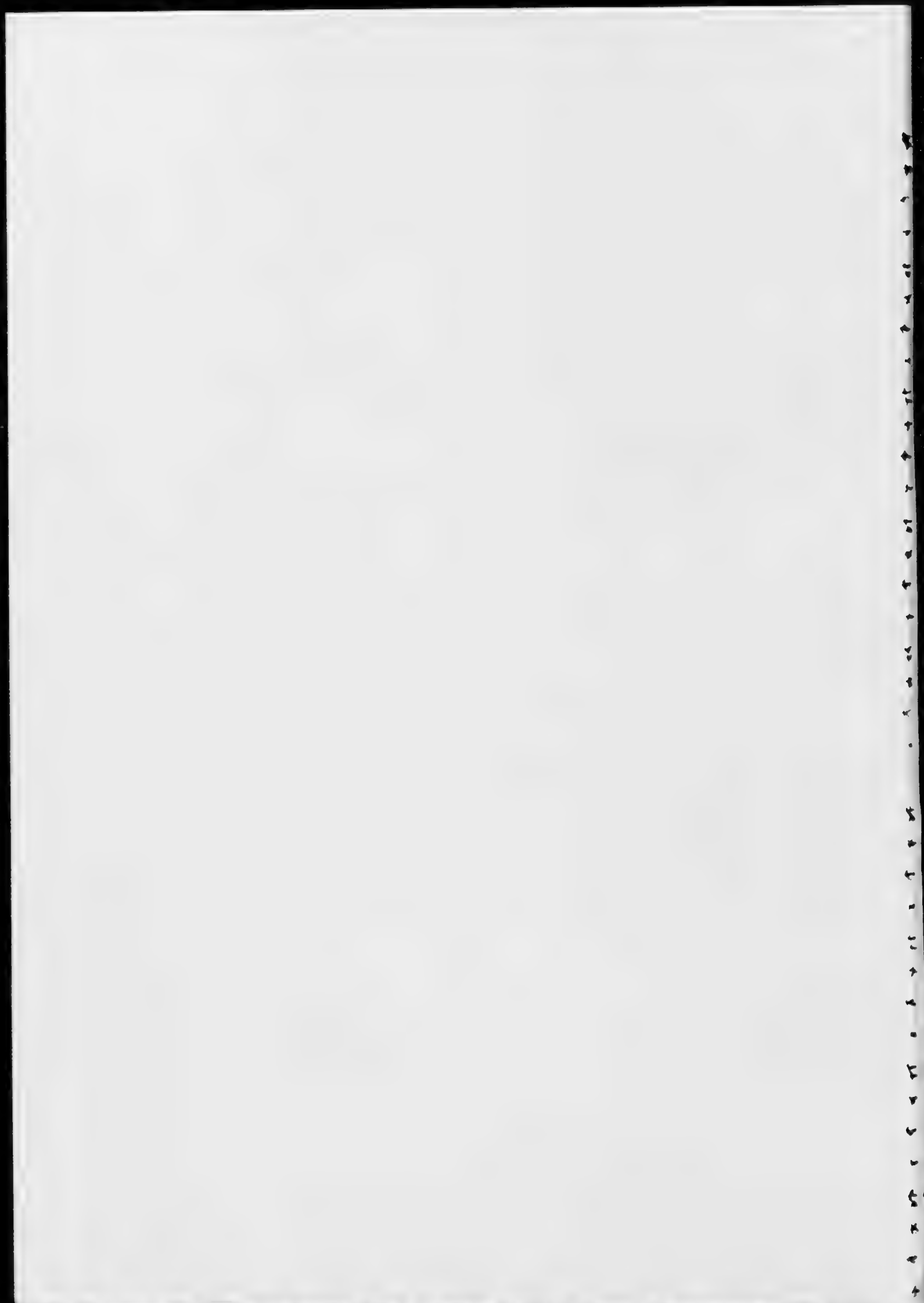
Question 8

The question is whether, in a suit for unfair competition, the relationship between the parties of one being a

buyer and the other a seller of services required as a matter of law that the buyer can use in its business confidential information received from the seller whereby the buyer no longer needs the services of the seller.

Question 9

The question is whether a recipient of confidential information breaches the confidential relationship against disclosure when he applies for a patent which issues disclosing the confidential information.



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II.

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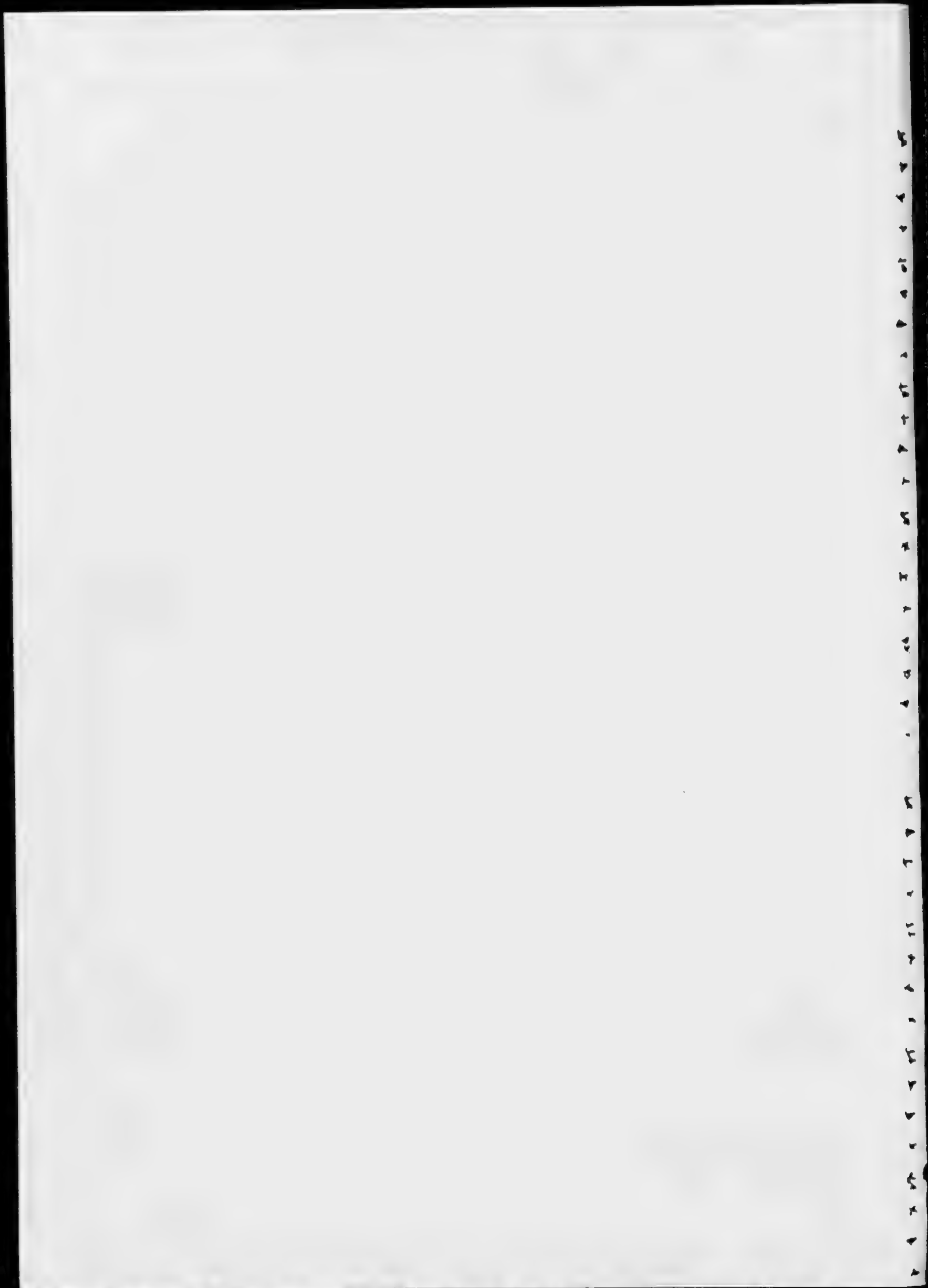
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III.

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IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA

Appeal No. 21,527

FILMON PROCESS CORPORATION,
Appellant,

v.

SPELLRIGHT CORPORATION, *et al.,*
Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA

BRIEF FOR APPELLANT

Jurisdictional Statement.

This is a civil action for patent infringement, false marking and breach of confidential disclosure. Plaintiff is a New York corporation having a place of business in New York, New York. The defendant, Spellright Corporation, is a District of Columbia corporation having a place of business in Washington, D. C. The defendant, William H. Wolowitz, is President of defendant, Spellright Corporation.

Jurisdiction was vested in the District Court by virtue of Title 35 of the United States Code, 28 U. S. C. 1338(a)

and (b), and there is complete diversity of citizenship of the parties with the amount in controversy exclusive of interests and costs being in excess of Ten Thousand Dollars.

Statement of the Case.

The Complaint charges defendants with infringement of Letters Patent 3,010,559, false marking of their goods as being patented, and for breach of a confidential relationship. All three counts are directed to the same ribbon made and sold by the defendants.

The opinion supporting the judgment appealed from is reported at 274 F. Supp. 312.

The Patent in Suit

The patent in suit is United States Letters Patent No. 3,010,559 dated November 28, 1961 to Walter Ploeger, Jr., (pl. ex. 2). Plaintiff is the owner of this patent by virtue of an assignment recorded in the United States Patent Office, (pl. ex. 4, Tr146). Mr. Walter Ploeger, Jr. is an officer of plaintiff (Tr109). The patent in suit is directed to a printing ribbon and is used in typewriters and other machinery. Claim 1 of the patent in suit reads as follows:

"A printing ribbon comprising an elongated strip of flexible, pliable, absorbent woven nylon, an elongated strip of a flexible, pliable, imperforate ink, impervious nylon film, said strips being in juxtaposed surface-to-surface relation along their entire lengths, and fused together only along their extreme elongated edges, and within the absorbent woven nylon strip being impregnated with ink."

History of the Art

The efforts of designers over the years to produce a commercial printing ribbon which prevented the keys from

contacting the inked portion have been unsuccessful. The need or desirability for such a ribbon is apparent from the patents of record herein for a period of forty years. In the pretrial statement, defendants enumerated eighteen patents. There is no evidence whatsoever that any of the references relied on by defendants was ever built and sold commercially.

The prior art shows pasting or melting a thermoplastic film to join it to a fabric. The inventor of the patent in suit tried these methods and found them unsatisfactory. The ribbons either curled (Tr117) or there was no seal along the edges (Tr118).

The prior art suggests that the joint be across the full width (Francis) or that the joint be a narrow edge portion (Phelps).

The prior art suggested that the inked layer be a textile fabric, silk fabric, silk tissue and paper or non-woven materials.

The prior art ribbons are either typewriter ribbons or manifold ribbons. A manifold ribbon is usually short and stiff. A manifold ribbon is used to make a second original by placing it between the original and a second sheet of paper. In order that the rear surface of the original not be smeared, the inked manifold ribbon is provided with a plastic covering. The Patent Office classified manifold and typewriter ribbons in the same class and subclass.

Patent Office History

When the applicant originally filed his application, the claims were quite broad. The only combination of elements disclosed in the application which ever became commercial was a ribbon comprised of nylon film and woven

nylon fabric fused together. In view of the prior art cited by the Patent Office, namely Phelps and Francis, and because of the commercial situation, the only claims pursued were those involving nylon film and woven nylon fabric fused together. The Examiner was satisfied after extensive prosecution that the novel combination being claimed produced unexpected results of increased ink absorbency¹ and increased capacity.² Increased absorbency was unexplainable.

Increased ink capacity was explained as resulting from the fact that the weld formed by fusing the two thermoplastics (nylon film and nylon fabric) made the laminate liquid "tight" at its edges. See second paragraph on page 49 of file wrapper (pl. ex. 1). The liquid tight seal enables a reservoir of ink to exist between the film and the fabric (Tr342).

Increased absorbency was demonstrated to the Examiner by placing a drop of ink on plain woven nylon fabric. A drop of precisely the same amount of ink was placed on the patented ribbon made from the same fabric. The drop of ink on the patented ribbon spread so as to have a diameter three times the size of the ink spot on the plain nylon fabric. See page 33 of the file wrapper (pl. ex. 1).

The patented ribbon opened up a whole new field, namely use of these ribbons by computers. The patented ribbon prevents the type face and the binding posts from contacting the printing ribbons thereby eliminating the many

¹ By "absorbency" is meant the rate at which the ribbon receives ink, such as the rate of return of ink to the part of the ribbon which has been struck by a typewriter key (Tr171).

² By "ink capacity" is meant the total quantity of ink which the ribbon is capable of holding (Tr171).

hours of costly down time of computers previously required to clean dried ink from these services. The GASA and FAA branches of the government purchased and used the patented ribbon since its inception (pl. ex. 1, page 46, Tr314).

When claims were presented limiting the invention to flexible, ink impervious nylon and flexible woven nylon fabric fused together only along the extreme edges, the invention was considered patentable. This narrow relationship is *sui generis* and provides unexpected results. As referred to on pages 48, 49 of the file wrapper (pl. ex. 1), the welded edges acted as a seal so that a reservoir of ink could occupy the space between the film and fabric. Hence, the ink capacity was substantially increased. This is surprising since over-inking normally results in "puddling" with the result that sharp clear imprints are not attained (Tr127). The defendants' literature is the best evidence that the patented ribbon gives sharp, clear, and dark imprints.

The nylon film keeps type face clean since the film prevents the type face from contacting the ink impregnated nylon fabric. Because the film and fabric are fused together only along their extreme edges, it has been found that the ribbon has *both* increased absorbency and increased ink capacity. This greater absorbency, which was five times the rate for plain nylon was dramatically demonstrated to the Court (Tr130-135) and was neither taught by any prior art reference, nor could it be explained (Tr170, 171, 344).

History of the Parties

About September, 1961, defendant William Wolowitz contacted the patentee, Walter Ploeger, Jr., and indicated

that he would like to sell a composite ribbon (Tr148-151). The composite ribbon at that time included a strip of correction material and a strip of inked fabric held together by Scotch tape. The Scotch tape would not stick very well to the inked fabric. Mr. Wolowitz had heard that Mr. Ploeger's company had developed a printing ribbon having a film backing which would provide a surface to which the Scotch tape would stick and thereby enable defendants' composite ribbon to be produced commercially (Tr149-151).

Out of this discussion grew a business relationship during which over a million yards of ribbon in accordance with the patent in suit were processed for the defendants (Tr180).

Plaintiff is a service organization. It slits fabric owned by others and does not sell the patented ribbon. Plaintiff will produce the patented ribbon for customers who supply it with the fabric. For example, see pl. ex. 9 which was produced by plaintiff for Remington Rand and is sold by them under their trademark (Tr203, 204). Likewise, the ribbons processed for defendants were sold by them under their trademark.

Defendants repeatedly sought an exclusive license under the patent in suit (Tr175, 208, 416, 417, 421, 657). At a meeting on September 19, 1962, plaintiff refused to grant an exclusive license or to sell the patent to the defendants (Tr656, 657). Mr. Wolowitz then stated that if he could not have an exclusive license he would infringe and break the patent (Tr422). Counsel for plaintiff thereupon advised Mr. Wolowitz that he would be sued if he infringed the patent in suit (Tr422).

From about January to about July of 1963, defendants manufactured and sold to department stores in various

parts of the country printing ribbons lacking material processed by the plaintiff and which infringed the patent in suit (Tr227, 228, 581, 619-621 and pl. ex. 18). These infringing ribbons were sold with leaflets containing the notation "Patented Construction Backing Keeps Type Clean" (see pl. ex. 7A). Defendants had previously used the same leaflets to refer to printing ribbons containing material processed by plaintiff. The infringing ribbons were also made by a method disclosed to defendants in confidence by plaintiff (Tr234, 235) in November or December 1961.

The Trial

The case was tried without a jury before the Honorable Alexander Holtzoff. The trial lasted six days. During trial the Court stated that it would not rule on issues relating to damages since damages would be the subject of an order for an accounting if and when the patent was held valid (Tr223).

At the trial, plaintiff relied on the testimony of the inventor, Walter Ploeger, Jr. who had worked in the art for 20 years (Tr111), and the testimony of a patent expert, Arthur H. Seidel (Tr413-460). Mr. Ploeger designed the first usable fusing machine for slitting and heat sealing nylon tape (Tr112). The Court was satisfied that Mr. Ploeger was an expert in the field to which the present invention pertains, and counsel for defendants admitted this (Tr112). The Court stated that Mr. Ploeger's testimony had been clear (Tr266). Mr. Ploeger testified that the ribbons charged to infringe were purchased by him in a department store and that the ribbons charged to infringe were not processed by the plaintiff (Tr227, 228).

Tests were made in open court to illustrate an unexpected and unexplainable result with respect to the ribbon of the patent in suit, namely the increase in the ribbon's absorbency of five times the normal rate (Tr130-135).

Defendants' main thrust was that the patent in suit is invalid. In fact, counsel for defendants admitted that the claims of the patent in suit are readable directly on the ribbons charged to infringe (Tr765, 766). Defendants relied primarily on German patent 966,174 to Gruendel (defts. exs. 8 and 9) and U. S. Letters Patent 2,657,157 to Francis (defts. ex. 10) in combination, to support its allegation that the patented invention was obvious to a man skilled in the art at the time the invention was made. German patent 966,174 to Gruendel is not a file wrapper reference, whereas Francis is a file wrapper reference.

In connection with German patent 966,174, defendants relied on a translation (defts. ex. 9) of that patent and the testimony of the translator, Joseph Geiger (Tr477-493). Plaintiff challenged defendants' translation and pointed up numerous inaccuracies in the translation of the German patent 966,174. Defendants' expert admitted on cross that in the German patent:

(a) "bonding" is to be interpreted as pasting or gluing (Tr484), since the German word "verkleben" means to glue or paste (Tr489);

(b) thermoplastic bonding means heating a material to soften it so that it will stick to other materials (Tr484, 485);

(c) the thermoplastic film is melted *onto* the tissue (Tr485, 492);

(d) the only word in the German language for welding, namely "schweissen", does not appear in the German patent (Tr492).

Defendants also relied on a patent expert, Robert A. Norton (Tr495-578). Mr. Norton was not qualified as an expert in the art to which the present invention pertains and this was noted by the Court (Tr708). Mr. Norton admitted he:

- (a) never saw a film being welded to a fabric (Tr708);
- (b) never saw a fabric ribbon having an ink impervious film (Tr544, 545);
- (c) never saw a ribbon as disclosed by the German patent (Tr545), and does not know if any were ever made;
- (d) saw the patent in suit for the first time two months before suit (Tr540);
- (e) does not consider himself to be an expert in the art of making printing ribbon (Tr526);
- (f) had never seen a ribbon being made in a factory (Tr526, 527).

At the close of final argument, the Court ruled from the Bench that the patent in suit is invalid, but infringed, if valid. The Court relied on the doctrine of file wrapper estoppel to support its finding that the patent received its life solely from the one limited feature of fusion along the edges of the two strips. The Court then found that this limited feature to be taught by German patent No. 966,174 to Gruendel. Thereafter, the Court concluded that it would be obvious to substitute nylon as the material for the ink impregnated layer instead of "silk tissue" as taught by the German patent, in view of the teaching in Francis patent 2,657,157.

With respect to the second cause of action for false marking, the plaintiff showed that defendants had sought and obtained approval to use the words "Patented Construction Backing Keeps Type Clean" in conjunction with the sale of ribbons processed wholly by them. That statement appears on leaflets sold with the ribbons charged to infringe the patent in suit.

It was plaintiff's position that the circumstantial evidence created a presumption of intent to deceive requiring the defendants to go forward with plausible evidence refuting the presumption.

During opening remarks, defendants' counsel indicated that the statement "Patented Construction Backing Keeps Type Clean" which appears on defendants' leaflets refers to the Scotch brand adhesive tape (Tr84, 85). The patent of Minnesota Mining and Mfg. Co. on Scotch brand adhesive tape had expired ten years ago and no testimony or other evidence was produced to support this statement*

Defendants relied on the testimony of Mr. Henry J. Kauffman as to how the leaflet was prepared. Mr. Kauffman as a director of defendant corporation and the information was communicated to him by *either* Mr. Wolowitz or Mrs. Estelle Jacobs, Mr. Wolowitz' sister (Tr256). Mrs. Jacobs testified that she never communicated any information with respect to "Patented Construction Backing Keeps Type Clean" to Mr. Kauffman (Tr389). Mr. Wolowitz also denied giving this information to Mr. Kauffman (Tr634).

The net result is that the defendants never gave a plausible explanation showing a lack of intent to deceive regard-

*The basic patent for Scotch tape is 2,177,627. This patent expired October 31, 1956, see *Minnesota Mining and Mfg. Co. v. International Plastic Corp., et al.*, 62 F. Supp. 34 (N. D. Ill, 1945).

ing the presence of the accurate statement regarding the Ploeger patented ribbon.

The Court ruled that the false marking statute, 35 U. S. C. 292, is a very drastic penal statute, and held that there was no evidence of intent to deceive the public or to induce the public to believe that the thing marked "Patented" was made or sold by or with the consent of the patentee. The Court supported this conclusion by the absence of facts not involved in the case at bar and which are alternatives in the nature, namely:

"It should be noted that neither the name of the patentee nor the number of any patent is stated. There is no imitation of the name of a patentee or any counterfeiting or imitation of his mark."

The third cause of action was for the breach of a confidential disclosure. The defendants were having trouble with their composite ribbon of an inked portion and a correction portion. In particular, it was desired to eliminate the Scotch tape joint (Tr237). Mr. Ploeger disclosed in confidence to Mr. Wolowitz that he could solve this problem and made a demonstration showing how the problem could be solved by a method for making a welded seam longitudinally down the middle of the composite ribbon (Tr236-238). The welded seam acted as an ink barrier and would prevent ink from the fabric portion bleeding onto the correction portion (Tr267, 270). Mr. Wolowitz stated to Mr. Ploeger that he had no intention of competing with him and was not interested in manufacturing ribbons, but only in selling them.

Unknown to the plaintiff, the defendants filed an application in Great Britain for a patent that disclosed therein the method communicated by Mr. Ploeger (Tr676). The British application matured into British patent No. 961,108

(pl. ex. 21). Walter Ploeger, Jr. filed a patent application on his method in the United States Patent Office and this matured into U. S. patent 3,274,039 (pl. ex. 12). Defendants have never obtained a U. S. patent on this method, nor have they challenged plaintiff's patent 3,274,039 by way of an interference pursuant to 35 U. S. C. 135.

Mr. Wolowitz testified that he invented the method long before it was communicated to him by Mr. Ploeger (Tr654). Mr. Ploeger testified as to knowledge long prior to his first meeting with Mr. Wolowitz (Tr239-242). The Court apparently did not believe the testimony of Mr. Wolowitz in this regard since it predicated its opinion on other grounds. Thus, the Court held that the most favorable construction from plaintiff's standpoint was that the defendants should not disclose it to other persons and make the process public. This is supported by Mr. Ploeger's testimony (Tr238). It is submitted that the filing of a British patent disclosing the method and claiming to have invented it constitutes a disclosure of the process to the public, thereby breaching the confidence.

Statutes Involved.

The relevant parts of the statutes and rules involved in this case are as follows:

35 U. S. C. 102 Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one

year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U. S. C. 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U. S. C. 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

35 U. S. C. 292. False marking

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, or sold by him, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—

Shall be fined not more than \$500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

Statement of Points.

Point 1

The Court applied an improper legal standard on validity. The Court clearly erred in its ruling that the statutory presumption of validity of 35 U. S. C. 282 is only entitled to "lip service", and that the statutory burden of proof to invalidate the patent in suit of 35 U. S. C. 282 is a mere preponderance of the evidence which need not be clear and convincing.

Point 2

The Court erred in its interpretation of German patent No. 966,174 to Gruendel and applied an improper legal standard with respect to foreign patents which are vague.

Point 3

The Court clearly erred in failing to make findings on and rule that the unexpected and unexplainable result of greater ink absorbency and capacity secured by the patented ribbon satisfies the requirements of patentability. When a ribbon cannot be explained, it cannot be obvious.

Point 4

The Court clearly erred in its interpretation of 35 U. S. C. 292 and in failing to find that the evidence created a presumption of intent to deceive the public within the mean of 35 U. S. C. 292 thereby requiring defendants to go forward with plausible evidence refuting the presumption.

Point 5

The Court erred in its legal conclusion that because the parties were buyer and seller there was no breach of confidence and in failing to consider that the agreement not to make public was breached by publication in defendants' British patent No. 961,108.

Summary of Argument.**Point 1**

The statutory presumption of a patent's validity, 35 U. S. C. 282, is a real presumption entitled to more than what the Court termed "lip service".

The defendants have the burden of showing that the patent in suit is invalid by clear and convincing evidence carrying through conviction that the Patent Office erred in granting the patent. All doubt is resolved against the infringer.

Validity of a patent is a question of law.

Point 2

A foreign patent such as German patent No. 966,174 to Gruendel, which was the Court's prime basis for invalidating the patent in suit, must describe the invention in such clear, full, and exact terms as to enable any person skilled

in the art to practice the patented invention without the necessity of experimentation.

German patent No. 966,174 to Gruendel should be strictly construed. It should not be extended beyond its fair meaning and scope, with weight being given only to matters substantially disclosed therein. It lacks disclosure of the very feature which the Court stated gave life to the patent in suit.

German patent No. 966,174 is vague, indefinite, and as a whole teaches nothing different from its file wrapper reference Phelps U. S. Letters Patent No. 2,044,630. The inked layer is silk tissue. Silk does not melt and cannot be fused. Francis does not disclose a "nylon" fabric.

German patent No. 966,174 clearly states that its ribbon is stiff. This is an essential attribute of the non-spoiled manifold ribbon disclosed in German patent No. 966,174. By contrast, Claim 1 of the patent in suit requires that the ribbon of the patent in suit be flexible and pliable, a prerequisite for a spooled ribbon.

Point 3

Tests performed by the plaintiff in open court and testimony clearly demonstrate the unexpected results of greater ink absorbency and capacity secured by the patented ribbon. These results remain unexplainable on the record.

The trial court erred in not considering these unexpected results and making no findings in respect to them.

Unexpected results, especially when they are unexplained, are conclusive evidence of patentability.

Point 4

Evidence showing authority to use the phrase "Patented Construction Backing Keeps Type Clean" in connection

with ribbons processed by plaintiff and a lack of such authorization to use that phrase in connection with ribbons processed wholly by the defendants at a time when the defendants had no patent, created a presumption of intent to deceive, and a resultant violation of 35 U. S. C. 292. It was incumbent upon the defendants to present a plausible explanation of a lack of intent to deceive regardless of whether or not the statute in question is penal or a drastic statute.

35 U. S. C. 292 lists a number of possible alternative violations, one of which (the false use of the word "Patented" by defendants) is present in the case at bar. It is improper for the Court to consider the absence of the other statutory alternatives as vitiating the one before it.

Point 5

The fact that the parties can be characterized as being buyer and seller is of no moment with respect to a confidential relationship.

The interpretation on the confidential relationship placed by the court enables the buyer to dispense with the services of the seller contrary to the intent of the parties at the time the agreement was made.

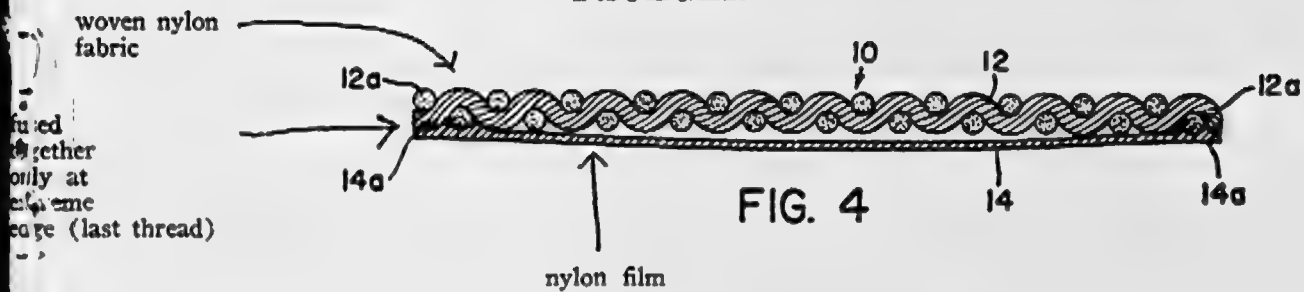
The issuance of defendants' British patent No. 961,108 containing plaintiff's confidentially disclosed trade secret constituted a disclosure to the public of a trade secret contrary to the agreement between the parties.

ARGUMENT.

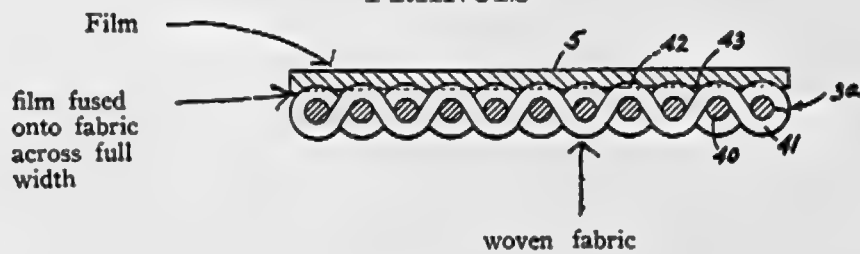
Introduction.

In order to facilitate an understanding of the claimed invention and the relevance of the prior art relied on, pictorial and descriptive charts are provided below.

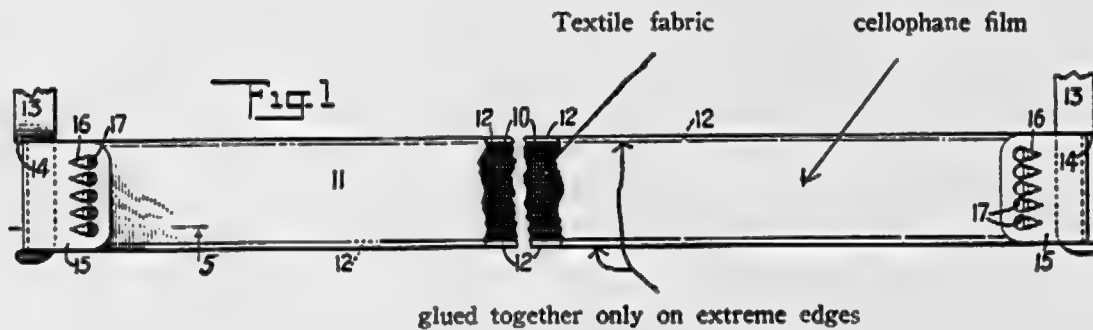
PLOEGER



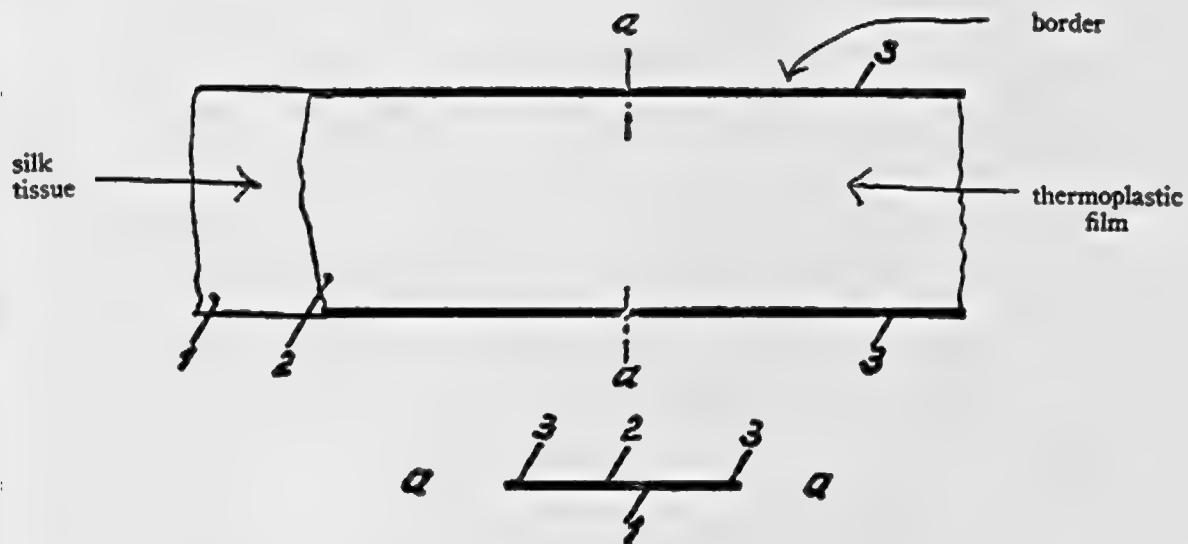
FRANCIS



PHELPS



GRUENDEL



<i>Ploeger Claim 1</i>	<i>Francis</i>	<i>Phelps</i>	<i>Gruendel</i>
a printing ribbon	printing ribbon	manifold ribbon	manifold ribbon
elongated strip of flexible, pliable, absorbent woven nylon	woven fabric such as silk or paper material	textile fabric	silk tissue
an elongated strip of flexible, pliable, imperforate ink-impervious nylon film	flexible film of large variety of plastics including nylon	strip of cellophane	strip of rigid thermoplastic (none named)
said strips being in juxtaposed surface-to-surface relation along their entire lengths	yes	fabric longer than film	yes
and fused together only along their extreme elongated edges	film fused onto fabric across full width	film and fabric joined by adhesive 12 only along extreme edges	film fused onto non-fusible silk tissue only along borders
and with the absorbent woven nylon strip being impregnated with ink	fabric impregnated with ink	fabric impregnated with ink	silk tissue impregnated with ink

POINT 1.

The statutory presumption of a patent's validity, 35 U.S.C. 282, is a real presumption entitled to more than "lip service". The defendants have the burden of showing that the patent is invalid by clear and convincing evidence carrying thorough conviction that the Patent Office erred in granting the patent. Patent validity is a question of law and all doubt is resolved against the infringer.

During final summation before the trial Court, counsel for appellant stated that it is hornbook law that a patent is presumptively valid once it is issued by the Patent Office, and that the invalidity must be shown by the defendant by clear and convincing evidence. The Court stated (Tr705):

"The Court: I think we can render lip service to that principle."

Counsel for the appellant then stated that it is clear that the burden is on the defendant to establish that the patent in suit is invalid by clear and convincing evidence. As to this, the Court stated (Tr705-706):

"The Court: No, the first part of this statement is correct, but not by clear and convincing evidence. The burden is on the defendant to establish the invalidity of the patent, of course, but not by clear and convincing evidence, but by the preponderance of the evidence."

In a recent patent infringement suit in the District of Columbia involving the present defendant, William Wolowitz, wherein he was the plaintiff, namely *Wolowitz v. Gulf Oil, et al.*, 255 F. Supp. 100, 102 (D. D. C., 1966), affirmed at ____ App. D. C. ____, 379 F. 2d 452 (App. D. C., 1967), petition for reh. en banc denied, the Court stated:

"In the present case, however, *the normal presumption of administrative correctness* accorded to the Patent Office decision to grant the patent in suit requires defendants to prove, by *clear and convincing evidence carrying thorough conviction, that the Patent Office erred in granting the patent*, especially since the normal presumption of administrative correctness is strengthened by the statutory presumption of validity accorded to the patent in suit in unequivocal terms by the first sentence of 35 U. S. C. 282" (Emphasis added).

As to the infringer's burden of proving patent invalidity, in the very recent *McCutchen v. Singer Company*, ____ F. 2d ____, 156 U. S. P. Q. 33 (5th Cir., 1967), the Court stated:

"Defendants have the burden of proving *beyond any reasonable doubt* * * * that the patent was invalid" (Citation omitted and emphasis added).

Not only did the trial Court refuse to require clear and convincing evidence, it held that the statutory presumption of validity does not even have the status of the presumption of an administrative hearing (Tr. 705):

"Mr. Robson: I would liken it to the presumption of an administrative regularity which attaches to an administrative hearing.

The Court: And it is hardly even as strong as that."

This ruling is directly contrary to *Wolowitz v. Gulf Oil, supra*.

In *Mumm v. Decker & Sons*, 301 U. S. 168, 57 S. Ct. 675, 81 L. Ed. 983 (1937), the Supreme Court stated in connection with the burden of the infringer on the issue of invalidity as follows:

"Not only is the burden to make good this defense upon the party setting it up, but his burden is a heavy one, and it has been held that 'every reasonable doubt should be resolved against him'" (Citations omitted).

The Court below did not resolve doubt against the infringers.

A recent case with facts and issues which closely parallel those of this case is *Frank W. Egan & Co., et al. v. Modern Plastic Machinery Co.*, ____ F. 2d ____, ____ U. S. P. Q. ____, (3rd Cir., 1967). In that case, the Court reversed the District Court and in sustaining the patent in suit, stated:

"All of these (prior art patents) were recited by the Patent Office, except the German application.

* * *

"In view of the file wrapper history, we think the Patent Office conclusion is entitled to weight, and its determination in issuing the patent enables the plaintiffs to start with the presumption of validity. However, the file wrapper would indicate a narrow construction of the patent."

These quotations are directly in point with the patent in suit where all of the prior art patents relied upon by de-

fendants were file wrapper references except for German patent 966,174, and where the file wrapper indicates a narrow construction of the patent.

In *Copease Manufacturing Co. v. American Photocopy Equipment Co.*, 298 F. 2d 772, 777 (7th Cir., 1961), the Court stated with respect to the presumption of validity flowing from 35 U. S. C. 282 as follows:

"As in every patent case, there is here a presumption that the patent in suit is valid. The burden of establishing invalidity rests on defendants. 35 U. S. C. 282. *Helmo Products v. Lake Shore Mfg. Co.*, 7th Cir., 227 F. 2d 677, 680."

"This presumption is not an idle gesture. *Artmoore Company v. Dayles Mfg. Co.*, 7th Cir., 208 F. 2d 1, 3, cert. denied 347 U. S. 920, 74 S. Ct. 518, 98 L. Ed. 1075, and is not to be overthrown except by clear and cogent evidence."

The Court below said this statutory presumption is only entitled to "lip service", a mere idle gesture.

As stated by Justice Clark in *Graham v. John Deere Co.*, 383 U. S. 1, 17, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966), "the ultimate question of patent validity is one of law". Interpretation of documents such as patents, file wrappers and other exhibits is a question of law. Hence, the provisions of Rule 52(a) do not apply, *New Wrinkle, Inc. v. John L. Armitage & Co.*, 277 F. 2d 409, 412 (3rd Cir., 1960); *Stewart-Warner Corp. v. Lone Star Gas Co., et al.*, 195 F. 2d 645, 647 (5th Cir., 1952); *Welsh Co. v. Chernivsky*, 342 F. 2d 586, 588 (7th Cir., 1965); *Kiwi Coders Corp., et al. v. Aero Tool & Die Works*, 250 F. 2d 562, 568 (7th Cir., 1957). An appellate court has the prerogative to interpret the exhibits itself.

In *Stuart W. Johnson & Co., Inc. v. Ro-Ber, Inc.*, ____ F. Supp., ____, 156 U. S. P. Q. 177, 182 (N. D. Ill., 1967),

the Court held that efforts by the infringer to purchase the patent they were charged with infringing was a factor supporting validity of the patent. The defendants in the case at bar:

- (a) On several occasions sought an exclusive license;
- (b) Sought to buy the patent; and
- (c) Used the words "patented construction" on their literature during and after use of the patented ribbon.

The Court improperly ignored these admissions since it considered them equivalent to negotiations to settle a lawsuit (Tr. 625). These admissions are significant since they relate to acts which occurred *before* defendants embarked on the activity complained of in this suit.

The Court applied an improper legal standard, contrary to established precedents, when it ruled that the statutory presumption of validity is only entitled to "lip service", and that evidence need not be clear and convincing. Under the standards applied by the Court, every patent is in jeopardy. When the proper legal standards are applied to the statutory presumption of validity and the requirement of clear and convincing evidence, the patent in suit is valid. Thus, the defendants have not sustained their heavy burden of proof that the patent is invalid.*

* No witness for the defense was qualified as a man skilled in the art and thereby in a position to state that the invention was obvious at the time it was made.

POINT II.

The Court erred in its interpretation of German Patent No. 966,174 to Gruendel and applied an improper legal standard with respect to foreign patents which are vague.

German patent No. 966,174 discloses a ribbon wherein a layer of thermoplastic film is joined along its borders to an ink bearing layer of silk tissue. It discloses a manifold ribbon which is used when it is desired to make a duplicate original. The ribbon therein is protected from the type face by a typewriter ribbon and the paper original. Hence, the thermoplastic film in the German patent does not absorb the pounding of the type face directly as in the case in a typewriter ribbon. Manifold ribbons do not move laterally, are stiff, and are not spooled. The German patent states:

“* * * the stiffness of the product achieved in this way assures a problem-free ribbon transport.”

A stiff non-spooled ribbon is just the opposite of that claimed in the patent in suit.

The German patent has three modifications. The first modification is shown in Figures 1 and 2. The second modification is shown in Figures 3 and 4. The third modification is shown in Figures 5 and 6. In each of Figures 2, 4, and 6, the leadline for the ink bearing member is directed to the small centrally located clear rectangle in the center portion of the ribbon. The defendants' patent expert, Mr. Norton, could not explain this apparent inconsistency between the even-numbered figures and the odd-numbered figures in the German patent (Tr. 561, 562, 564) and stated:

“I find two figures that do not agree” (Tr. 562).

The German patent does not disclose a woven nylon fabric as claimed, but instead discloses a "silk tissue" which could mean a paper like carbon paper. Silk in any form is non fusible (Tr. 457, 501, 502).

The ribbon in the German patent is inoperative as a typewriter ribbon since it would leak at the side edges (Tr. 118).

In the German patent, the mechanism for joining the film and ink bearing issue is by melting the film so that it acts as a solder or adhesive to join the film onto (German word "auf") the non-fusible tissue. It will be noted that the only reference cited by the German Patent Office when acting on said German patent is the U. S. patent to Francis, No. 2,657,157, a file wrapper reference for the patent in suit. In Francis, the film is joined to the fabric by heating the film so that it melts onto the fabric. It is logical to assume that the same mechanism was contemplated by the German patent since the German patent states that the film melts onto the silk tissue. The German patent uses the word "auf" which means "onto" (Tr. 492). The German word for "into" is "hinein" and that word does not appear in the German patent.

According to defendants' translation of German patent No. 966,174 (def. exh. 9) the ink bearing layer is "silk tissue". Webster's Unabridged Dictionary, 3rd Edition, page 2118 defines silk paper as:

"a paper similar to granite paper but having only a very few *silk fibers scattered in the tissue*" (emphasis added).

The translation of the German patent is the work product of the defendants' translator, Mr. Geiger. Mr. Norton, defendants' expert on patents, disagreed with Mr. Geiger's translation and indicated that he believed the ink bearing

layer in the German patent to be a silk fabric (Tr. 559). It was never made clear as to what silk tissue is. Mr. Norton stated he had never seen silk tissue (Tr. 558).

Claim 1 of the patent in suit defines a structure whose extreme elongated edges are fused together. As the Court properly found, the only ink bearing material specifically disclosed in the German patent is silk tissue (Tr. 557). Silk, whether it be paper or fabric, cannot melt (Tr. 457, 501, 502). Hence, the German patent could not possibly teach fusing together of the ink bearing layer and the protective film. The German patent does not suggest any specific material for the film. The Court ignored the recitation in the patented claim that the film be flexible nylon. Very few thermoplastics can be used for the printing ribbon. Mylar and polyethylene will not work (Tr. 115-117) and both are thermoplastic.

It was precisely this situation that Justice Clark referred to in *United States v. Adams*, 383 U. S. 39, 50, 86 S. Ct. 708, 15 L. Ed. 2d 572 (1966) wherein in sustaining the Adams patent he disposed of the Skrivanoff prior art reference because "one which fails to achieve its intended result does not negative novelty".

After review of the file wrapper of the patent in suit, the Court held that the patent in suit is a very narrow one, and is limited to a ribbon consisting of an absorbent nylon strip and an impervious nylon film, fused together only along their extreme elongated edges. As a matter of law, the patent in suit is limited to the claims appearing therein. It is admitted that the patent is narrow and specific, yet each and every feature is found in defendants' ribbons.

As a matter of law, no patent receives its life from any particular feature recited in a claim. There is no such

thing as a "heart" of an invention. See *In re Duva*, ____ F. 2d ____, 156 U. S. P. Q. 90, 94 (C. C. P. A. 1967) wherein the Court stated:

"Thus, all factual differences which may be properly noted in any portion of a claim *must* be included within the basis for comparison with the prior art if we are to properly evaluate the differences between the invention defined in a claim and the teachings of a reference. The command of 35 U. S. C. 103 is to compare the invention *as a whole* with the prior art" (Emphasis added).

The Court improperly interpreted German patent No. 966,174 when it found that the alleged limited feature giving life to a patent in suit was disclosed in Gruendel as a whole. It was improper for the Court, whose eyes had been sharpened by the disclosure of the patent in suit, to hold that the carrying elements of Ploeger's invention were disclosed in the German patent on the basis of Claim 1 of the German patent. Claim 1 of the German patent is quoted in the Court's opinion. That claim of the German patent does not disclose the alleged limited feature of the patent in suit, namely fusing together of film and fabric.

Nylon fabric does not readily fuse to other plastics. Fusion of film and fabric only occurs when the two strips are thermoplastic and cut simultaneously by a hot knife (Tr. 687, 688). The heat is thereby directed into the film and fabric laterally from the edges or in a direction parallel to the plane of the layers (Tr. 687-689). No such cutting method or combination of materials is taught by either Francis or the German patent to Gruendel. Ploeger could not produce a satisfactory ribbon using the techniques in Francis and Gruendel (Tr. 117), even when he used nylon film and woven nylon fabric (Tr. 118).

Assuming *arguendo* that the carrying feature of the patent is an absorbent nylon strip and an impervious nylon

film fused together only along their edges, it is clear beyond peradventure that this relationship could not be "emphatically disclosed" in the German patent, as stated by the Court, *since silk does not melt* (Tr. 457, 501, 502).

A foreign patent, such as German patent No. 966,174, to anticipate a patented invention, must describe the invention in such full, clear, and exact terms as to enable any person skilled in the art to practice the patented invention without the necessity of experimentation, see *Beckett v. Coe*, 69 App. D. C. 51, 98 F. 2d 332, 335 (App. D. C., 1937):

"Foreign patents are valid references when there is a clear disclosure of the invention sought to be patented in the United States. In re Cross, Cust. & Pat. App. 1932, 62 F. 2d 182. But when such a patent merely prophesies what can be done without setting forth that it has been done, or makes claims for things not fairly disclosed in the specification, the foreign patent does not anticipate. Westinghouse Air-Brake Co. v. Great Northern Ry. Co., 2 Cir., 1898, 88 F. 258; General Electric Co. v. Hoskins Mfg. Co., 7 Cir., 1915, 224 F. 464; Haynes Stellite Co. v. Chesterfield, supra; American Stainless Steel Co. v. Ludlum Steel Co., 2 Cir., 1923, 290 F. 103. This court has said, in Davies v. Coe, 1936, 65 App. D. C. 345, 346, 83 F. 2d 602, 603: (Emphasis added).

'The disclosure of a foreign patent is to be measured not by what may be made out of it, but what is clearly and definitely expressed in it. In re Ek, 57 App. D. C. 203, 19 F. (2d) 677; Carson v. American Smelting & Refining Co. [C. C. A.] 4 F. (2d) 463' (Emphasis added).

See also: *Switzer v. Marzall*, 96 F. Supp. 332, 333 (D. D. C., 1951); *General Tire & Rubber Co. v. Watson*, 184 F. Supp. 344 (D. D. C., 1960), and 69 C. J. S. 218.

Justice Clark applied this standard in sustaining the Adams patent in *United States v. Adams*, 383 U. S. 39,

50, 86 S. Ct. 708, 15 L. Ed. 2d 572 (1966) where in disposing of the Skrivanoff prior art reference he stated:

"That in 1880 Skrivanoff may have been able to convince a foreign patent examiner to issue a patent on his device has little significance in the light of the foregoing."

The German patent does not meet this test since it does not clearly describe the invention of Claim 1 of the patent in suit.

As noted in the passage quoted from *Becket v. Coe, supra*, an alleged anticipating patent, and in particular, a foreign patent, is not to be extended beyond its fair meaning and scope, or reconstructed in the light of subsequent invention and then used as an anticipation.

Extrinsic evidence is not admissible to show that a word having a sensible meaning in the context was erroneously used for another word, nor can a prior art patent have implied into it, from necessity, more than it fairly shows, to make it represent an operative structure. The German patent does not meet this test since it must be extended or reconstructed beyond its fair meaning and scope by hindsight to arrive at the ribbon claimed in Claim 1 of the patent in suit.

The references relied on by the defendants must clearly teach something closer to the claimed invention than those considered by the Patent Office, *Wolowitz v. Gulf Oil Corp.*, 255 F. Supp. 100 (D. D. C., 1966), aff'd — App. D. C. —, 379 F. 2d 452 (App. D. C., 1967), petition for reh. denied, *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Co.*, 287 F. 2d 228 (9th Cir., 1961); *King-Seeley Thermos v. Tastee Freez Industries*, 145 U. S. P. Q. 596 (N. D., Ill., 1965), aff'd 357 F. 2d 875 (7th Cir., 1966); *Marston v. J. C. Penney Company, Inc.*, 353 F. 2d 976 (4th Cir., 1965).

The German patent is less relevant than the file wrapper patent to Phelps because the latter contains a clear disclosure. No specific film is disclosed in the German patent. The German patent *does not*:

(a) contain drawings which are consistent with one another so that the disclosure can be understood (Tr. 561-564):

(b) identify the ink bearing element as being a thermoplastic material, which it must be if it is to fuse together with the film (Tr. 568), instead the sole disclosure of the ink bearing element is silk which cannot fuse;

(c) clearly disclose the ink bearing member to be a woven fabric;

(d) indicate that "border" is the same as "extreme edge";

(e) disclose a flexible ribbon, but instead it discloses a "stiff" ribbon.

Phelps patents 2,044,630 was the closest reference considered by the Patent Office. Unlike the German patent, Phelps discloses a layer of cellophane material in Figure 1 jointed at 12 only to the "extreme edges" of a layer of textile fabric. The statement at page 2, lines 30-35 in Phelps is directly contrary to the Court's finding that in Phelps the two strips were fastened together at intervals. Both Phelps and the German patent disclose a short, stiff manifold ribbon to be inserted between worksheets rather than a flexible pliable ribbon, which can be spooled, such as a typewriter ribbon, as defined by Claim 1 of the patent in suit.

In Phelps, the cellophane film and the inked fabric are held together only along their extreme edges by an adhesive.

In the German patent, the *borders* of the thermoplastic film are melted so that they attach to the inked non-fusible tissue. Melting only one layer, namely the thermoplastic film, it is merely another form of adhesive bonding (Tr. 484, 485). Neither Phelps nor the German patent teaches the narrow structural interrelationship recited in Claim 1 wherein *ink impervious flexible nylon film and flexible woven nylon fabric are fused together only at the extreme elongated edges*.

The reference relied on by the defendants teach nothing material or of great significance which was not previously considered by the Patent Office.

In *Marston v. J. C. Penney Co., Inc.*, 353 F. 2d 976, 982 (4th Cir., 1965), the Court stated:

"Under these circumstances we do not think the failure to consider Lee would weaken the statutory presumption. Kopec, on the other hand, does reveal a structure different from other patents considered by the Examiner *but this patent, in our judgment, does not reveal anything of great significance* and again we conclude that the failure to consider it does not materially weaken the presumption" (Emphasis added).

Hence, the German patent was not entitled to great weight as held by the Court since it is not different from Phelps nor does it reveal anything of great significance not already considered by the Patent Office experts.

The Court held that the Examiner overlooked the German patent to Gruendel. In *Artmoore Co. v. Dayless Mfg. Co., Inc.*, 208 F. 2d 1, 4 (7th Cir., 1953), the Court stated:

"Defendants' argument based on these prior art patents, not cited in the Patent Office, is not convincing. It has been held, and we think with logic, that *it is as reasonable to conclude that a prior art patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently*

overlooked. Adler Sign Letter Co. v. Wagner Sign Service, 112 F. 2d 264, 267 [45 USPQ 387, 389]; Charles Peckat Mfg. Co. v. Jacobs, 178 F. 2d 794, 802 [84 USPQ 4, 10-11]'' (Emphasis added).

The patent in suit, the Phelps patent and the German patent to Gruendel are all classified in the same class and subclass in the Patent Office (Tr. 700). Hence, there is no logical reason to assume that the Examiner overlooked the Gruendel patent.

Accordingly, the legal standards used by the Court are clearly erroneous and require reversal.

POINT 3.

The Court clearly erred in failing to make findings on and rule that an unexpected unexplainable result satisfies the requirements of patentability. If something cannot be explained, it cannot be obvious.

At the trial, the patentee presented evidence on unexpected results of the patented ribbon. Tests were conducted in open court to show that the absorbency of the patented ribbon was five times as fast as the absorbency of the same fabric without a protective film of nylon (Tr. 130-135). Not only are the results unexpected, but they are unexplainable (Tr. 170, 171). German patent No. 966,174 is completely silent in this regard. The patented ribbon also unexpectedly has a 25% greater ink capacity. The increased capacity results from the "reservoir" (see pl. ex. 1, p. 49).

The trial Court made no findings on unexpected results. The failure to do so constitutes reversible error since unexpected results, especially when they are unexplainable, in and of themselves, satisfy the requirements of patentability.

In *United States v. Adams, et al.*, 383 U. S. 39, 50, 51, 86 S. Ct. 708, 15 L. Ed. 2d 575 (1966), Justice Clark in sustaining the validity of the Adams patent found it to be unobvious because of the unexpected results obtained:

"Nor is the Government's contention that the electrodes of Adams were mere substitutions of pre-existing battery designs supported by the prior art. If the use of magnesium for zinc and cuprous chloride for silver chloride were merely equivalent substitutions, it would follow that the resulting device—Adams' — would have equivalent operating characteristics. But it does not.

* * *

"We conclude the Adams battery was also unobvious. As we have seen, the *operating characteristics of the Adams battery have been shown to have unexpected and to have far surpassed then-existing wet batteries. Despite the fact that each of the elements of the Adams battery was well known in the prior art, * * **" (Emphasis added).

The operating characteristics of the patented ribbon far surpassed the prior art despite the fact that nylon film and fabric, per se, were known to the art.

In *Higley v. Brenner*, — App. D. C. —, — F. 2d —, 155 U. S. P. Q. 148 (App. D. C., 1967) this court stated:

"Further, even if all of the elements used are old, a new result, an unexpected, a far more efficient result, or a more economical result will satisfy the requirements of patentability."

In *Canaan Products, Inc v. Edward Don & Co. et al.*, 154 U. S. P. Q. 393, 397 (N. D. Ill., 1966) the court stated in connection with unexplained unobvious results:

"* * * the inability to understand this mechanism conclusively proves the unobviousness of the development."

The increased absorbency rate means that the ribbon may be inked faster and that the recuperative power of the ribbon will be greater (Tr. 171-173). By recuperative power is meant the speed of return of ink to a part of the ribbon from which ink has been removed by the ribbon being struck by a key. Also, the ribbon will last longer since it will hold 25% more ink while at the same time permit a dark, sharp imprint (Tr. 170, 171).

The Court committed reversible error in failing to give proper weight to the unexpected, unexplained results of the patented ribbon. This is particularly true when these results were a material basis for granting a patent.

POINT 4.

The Court clearly erred in its interpretation of 35 U.S.C. 292 and in failing to find that the evidence created a presumption of intent to deceive the public within the meaning of 35 U.S.C. 292 thereby requiring defendants to go forward with plausible evidence refuting the presumption.

The defendants have deceived the public and induced them to believe that the ribbons sold by them were patented or made or sold by or with the consent of the patentee. In 1962, the defendants sold ribbons processed for them by plaintiff and inserted into the box with the ribbons a leaflet which stated "Patented Construction Backing Keeps Type Clean". That terminology was used by the defendants with the approval of the plaintiff (Tr. 199) but not with respect to ribbons processed by the defendants after 1962 (Tr. 232). Defendants used the identical leaflets in 1963 in connection with ribbons not processed by the plaintiff, but rather wholly made by the defendant. Thus, de-

fendants have falsely marked their ribbons by use on leaflets of the terminology "Patented Construction".

35 U. S. C. 292 in clear and unequivocal language penalizes those who without the consent of a patentee, with the intent to deceive the public, identify their product as being patented. Up to the filing of suit, there was only one patent in existence on any portion of the defendants' ribbon and that was plaintiff's. There was only one backing on defendants' ribbon which kept type clean and that was the nylon film backing on the printing portion which during 1962 was processed by plaintiff for defendants.

The statute requires the acts of the defendant to have been done with the intent to deceive the public. Where it is shown that the defendants do not own a patent nor do they have the consent of the patentee, the law presumes that the acts were done with the intent to deceive until the contrary is clearly shown. In *Krieger v. Colby, et al.*, 106 F. Supp. 124, 130 (S. D. Calif., 1952), the court commenting on the intent to deceive stated:

"The presumption is, until the contrary appears, that the mark was placed on the article with the intention to deceive. *Aliphant v. Salem Flouring Mills Co.*, 18 Fed. Cas. No. 10486, p. 674".

The defendants have not come forward with a plausible explanation refuting this presumption. During opening remarks, defendants' counsel indicated that the "Patented Construction" referred to the Scotch brand adhesive tape (Tr. 83, 84). This was not pursued by defendants during the trial presumably because of their knowledge that the patents on the Scotch brand tape expired ten years ago, see p. 10 of this Brief.

Defendants' advertising agency witness, Mr. Kauffman, could not explain the basis for the words "Patented Con-

struction Backing Keeps Type Clean" on defendants' leaflets. He testified the information came to him from either Mrs. Jacobs or Mr. Wolowitz (Tr. 256). Mrs. Jacobs, sister of Mr. Wolowitz, was sales manager of defendant Spellright (Tr. 387). She testified that she did not communicate this information to Mr. Kauffman (Tr. 389). Mr. Wolowitz likewise denied communicating this phrase to Mr. Kauffman (Tr. 634). Mr. Kauffman testified he did not personally prepare defendants' leaflet, did not supervise it, and did not review it (Tr. 255).

By no stretch of the imagination could the Scotch brand tape used in the early ribbons of the defendants perform the function of keeping type clean. A dictionary definition of "construction" requires two or more elements connected together and therefore this could not read on Scotch brand tape. Moreover, the leaflets were used with ribbons which did not use Scotch tape to hold the halves together.

The defendants did not offer any explanation. Instead, Mr. Kauffman (who testified he did not prepare the leaflet) blamed either Mrs. Jacobs or Mr. Wolowitz, and they blamed Mr. Kauffman. The net result is that no one knew how the leaflet came into existence using the words "Patented Construction". It is interesting to note that both Mrs. Jacobs and Mr. Wolowitz admitted seeing these words on their leaflet soon after it was printed, but claim they did not give it much thought (Tr. 406, 635).

A clear violation of 35 U. S. C. 292 is presented when (a) each witness shifts the blame to another witness, (b) all of defendants' witnesses were aware of their usage of "Patented Construction", (c) defendants did not have a patent, and (d) defendants had previously used the identical leaflets with ribbons processed by plaintiff, who

had a patent which was accurately described in defendants' leaflet.

It is elementary evidence that once facts are shown to exist, it will be presumed that they continue to exist. Since the words "Patented Construction" on defendants' leaflets in 1962 meant plaintiff's patent, there is no reason to assume that they meant something different in 1963. Hence, the circumstantial evidence created a presumption to deceive which was not rebutted.

The Court held that the subject statute, 35 U. S. C. 292 is a drastic one. Whether or not the statute is drastic has no bearing on the issue of whether or not the circumstantial evidence shows an intent to deceive until contrary evidence is introduced.

35 U. S. C. 292 states the following *alternatives, inter alia*, which are prohibited:

- (a) the name or any imitation of the name of the patentee or
- (b) the patent number or
- (c) the word patent or
- (d) counterfeiting or imitation of the mark of the patentee.

The Court considered the absence of items (a), (b) and (d) as being significant. Plaintiff never argued the presence of items (a), (b), or (d) and their absence is completely irrelevant to whether there was a violation because of the presence of item (c). It was improper for the Court to consider the lack of other alternatives as evidence failing to show that the "thing was made or sold by or with the consent of the patentee".

POINT 5.

The Court erred in its legal conclusion that because the parties were buyer and seller there was no breach of confidence and in its failing to consider that the agreement not to make public was breached by publication in defendants' British Patent No. 961108.

Mr. Ploeger, an officer of the plaintiff, communicated in confidence to Mr. Wolowitz, at the latter's request, a new method for making ribbons (Tr. 237, 238, 266, 267). The new method for making ribbons was demonstrated to Mr. Wolowitz at that time. The method involved the manipulative steps necessary to produce a ribbon having an ink barrier in the form of a weld longitudinally down the center of a composite ribbon. The weld would enable the ribbon to be composed of two longitudinal separate entities whereby the ink in one entity would not migrate to the other (Tr. 267).

The Court held that the agreement to keep confidential cannot be construed to mean that the defendants should not use this process because the very purpose of disclosing it was to help defendants' own business, a customer of the plaintiff.

The Court committed reversible error when it held that the agreement cannot be construed to prevent the defendants from using the process merely because the defendants were customers of the plaintiff. Any interpretation of the agreement which places defendants in a position to directly compete with the plaintiff and no longer require the services of the plaintiff is an abnormal construction which could not possibly have been the intent of the parties. The fact that the parties can be characterized as being buyer and seller is of no moment. In similar type buyer-

seller relationships, the courts have found a confidential relationship, *even though there was no express agreement*. See *Schreyer v. Casco Products Corp.*, 190 F. 2d 921 (2nd Cir., 1951); *Hoeltke v. C. M. Kemp Mfg. Co.*, 80 F. 2d 912 (4th Cir., 1935); *Matarese v. Moore-McCormack Lines, Inc.*, 158 F. 2d 631 (2nd Cir., 1946).

The Court clearly erred in failing to take into consideration that defendants' British Patent No. 961,108 constituted a disclosure of plaintiff's confidentially disclosed secret method, thereby breaching defendants' agreement not to disclose such method to other persons. The defendant, William Wolowitz, filed a patent application in Great Britain disclosing each and every step of the process. The Wolowitz British application matured and issued as British Patent No. 961,108 on July 17, 1964 (pl. ex. 21). The United States patent application for this trade secret filed by Walter Ploeger did not issue as a patent until September 20, 1966 (U. S. Letters Patent 3,274,039, pl. ex. 12).

The Court held that the most favorable construction from the plaintiff's standpoint that can be placed upon the confidential disclosure was that the defendant should not disclose it to other persons and make the process public because the plaintiff was intending to apply for a patent. Assuming *arguendo* that this is the most favorable construction which can be placed on the agreement, it was breached. Disclosure in said British patent by defendants was a disclosure to the world. Hence, the agreement was clearly breached.

Conclusion.

The Court's findings and conclusions of law are clearly erroneous with respect to the invalidity of the patent in suit, false marking under 35 U. S. C. 292, and the breach of confidential relationship with respect to the method for making a new ribbon.

Therefore, appellant prays that the judgment of the Court be reversed and that judgment be here rendered for the appellant holding the patent in suit valid, that defendants have falsely marked their ribbons, and that defendants have breached a confidential relationship with respect to the secret method for making a ribbon.

It is submitted that appellant is entitled to its costs on this appeal, and in connection with the trial before the District Court.

Respectfully submitted,

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BRIEF FOR APPELLEES

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 21527

FILMON PROCESS CORPORATION, *Appellant,*

v.

SPELLRIGHT CORPORATION, ET AL., *Appellee.*

Appeal From the United States District Court for the
District of Columbia

United States Court of Appeals
for the District of Columbia Circuit

FILED MAR 6 1968

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COUNTERSTATEMENT OF THE QUESTIONS PRESENTED

First Count

Where Plaintiff sued for patent infringement on a typewriter ribbon, and where none of the differences that Plaintiff asserts between the claims of the patent in suit and the prior art could possibly meet the high standard for patentability established by the Supreme Court; the question is whether the patent is invalid as a matter of law?

Where the trial judge made the following finding of fact:

"It is **clear**, therefore, that the carrying elements of Ploeger's invention, and the basis on which he was awarded his patent had been previously disclosed and **emphatically disclosed** by the German patent to Gruendel that was issued several years prior to the time that Ploeger made his application for a patent in the United States." (Emphasis added)

The question is whether there is any merit to Plaintiff's contention that the trial judge did not find the evidence to be "clear and convincing"?

Where it is clear that the Examiner overlooked the most pertinent prior art during his examination of the application for the patent in suit; the question is whether the presumption of validity of the patent is greatly weakened if not destroyed, thus relieving Defendant of the heavy burden and high standard of proof normally required of a defendant attacking the validity of a patent?

Where plaintiff attempted to distinguish its patent from the German one by relying on things said to be vital to the invention, and not disclosed in its patent; the question is whether the patent in suit is invalid for incompleteness and/or indefiniteness?

Second Count

Where "an ordinary criminal statute" (to use the words of the Senate and House committees who passed it) permits any informer to bring an action thereon, and does not provide for compensation to injured parties but only a penalty in the form of a "fine"; the question is whether an appeal on the merits from a judgment finding defendants not guilty is forbidden by the double jeopardy clause of the Constitution?

Where the above statute forbids use of patent marking *for the purpose of deceiving the public*, and the trial court held that there was no such purpose, after a five day trial at which seven witnesses testified; the question is whether the case is controlled by Rule 52a, F.R.C.P.?

Where the above statute spells out several detailed prerequisites to a violation thereof, on which plaintiff offered no evidence; the question is: did the trial court correctly hold "a cause of action has not been made out"?

Where at the close of Plaintiff's case Defendants moved to dismiss on the ground Plaintiff failed to prove a *prima facie* case and where the Court implied that the motion was well founded but decided to "reserve the matter until the end of the case" (Tr. 473) and then in his final decision held "a cause of action has not been made out", the questions are, First, should this Court review the Plaintiff's evidence to see if it made out a *prima facie* case, and Secondly, if it finds that Plaintiff failed to prove a *prima facie* case, should it affirm the decision below?

Third Count

Were the findings of the trial court, to the effect that an alleged trade secret was given freely for use in Spellright's business, supported by substantial evidence?

Where Plaintiff claims breach of disclosure of a trade secret, but offered no evidence to prove that it kept the idea secret; the question is: did it fail, as a matter of law, to make out a *prima facie* case?

Where Plaintiff claims that an idea was disclosed to Defendant, and that *after* such disclosure it made an *ex parte* request that the idea be kept confidential but does not even allege that Defendant agreed to keep the idea confidential; the question is: did Plaintiff fail, as a matter of law, to make out a *prima facie* case?

Where Plaintiff did not at the trial rely on Defendant's issue of a British patent as a breach of alleged trade secret, but in response to inquiry by the Court said that the British patent was being introduced in evidence for another purpose; the question is: may it be relied on in this Court as a breach?

Where Plaintiff allegedly made an *ex parte* request to Defendant to keep an idea confidential because Plaintiff intended to apply for a patent; the question is: did Plaintiff fail to make out a *prima facie* case, as a matter of law, when it now claims that issuance of a British patent was a breach but has at no time even alleged that the issuance of the British patent in any way interfered with Plaintiff securing its patent or that Plaintiff was in any way damaged by issuance of the British patent?

Where a plaintiff sues for breach of trade secrets and admits that it suffered no damage from the alleged breach, and withdrew its prayer for an injunction; the question is: did it fail, as a matter of law, to make out a *prima facie* case?



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IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 21527

FILMON PROCESS CORPORATION, *Appellant*,

v.

SPELLRIGHT CORPORATION, ET AL., *Appellee*.

Appeal From the United States District Court for the
District of Columbia

BRIEF FOR APPELLEES

COUNTERSTATEMENT OF THE CASE

Defendants disagree with Plaintiff's statement of the case and submit a counterstatement.

Plaintiff's first alleged cause of action is for patent infringement and the crux of the issue on this appeal is the correctness of the following finding of fact of the trial judge (JA 19, 8-9):

"It is *clear*, therefore, that the carrying elements of Ploeger's invention, and the basis on which he was awarded his patent had been previously disclosed and *emphatically* disclosed by the German patent to Gruendel" * * * (Emphasis added)

Plaintiff's alleged second cause of action is based on a criminal statute, 35 U.S.C. 292, which provides for a fine of \$500 where patent markings are applied "to deceive the public". However, the Court below found "there was no intent * * * to deceive the public".

Plaintiff's alleged third cause of action claimed breach of an alleged trade secret that Ploeger disclosed to Defendant Wolowitz. The Court, after a five-day trial in which the relationships between the parties were fully developed, found as a fact that Defendants were given the idea freely to use in their business.

Previously, this Court found that Plaintiff was not entitled to a jury trial as to the first and third counts because stipulations in the pretrial order made it clear that Plaintiff was not entitled to any damages, *Filmon Process Corp v. Sirica*, CA-D.C., 379 F2d 449.

Plaintiff's brief relies mainly on the testimony of its own witnesses. However, numerous improprieties and contradictions justified the Court in rejecting their testimony.*

* Ploeger swore in answer to our interrogatories 36 and 62s that he did not mark his product with the patent number. When this Court held in *Filmon Process Corp. v. Sirica*, *supra*, that this was fatal to any claim for damages, Ploeger swore that he put the number on the product regularly (Tr. 277-89, 384-6). Other contradictions by Ploeger appear as this brief proceeds. Seidel was the attorney who filed the suit. He did not withdraw until the pretrial conference as the record below shows, although he denied this at the trial (Tr. 453). His partner, Gonda, was a principal attorney throughout the case including the trial and this appeal, and was also a witness (Tr. 464-9).

Ploeger and Seidel caused letters to be sent to 106 stores, nearly all of which were customers of Spellright, advertising this lawsuit and saying "My client has instructed me that it wishes to move forward under its patent rights to the maximum extent permitted to it by law." Included was a store in Canada 80 miles from the border who was accused of infringing Ploeger's U. S. Patent when it sold Spellright ribbons. (See D's interrogatories 52, 53, 54a and 54b at JA 12). Judge Jackson said of the letters that "it was a threat, and I don't approve of such actions" (hearing, February 28, 1964, Tr. 22). Judge Holtzoff said the letters were "reprehensible" (Tr. 792). Seidel filed an affidavit alleging motions, that the Court had granted, had been filed in bad faith; and Judge Holtzoff ordered that remark stricken (Hearing, September 20, 1963, p. 31). Seidel was very evasive on cross-examination (Tr. 455-9).

**Plaintiff Distorted Its Own Patent at the Trial and
in Its Brief Here**

Plaintiff's patent shows an ordinary typewriter ribbon 12 of cotton, silk or nylon, together with a nylon film backing 14. The backing and ribbon are fused together along the edges 14a. The words "fused together" as used in the patent, simply mean that one of the two layers 12 or 14 (Fig. 4) is melted into the other, for example, that the film 14 is melted into the borders of the ink-carrying ribbon 12 without any part of the latter necessarily being melted (Tr. 488, 506-7).

A mere reading of the whole patent shows that there is nothing said therein about the means or method whereby the two layers 12 and 14 are fused together, much less that hot knives are used.

Moreover, the preferred form of the patent is one in which the ink-carrying layer 12 is cotton or silk (Tr. 498-506). See also the patent at column 1, line 61:

"For the purpose of illustrating the invention there is shown in the *drawings* a form which is presently *preferred*; * * * " (Emphasis added)

Since the drawings illustrate the *preferred* form, we note that they illustrate a form in which the strip 12 is of non-fusible material (Tr. 502). See also column 2, line 26 of the patent:

"*Although in the illustrated embodiment of the ribbon 10 of the present invention, the edges 14a of the impervious strip 14 are shown to be fused to the edges 12a of the absorbent strip 12, if the absorbent strip 12 is made of a fusible material, the edges 12a of the absorbent strip 12 may be fused to the edges 14a of the impervious strip 14.*" (Emphasis added)

Column 2, line 9, of the patent says that the woven strip may consist of "cotton, silk or nylon". Cotton and silk are incapable of being melted, hence the portion of the

specification starting at col. 2, line 26, quoted above, is in effect saying that the embodiment of the invention *shown in the drawings* uses cotton or silk for the ink-carrying ribbon 12 (Tr. 502). Indeed, an examination of Fig. 4 shows a distortion of the nylon film backing 14 for approximately $\frac{1}{2}$ inch inwardly from the edges 14a thereof. It is also noted that there is no distortion of the ribbon 12 (Fig. 4), and it was thus unaffected by heat (Tr. 503). Moreover, Ploeger's attorney, said this to the Examiner (PX 1, p. 27):

"Claim 15 [claim 2 of the patent] has been added because there are materials, as indicated in the specification (first sentence of second paragraph of page 4) other than nylon which may be fused to the impervious nylon film, and which may perform satisfactorily in the present invention." (Matter in brackets added)

Turning to the first sentence of the second paragraph of page 4 of the file wrapper (PX 1), which is the thing referred to in the above quotation, the only materials named, other than nylon, are cotton and silk. Thus the foregoing was a representation to the Examiner that cotton and silk may be used as the ink-carrying strip 12 of the patent (Tr. 507-8).

Therefore, the word "fused" as used in claim 2 of the issued patent, and on page 27 of the file wrapper, simply means that the nylon film 14 is melted (because cotton and silk cannot melt) into the borders of the cotton or silk ribbon 12. Therefore, the word "fused" is not used in the patent as meaning "welded", for in a welding operation both materials are melted and flow together (Tr. 506-7).

While the patent mentions in col. 2, lines 30-32, and in claim 1, an alternate form not illustrated in the drawing (and thus not the preferred form) involving a woven nylon ink ribbon with a nylon film backing, there is nothing said that both nylon strips are heated, or that the two strips are "welded" together (Tr. 506-7). The only word used is

"fused", which presumably means the same thing as it meant in connection with the preferred form (cotton or silk ribbon 12 with nylon backing 14) in which one of the two strips was heated. Thus, claim 1 is not limited to the situation where both nylon strips 12 or 14 are heated (Tr. 506-7); indeed such a situation is not even described in the patent.

The Prior Art Patent to Francis Illustrated a Structure Similar to Ploeger Except Attached All Across the Ribbon

The Francis patent, which was cited by the examiner, will now be discussed as background information.

Francis, 2,657,157, is quite the same as Ploeger except that the film is attached across the entire back of the ribbon, instead of at the edges only as in Ploeger. The Francis patent is described, though not by name, in the patent in suit, col. 1, lines 28-35, thus:

"Another attempt to strengthen the single ply printing ribbon has been to coat the outer surface of the ribbon with a thin layer of plastic material. However, since the plastic penetrates slightly into the pores of the absorbent ribbon, the amount of ink which such a plastic coated ribbon can absorb is drastically reduced. Thus, such a plastic coated ribbon has a shorter useful life than a single ply ribbon."

Ploeger traversed the rejection on Francis, arguing that Francis had its backing attached clear across the back and also that it did not disclose nylon (PX 1, pp. 31-5).*

* Moreover, in a further effort to overcome the rejection on Francis, Ploeger filed an affidavit of Nagy which stated (PX 1, p. 38):

"The impervious plastic film must be joined to the ink bearing layer of absorbent nylon material only at their edges. If the film is adhesively secured to the layer of ink bearing absorbent nylon material across the full width thereof, the plastic would slightly penetrate into the pores of the absorbent nylon material and the amount of ink which such a plastic coated ribbon could absorb would be drastically reduced thereby providing a shorter useful life than a conventional nylon ribbon. In such a plastic coated nylon ribbon, there is no reservoir of ink nor any capillary action."

The Examiner then repeated his rejection, holding that Francis disclosed a nylon backing and that other prior art taught a woven nylon ribbon (PX 1, p. 40). Thereafter, Ploeger dropped his argument that Francis did not disclose nylon and presented this argument (PX 1, pp. 48, 50):

"The patent to Francis completely lacks the concept of the present invention since the film is adhesively secured to the absorbent fabric *across the full width thereof.*" (Emphasis added)

* * * * *

"Each of these patents discloses a film which is secured to the absorbent fabric across the full width thereof in the same manner as in Francis. Neither of these patents provides a welded or fused joint along the extreme edges only."

Ploeger's application was then allowed.

The German Patent Shows Alleged Invention of the Ploeger Patent

The U. S. Patent Office classified Grundel's German patent 966,174 under "Typewriter Ribbons" and in exactly the same class and sub-class as the patent in suit (Tr. 700).*

Plaintiff's brief argues that the German patent discloses only a manifold ribbon; however, while the first two paragraphs of that patent describe prior art manifold ribbons** ("which sometimes may more accurately be designated as ink screens"), *the third and fourth paragraphs of the patent describe prior art efforts to improve conventional*

* All reference in this brief to the German patent is to the translation. Plaintiff's brief attacks the translation but in doing so reads the testimony out of context.

** Plaintiff's brief (p. 25) says "Manifold ribbons do not move laterally * * *", but see the first paragraph of the German patent: "this second ribbon is guided across the machine * * *". Moreover, Plaintiff argues that Grundel's ribbon is like a sheet of carbon paper, but examination of the drawing shows that it is a long narrow strip, just like a typewriter ribbon. If such a narrow strip was used like carbon paper, it would accommodate only a single line of typing.

ink ribbons. Indeed, the third paragraph refers to "ink release to the side opposite the *type impact*." This would apply only to a conventional ribbon such as a typewriter ribbon (Tr. 539-40). Moreover, the fourth paragraph of the German patent refers to a "conventional ink ribbon" (Tr. 572). Reading the fourth paragraph in context with the fifth makes it clear that one of the things to which Grundel proposes to apply a backing is "a conventional ink ribbon."

The fifth paragraph of the German patent explains that the problem may be solved by "joining this film to the *ink ribbon or ink screen respectively*, by thermoplastic bonding on a very small strip along the longitudinal edges. The ink carrying tissue on the entire surface of the *ink ribbon, or ink screen* is thus covered by only a loosely touching film * * *." (Emphasis added)

It is entirely clear, therefore, that the teachings of the German patent apply to both ordinary ribbons and to ink screens. However, it may be said parenthetically that it would make no difference in the result if the German patent was limited to ink screen, for Ploeger's claims 1 and 2, in suit, recite the subject matter as a "printing ribbon". These words are clearly defined broadly in the first sentence of the specification. Moreover, the claims say nothing about any particular use of the ribbon or any impact of type thereon.*

The German examiner cited the Francis patent against Grundel and this appears in print at the end of the German patent itself. Grundel explained the Francis patent, though not by name, in his specification, thus:

"Various attempts have been made in the past to cover one side of ink ribbons in order to restrict the ink re-

* While Plaintiff is incorrect in stating that Grundel discloses "only a manifold ribbon", that contention would avail Plaintiff nothing because a manifold ribbon is indeed a typewriter ribbon since it is for use in a typewriter. It is clearly a printing ribbon.

lease to the side opposite the type impact. Ink ribbons have thus been impregnated on one side or coated with suitable means. Such means have been applied through vulcanization or bonding. Inasmuch as thermoplastic films have been used they were joined by thermoplastic bonding. In all of these cases an intimate bond between the ink ribbon and the covering means was obtained over the whole area, with the result that the ink-holding capacity, and consequently the productive output of the ribbons, was always reduced by a smaller or larger amount."

The similarity between this statement of the Francis structure by Grundel, and the almost identical statement in the Ploeger patent (col. 1, lines 28-35) quoted at page 5, *supra*, is immediately apparent.

After explaining certain prior art efforts to overcome "the earlier mentioned shortcomings," Grundel says (pp. 2-3):

"It has been found that these problems can be solved in a very simple way by using a thermoplastic film to cover one side of the ink ribbon, joining this film to the ink ribbon, or ink screen, respectively, by thermoplastic bonding on a very small strip along the longitudinal edges. *The ink-carrying tissue on the entire surface of the ink ribbon, or ink screen, is thus covered by only a loosely touching film, yet, through thermoplastic bonding, this film is firmly joined at its borders to the tissue, thus preventing any shifting and assuring perfect originals or duplicates.*" (Emphasis added)

"Fig I shows an ink ribbon with a partially overlaying cover film, *which is loose on its surface and joined at the borders only;*" (Emphasis added)

Grundel's claim 1, quoted by the Court below (JA 19, p. 8) says the same thing very clearly and concisely (Tr. 573-4).

In his Figure 1, Grundel simply melts the edges of the film into the borders of the ink tissue without the ink tissue

being melted, just as Ploeger describes in the preferred form of his invention (Tr. 512, 535).

In Figure 3, (described at p. 3, lines 13-22 of the patent), Grundel teaches use of thermoplastic material for both the ink ribbon and the film backing, and a *true weld* attaching these (along with an additional thermoplastic thread) together. The true weld involves melting all three elements and causing them to flow together (Tr. 515-9).

Moreover, Plaintiff admitted that the layers of the German patent were attached by "fusing" (Tr. 487, lines 9, 13). Compare this with the word "fused" which is the only word, on this subject, that appears in Ploeger's patent (see claims 1 and 2 in particular). In addition, Plaintiff admitted (Tr. 488):

"THE COURT: I say fusing is a more generic term than either melting or welding.

"MR. ROBSON: Yes, sir."

Therefore, it is entirely clear that neither Ploeger's specification nor his claims disclose any more detail as to the way the layers are joined than is disclosed in the German patent.

Plaintiff's brief argues that the word "tissue" used in the English translation refers to something different from woven fabrics, but see Webster's New International Dictionary, 2d Edition, which defines "tissue" thus:

"1. a woven fabric;"

Moreover, the word "ribbon" appears regularly in the translation, and the above dictionary defines it thus:

"3. An inked strip of cloth used in typewriters and stamping presses."

The German word, which appears in the translation as "tissue" also means "weave" (Tr. 572, 557-9).

Moreover, the fact that Grundel refers to "silk tissues" (p. 3, line 7) confirms the above, for it is well known that the silkworm produces long threads which are made into fabrics by weaving (Tr. 558).

Plaintiff's brief (p. 25) refers to Grundel's statement: "the stiffness of the product achieved in this way assures a problem-free ribbon transport". The ribbon transport is, of course, referring to the ribbon moving through the typewriter, or other machine, in the usual way. The ribbon must have a certain degree of stiffness for it stands on its lower edge, and if it were too limp it would curl just like a highly worn ribbon often does (Tr. 539-43). The amount of stiffness (and its converse, pliability) is a matter of degree which is obviously selected by the ribbon manufacturer, and patentability cannot depend on such a matter of choice.

Whether a ribbon is used like a typewriter ribbon, or as an ink screen (where it is located between sheets of paper), *the same must be pliable*, for it is required to deform somewhat in response to the impact of the typewriter key if it is to make an imprint. The reason that a typewriter ribbon works is that it allows the shape of the letter on the key to deform the ribbon, whereby the only part of the ribbon that strikes the paper is a portion having the shape of the letter to be printed. If it were not so, only a smudge would result. Thus a typewriter ribbon is bound to be pliable.

Ploeger's patent cites "cotton, silk, or nylon" as the three materials for his ink carrying tissue (col. 2, line 9). These are the three fabrics that had been widely used for typewriter ribbons prior to 1959 (Tr. 629, 500-1).

Ploeger's selection of nylon film as a backing for his ribbon was an obvious one, since nylon is a fairly new material known for its extreme durability (Tr. 510-24). Indeed, the patent to Markes 2,699,244 granted January

11, 1955 teaches that a separate nylon protecting member 24 for a typewriter ribbon is advantageous (col. 2, lines 15-16):

“* * * nylon is quite satisfactory for this purpose as it has the necessary thinness, flexibility and durability.”

Similarly both the Examiner (PX 1, p. 40) and the Court below (Opinion p. 9) found that Francis 2,657,157 had a backing of nylon (Tr. 519).

The German patent does not specify the materials for the ink carrying tissue, except in passing he says (p. 3, line 6) “it is now possible to use the finest silk tissues which in turn produce imprints, the fineness and precision of which leave nothing to be desired”. The advantage of silk, over nylon and cotton, is its fineness and so by implication these other materials could be used if extreme fineness was not needed (Tr. 557-9).

Grundel does not say that his “thermoplastic film” is nylon, but it is well-known that nylon is a very common form of such film (Tr. 515), and indeed, it is well-known that it is perhaps the only one that could be welded to a nylon ink-carrying tissue (Tr. 431).

Since nylon is one of the two most common materials for the ink-carrying tissue for typewriter ribbons, and the only thermoplastic material used for that purpose, one skilled in the art would certainly be expected to try it if he attempted to carry out Figure 3 of the German patent. And since a nylon film backing is the only thermoplastic that can be welded to a nylon ink-carrying tissue (Tr. 431) and since nylon backings for typewriter ribbons are taught in the prior patents to Markes, 2,699,244, and Francis, 2,657,157 (cited at the end of the German patent), it would be obvious for one skilled in the art to use nylon for Grundel's backing.

**It Is Desirable for the Court to Understand
Spellright's Ribbon**

It is desirable for the Court to understand Spellrights' ribbon, because presentations made by Plaintiff, in its attempt to prove infringement, are relevant on the question of validity as will appear under the next heading.

At the outset, the Court did not, as Plaintiff's brief (pp. 8, 9) argues, hold the patent in suit infringed, if valid. It was Defendants' position that the printing half of the ribbon PX 17 (except for the ink) was supplied by Plaintiff and that Plaintiff authorized its use (Tr. 608-23). On the other hand, it was Plaintiff's position that it did not supply material for these ribbons and that they were infringements. The Court specifically said that he was not resolving this dispute (Opinion, p. 14).*

All forms of the Spellright ribbon are in essence two-color ribbons. As is well-known, typewriter ribbons in which the upper half is black and the lower half is red have been used for many years. Spellright's ribbon differs in that the upper half is black and the lower half is white. Therefore, if a typist makes a mistake while using the black half of the ribbon, she may back-space her typewriter and mask the error by typing over it from the white half of the ribbon. The white half is made of "correction material" which has a chalk-like surface (see PX 17).

Since the black half is vertically above the white half, an ink of low viscosity would tend to bleed down and ruin the white half. Thus, on the black half of the ribbon a heavy paste ink was used, instead of ordinary ink, to reduce as much as possible the tendency of the ink to bleed to the white half of the ribbon (Tr. 589, 639). For further details, see PX 17.

* Plaintiff never offered in evidence any ribbon made by Spellright of material not supplied by Ploeger (JA 19, p. 9).

**Plaintiff's Allegations Respecting Increased Absorbency, etc.,
Are Without Merit**

Ploeger ran a test purporting to show that one kind of ink would run up his ribbon by capillary action. Wolowitz ran a similar test using Spellright's paste ink and did not get the capillary action (Tr. 630, 638). Plaintiff did not attempt to dispute or explain away the result of Wolowitz's tests; indeed, when Plaintiff offered its proof of infringement, it did not even allege that the Spellright ribbon had substantial capillary action (Tr. 440-5).

Similarly, while Plaintiff argues that its invention has a reservoir effect which delivers ink when the key strikes the backing,* it does not allege that with Spellright's paste ink there is a like effect (Tr. 440-5).

Thus, Plaintiff blows hot and cold. When it offered proof of infringement, it made no effort to prove that Spellright's ribbon had any of the alleged unusual results. *It proved simple structure only.* When it comes to validity, it tries to sustain its patent by alleging operating characteristics and results not in its claims, and which the Spellright ribbon does not even have.

One reason why Spellright was interested in Ploeger's material was because it had a film backing to which Spellright could attach its correction material; remembering that Spellright had found difficulty in directly attaching the correction material to the ink-carrying tissue (P. Br. p. 6; Tr. 148-51). Spellright, therefore, did not use Ploeger's material because of any alleged capillary action, reservoir effect or the like (Tr. 641-3), and since Ploeger's claims 1 and 2 do not specify any of these alleged unusual effects, but only simple structure, Plaintiff was able to read its claims on the Spellright ribbon made of Ploeger's material and inked with a thick paste ink (Tr. 440-5). Except for

* If the effect exists, the German patent would obviously have it also since the structure of the two patents is the same.

the word "nylon", the very words that Plaintiff used to prove infringement (Tr. 440-5) also read squarely on the German patent.

**There Is Nothing New or Unobvious About Any Capillary
Action in Ploeger's Ribbon**

Ploeger claims that there is something unusual about the capillary action in his ribbon. He demonstrated that *light-weight ink* will run up his ribbon. But Wolowitz ran an identical test using the ribbon and protective nylon backing of the prior art U. S. Patent No. 2,699,244 to Markes.* The result was exactly the same as with Ploeger's ribbon (Tr. 629-30, 636-9, 643).

Moreover, while Plaintiff argues that the capillary action was unexplainable, it not only was explained to the Examiner but Plaintiff filed an affidavit of Nagy explaining it (PX 1, pp. 31, 38). When, however, Nagy testified to the same thing in this suit, he admitted on cross-examination that all ribbons have capillary action and that Ploeger's nylon backing causes "a little bit more" capillary effect (JA 13, p. 29).

Moreover, Ploeger's specification and claims do not refer to any capillary effect or to any conditions to create such an effect. It is well-known that a requirement for capillary action is to have small interstices or channels and a light fluid to run up the channels. Thus, capillary action depends on the size of the spaces between threads of the ribbon and the viscosity of the fluid (ink). Neither is disclosed in the patent.

Nor was the Examiner impressed with the capillary action or the alleged increased ink capacity, as stated in Plaintiff's brief (p. 4), for after that subject was presented

*During this test Wolowitz demonstrated that when fluid ink was used in a ribbon not sealed at all, the rate of capillary action was as fast as the Ploeger ribbon which was sealed at the edges (Tr. 632-7).

(PX 1, pp. 31-8), the Examiner found the same to be in the prior art (PX 1, p. 40, Par. 3).

Plaintiff's brief (p. 4) says that a drop of ink on Ploeger's ribbon will spread out to three times the area as is the case if a drop of ink falls on plain nylon fabric. This would be expected of any ribbon with a smooth film backing for ink will obviously spread out on a smooth film. The Examiner was not impressed with this argument of Ploeger (PX 1, pp. 31, 40). Obviously the same would happen in Grundel.

Moreover, since the structure of the German patent is quite the same as Ploeger's, the German ribbon would obviously have quite the same ink capacity and capillary effect as Ploeger.

Ploeger's Ribbon Had Only Minor Success

Plaintiff's biggest customer for its ribbon was Spell-right (Tr. 309) who purchased 1,500,000 yards (Tr. 180).^{*} This is only a trifle compared to the total market for typewriter ribbons. Moreover, by 1963 Plaintiff's sales had fallen off to \$1,000 per year (Tr. 308-9). Ploeger blames his failure to market his ribbon on this lawsuit (Tr. 380). While Plaintiff alleges that he makes sales to Remington Rand, the Government, and others, this was also going on in 1963 when his total sales were only \$1,000 per year (P. Br. 5). It was within the power of Plaintiff to prove how much was sold to these concerns but it did not do so. Any suggestion that he is doing well with his ribbon is contradicted by his testimony (Tr. 380).

Plaintiff's expert Nagy explained that Ploeger's ribbon bulks after a short period of usage, resulting in bad feeding through the typewriter (JA 13, p. 22; Tr. 661). The Patent Office was not told of this defect.

^{*} At 10 yards per ribbon, this would make 150,000 ribbons.

Ploeger filed Nagy's affidavit in the Patent Office (PX 1, pp. 37-9) praising the ribbon of the Ploeger application even though Nagy never saw the application (JA 13, pp. 25-7). Moreover, Nagy admitted that a whole paragraph in his Patent Office affidavit (PX 1, p. 39) was untrue (JA 13, p. 32).

Ploeger's application was repeatedly rejected until an affidavit of Hommel of Schwarzenbach-Huber was filed (PX 1, pp. 54-5). Hommel praised the commercial possibilities of the idea. To bolster Hommel in the eyes of the Examiner, Ploeger swore (PX 1, p. 52): "The Schwarzenbach-Huber Company is the largest distributor of typewriter ribbons" (PX 1, p. 52), an untrue statement (JA 11, p. 97). The Patent Office was not told that Schwarzenbach-Huber was a sales agent for Plaintiff (Tr. 597, 179).

As a desperate effort at makeweight, Plaintiff's brief (p. 6) claims Spellright sought to buy the patent, threatened to infringe, etc. The full undisputed facts, however, show that such an offer to purchase was made at Ploeger's suggestion to give him an excuse to live up to a bargain he made but found it embarrassing to keep (Tr. 656-61).*

**The Facts Show That the False Marking Charge
Is Without Merit**

We entirely disagree with all the statements of alleged facts relating to the charge of false marking set forth in Plaintiff's brief, and submit the following counterstatement.

Wolowitz applied for a patent on a self-correcting (black and white) ribbon and in June 1961 the Examiner allowed a claim, which fact was brought to the attention of Spellright (Tr. 625-6). Kaufman, a member of Spellright's board of directors, heard of this fact (Tr. 247-8). He was head of an independent advertising agency and was at a

* Ploeger and Seidel claim that Wolowitz threatened to infringe but this was denied (Tr. 626).

later date asked to write Spellright's literature (Tr. 246). He had no experience with patents and assumed that if a patent had been allowed, that the item was patented (Tr. 248-9). He related the facts, as he believed them, to a subordinate who did the actual writing (Tr. 255). Kaufman never heard of Ploeger or Plaintiff and was not referring to their patent in Spellright's literature (Tr. 249), and there is not a shred of evidence to support the contrary allegation in Plaintiff's brief.

Moreover, all the parts (the film, the glue, etc.) of the Spellright ribbon were "patented" by the suppliers of those parts (Tr. 607, 790),* so the words that Kaufman's agency used were true even though for different reasons than Kaufman thought.

Spellright used the leaflet (PX 7a) which Kaufman's agency prepared in connection with Spellright's regular line of ribbons (Tr. 393). Plaintiff does not allege that this use of the leaflet** was improper and therefore we are not called upon to defend use of the leaflet generally, but only in connection with one rather specific alleged situation discussed below.

Spellright in addition to its regular line of ribbons sold a small quantity of experimental ribbons in 1963 (Tr. 580-5). Plaintiff alleges that PX 11 is one of these ribbons and that Ploeger purchased it from Abraham & Straus in New York City (Tr. 223-8). Ploeger further alleges that a printed Spellright leaflet came with the PX 11 ribbon (P. Br. p. 7) but he was unable to produce the leaflet (Tr. 228-30). Also, the chain of possession of PX 11 was not established (Tr. 427, 464-8).

* Plaintiff's brief suggests that the basic patent on Scotch tape had expired but does not suggest that there were no improvement patents.

** Defendant's regular line of ribbons used Ploeger material (Tr. 662, 180). Ploeger alleges that he authorized marking them (Tr. 199-200) and to be consistent he makes no charge of false marking with respect thereto (P. Br. 35).

Spellright's evidence was that the printed leaflets, prepared by Kaufman's agency, had a guarantee on them which applied to only its regular line of ribbons and that for that reason it used a mimeographed (not a printed) leaflet with its experimental ribbons (Tr. 395). Therefore, it was never intended that the experimental ribbons at Abraham & Straus would be accompanied by Kaufman's leaflet that used the word "Patented". It follows that Ploeger probably did not receive a printed leaflet with PX 11, if indeed PX 11 is a ribbon that he got from Abraham & Straus, but if he did, it was an error, for Spellright did not intend to send them with the ribbon.

Ploeger Gave Spellright the "Method" of the Third Cause of Action With No Strings Attached

Ploeger gave Wolowitz the right to use an unpatented method (which Ploeger demonstrated to Wolowitz) without any strings attached, as the following examples from Ploeger's deposition clearly show (Tr. 296-302):

"Our meetings were strictly social and that was all.
* * *"

* * *
"Q. Were you freely giving him helpful suggestions as to how to improve his product. A. Yes, sir.

"Q. And you passed along helpful suggestions to him without any strings attached, didn't you? A. I would think so. Certainly.

* * *
"Q. Did Filmon Process Corp. ever make any agreements, either oral or written, with Spellright Corp.? A. No."

Ploeger's father was present at the time (Tr. 681). The father confirms that the ideas were given freely, without any obligation (JA 11, p. 61).

In his deposition, Ploeger, Jr., said he could not recall a thing that was said the day of the demonstration (Tr. 290); but he later claimed this (Tr. 238):

"Q. Did you say anything further to Mr. Wolowitz *with respect to your intentions to file a patent application?* (Emphasis added)

"A. * * * I told him to retain it as confidential information."

The Court found that, in view of all the relations between the parties, "the very purpose of disclosing it was to help defendant in its own business" and that therefore the plaintiff had no basis for claiming that any use Spellright made of the idea was a breach.*

The Court found that Defendants denied that there was a request to keep the idea confidential, but that even if the request were made the most it could have meant was that Wolowitz should not make the process public "because the plaintiff was intending to apply for a patent". In view of this finding of fact, Plaintiff's appeal brief stresses the issuance of a Wolowitz British patent in 1964 as a breach. Plaintiff never alleged that the British patent was a breach at the trial; indeed, it was not introduced in evidence until almost the end of the trial and then as follows (Tr. 677):

"THE COURT: How is it relevant to the issues of this action? What does it tend to prove?

"MR. ROBSON: It refutes this witness's testimony that the film and the fabric would not be welded together because the fabric would melt.

"THE COURT: Oh, I see. Very well. Let it be admitted."

Even assuming that Ploeger made a request that Wolowitz keep the idea confidential so that Ploeger could apply

* It is well-known that both manufacturers and retailers regularly give free advice and suggestions to customers.

for a patent, Wolowitz made no public disclosure *prior to Ploeger's application for patent*, and the issue of the British patent in no way interfered with Ploeger securing a patent; indeed, Plaintiff claims no damages under the third cause of action (Tr. 161-8) and Plaintiff withdrew its prayer for an injunction (Tr. 162). Thus, while it is strongly denied that the British patent was a breach, even if it was a breach, it was a harmless breach and *de minimis*.

Wolowitz and Farrell testified that Wolowitz had the idea first (Tr. 586-7, 653-5) but Wolowitz does not say he made a full disclosure of it to Ploeger, although Ploeger may have deduced the idea from statements Wolowitz did make (Tr. 653-4). Plaintiff's brief (p. 12) suggests that the Court resolved priority in favor of Ploeger and rejected the testimony of Wolowitz. However, Wolowitz testified at the trial to the very thing that the Court found, namely, that Ploeger made the demonstration (Tr. 654). The Court, however, never ruled one way or the other on the defense that Wolowitz was in possession of the idea well prior to the demonstration.*

Finally, it is noted that there was no evidence that Plaintiff kept the idea secret for any length of time, *much less until the British patent issued*; hence, Plaintiff failed to make out a *prima facie* case under the laws of trade secrets.

Plaintiff's brief (p. 11) urges that Wolowitz told Ploeger that he had no intention of competing with Ploeger, and was not interested in manufacturing but only selling ribbons. This is unsupported by the record, and is *denied*.

* Plaintiff's brief (p. 12) argues that Wolowitz did not seek an interference with Ploeger; but, as admitted at page 4 of the Pretrial Order, Wolowitz filed first and Ploeger did not seek an interference with Wolowitz.

SUMMARY OF ARGUMENT

Ploeger's idea is so clearly unpatentable that if the Court below had held the patent valid, the decision would have been erroneous as a matter of law.

Plaintiff argues that clear and convincing evidence is required to invalidate a patent. Judge Holtzoff's finding quoted at page 1, *supra*, meets this test. He found it "clear" that the German patent teaches Ploeger's idea, and that such idea is "emphatically disclosed" in the German patent. Moreover, in a case such as this one, where it is clear that the Examiner overlooked the best prior art, Defendant's burden is to prove invalidity by the preponderance of the evidence.

Plaintiff seeks to read many things into its patent that are not there. Plaintiff's brief relies on these things for patentability. When a plaintiff does that its patent should be held invalid on the ground that it is incomplete and/or indefinite.

Plaintiff's alleged second cause of action (alleged false marking) is based on "an ordinary criminal statute" and the one and only sanction provided in event a defendant loses is a "fine" which is penal and not compensatory. The double jeopardy provision of the Constitution, therefore, applies and a losing plaintiff may not appeal on the merits.

The statute, being criminal, must be strictly construed. Plaintiff's proofs are entirely silent on several matters prerequisite to a conviction.

Moreover, the statute forbids certain patent markings only when those markings are made with intent to deceive the public. The Court found as a fact that there was no intent to deceive.

As for the third count,—alleged breach of trade secrets,—the Court found after a five day trial that Ploeger

freely gave Defendants the right to use the idea and that no compensation was contemplated. This was a finding of fact, and Rule 52a, F.R.C.P. applies.*

ARGUMENT

THE PLOEGER PATENT IS INVALID AS A MATTER OF LAW

The Ploeger patent is so plainly invalid in view of the severe test of patentability laid down by the Supreme Court in recent years that even if the trial judge had upheld the patent, a reversal would have been required as a matter of law. This being true, the Court need not decide Point 1, raised in Plaintiff's brief, as to the strength of the presumption of validity or the weight that the evidence must have to overcome that presumption.

In *Calmar v. Cook Chemical Co.*, 383 U.S. 1, the Scroggins patent was allowed by the Examiner over the very same prior art that the Supreme Court used to invalidate it. Moreover, both the trial court and the Court of Appeals upheld the patent. The Supreme Court reversed, holding just as Judge Holtzoff did here, that during the prosecution of the application the patentee gave up everything except very narrow differences over the prior art (383 U.S. at pp. 33-4, 36). The Court found such differences unpatentable as a matter of law.

In *Great A.&P. Tea Co. v. Supermarket Equipment Co.*, 340 U.S. 147, the Court reversed holdings of validity adopted by both lower courts, with reference to an idea

* Plaintiff failed, as a matter of law, to prove a *prima facie* case for the following additional reasons. Plaintiff admitted that it suffered no damages from the alleged breaches. It clearly is not entitled to an injunction; indeed, it withdrew its prayer for an injunction. Hence, Plaintiff is not entitled to relief. Moreover, Plaintiff did not prove, as the law requires in a trade secret case, that it kept the idea secret. Its evidence does not make out a contract because Ploeger never alleged that Wolowitz agreed to keep the idea secret. Also, Plaintiff never alleged, at the trial, that issuance of the British patent was a breach.

that A.&P. copied and widely used. The case spelled out a very exacting standard when the elements of a combination are all old.

In *Kell-Dot Industries v. Graves*, CA-8, 361 F2d 25, the lower court held the patent valid, but was reversed, thus:

"In *Calmar*, it was admitted that the invention was a combination of old elements and here it cannot be questioned that all elements of the patent in suit are contained in the prior art. In *Calmar*, the industry faced extinction unless an integrated closure pump could be devised that could withstand shipping without leakage or breakage. In the instant case, there was no problem to be solved. In *Calmar*, there was a long-felt need for such a device, not only in the insecticide industry but also by manufacturers of other low viscous liquids. Many skilled people worked unsuccessfully for years to solve the *Calmar* problem, but in the instant case, so far as shown by this record, no one except plaintiff, motivated by his desire to avoid infringement, was even working on any change in the existing extrusion machines. There was nothing in the prior art in *Calmar* suggesting the combination of the old features, but in the instant case there are a number of extrusion machines utilizing the single, one stage head plate. Additionally, the patent in *Calmar* was a tremendous commercial success resulting in prompt sale of some fifteen million sprayers. The patent in *Calmar* was also adaptable to assembly line production and eliminated costly and time consuming production steps. Such results are not found in the patent in suit. More important probably is that the device in *Calmar* produced a useful result new to the industry, whereas the patent in suit does not. It is quite obvious that a much stronger case was made for patent validity than in the instant case. Nonetheless, the Supreme Court was convinced that the patent in *Calmar* must fall when the proper interpretation is made of § 103, since the differences in the claims of the *Calmar* patent and the pertinent prior art would have been obvious to a person reasonably skilled in that art."

The idea of an impervious backing for a typewriter ribbon is old. Stark, 1,953,316 (JA 17), filed in 1931, shows a ribbon 10 having a backing sheet 11 secured, true enough, across the entire back of ribbon 10. However, Stark teaches an alternate form in which the backing is stitched to the edges only (see p. 2, col. 1, lines 55-64). Nylon was not available in Stark's day, but when it became available, its unusual durability and toughness suggested its use as a typewriter ribbon, as well as for a backing for a ribbon (see Markes 2,699,244; JA 17).

All Ploeger did was to modernize the early ribbon of Stark by using nylon. True, Ploeger fuses the edges; but to attach by fusing instead of cementing has, as far back as 1900, been held an unpatentable expedient, *In re Locke*, 17 App. D.C. 314. Moreover, the words "fused together" describe the product by the process of making it.* Patentability of a product cannot depend on such a process limitation, *In re Stevens*, (CCPA 1965), 345 F2d 1020, 1023.

Then in 1957 came Grundel and emphatically disclosed a thermoplastic film *fused* to the ink carrying fabric along the borders only, and otherwise loose. He also disclosed a true *weld* at the borders.

By the time Ploeger filed his application in 1959, nylon had become the second most commonplace material for typewriter ribbons (Tr. 629).

Anyone skilled in the art, who desired to manufacture Grundel's ribbon, would be expected to try out the most modern and commonplace materials, especially nylon.

It follows that the patent in suit is invalid as a matter of law.

* Ploeger's original claim 1 used the word "sealed" (See p. 5 of Judge Holtzoff's opinion). Ploeger acquiesced in the rejection of that claim. The reasoning of the Supreme Court in *Calmar* requires that it be determined if the word "fused" adds anything patentable over the word "sealed."

Moreover, as explained at pages 13-4, *supra*, every word that Plaintiff used in its proof that PX 11 and PX 17 were infringements, reads squarely on Grundel (if made with nylon). That proof did not include any allegation respecting capillary action, increased absorption, or the like, and these things are not in the claims. A patentee may not blow hot and cold. He cannot omit these things from his proof of infringement and then rely on them to sustain his patent, *Miller v. Eagle Mfg. Co.*, 151 U.S. 186:

"That which infringes if later, anticipates if earlier."

The teachings of Grundel are as specific, if not more so, as those of Ploeger. If Ploeger's ribbon has improved capillary action, increased absorption, etc., so does Grundel.

**THE DISTRICT JUDGE APPLIED PROPER STANDARDS IN
HOLDING THE PATENT INVALID**

Plaintiff's argument that clear and convincing evidence is required to invalidate a patent is conclusively answered by the principal finding of the Court below which plainly meets the standard that Plaintiff demands (JA 19, p. 8-9):

"It is *clear*, therefore, that the carrying elements of Ploeger's invention, and the basis on which he was awarded his patent had been previously disclosed and *emphatically* disclosed by the German patent to Grundel * * * " (Emphasis added)

The difference between "clear and convincing" which Plaintiff demands, and "clear" and "emphatically" used by the Court, is about the same as the difference between tweedledum and tweedledee.

The only other finding that Plaintiff attacks on appeal relates to the obviousness of making the German device of nylon. Plaintiff did not even dispute, at the trial, Defendant's evidence on this issue; so it is hard to understand how it can be alleged that the evidence was not clear and convincing.

Plaintiff's brief (p. 21) says that, in view of colloquy during final argument, the Judge had an erroneous view of the law. Statements made by the Judge at that stage of the case cannot be relied on to establish an error in the ultimate findings, *Dempster v. Morris*, CA-2, 55 F2d 1914, 1917; *U.S. v. Flower*, CA-8, 108 F2d 298, 301; *General American Tank Car Corp. v. Adolph Gobel*, CA-2, 80 F2d 849, 853; *Parker v. St. Sure*, CA-9, 53 F2d 706, 709; *Anderson v. Sands*, 39 App. D.C. 533. But more important, Plaintiff reads the Court's statements out of context, for the Court also said (Tr. 721):

"THE COURT: The general rule is that prior art which is not referred to in the file wrapper has a greater weight on the issue of validity than prior art referred to by the Examiner * * *"

* * * * *

"* * * I think it is a fair inference that he [the Examiner] did not discover it [the German patent]. We find in patent litigation lots of instances where some item of prior art is not discovered by the Examiner, especially so when you have an item in a foreign language * * * " (Matter in brackets added)

Plaintiff's brief (p. 21) italicized the words, in an opinion of Judge Jackson to the effect that where there is the "normal presumption" of validity, the defendant's proofs must be "clear and convincing" in order to invalidate a patent. However, as we shall now show, the "normal presumption" does not apply where the Examiner overlooked the most pertinent prior patent, see *American Infra-Red Radiant Co. v. Lambert Industries, Inc.*, CA-8, 360 F2d 977, 983:

"The trial court held the patents valid on the ground that the 'very heavy burden' imposed on defendants to overcome the statutory presumption of validity was not made * * *"

In reversing, the Court of Appeals said (p. 989):

"* * * it is difficult to imagine how a patent has any presumption of validity over pertinent prior art

references when these references were not before the patent examiner. * * * Therefore, we are no longer dealing with a strong presumption of validity on the part of the Schwank patent, but with a presumption of validity that was greatly weakened. In such a situation the defendants obviously do not have to bear the heavy burden necessary to overcome a presumption at its full strength."

In *Lorenz v. F. W. Woolworth Co.*, CA-2, 305 F2d 102, the Court found in footnotes 6 and 7 that there were many prior patents on the subject, that the ones relied on by the defendant were not cited by the Examiner, and that "these factors tend to weaken or negate the presumption". The Court said a "preponderance of the evidence" was enough to overcome the presumption of validity in that case. See also *T. P. Laboratories v. Hugel*, CA-7, 371 F2d 231, 234:

"The presumption of validity of a patent does not exist as against evidence of prior art not before the Patent Office * * * and even one prior art reference not considered by the Patent Office can suffice to overthrow this presumption."

See also *Monroe Auto Equipment Co. v. Superior Industries*, CA-6, 332 F2d 473, 481; *Dresser Industries Inc. v. Smith-Blair, Inc.*, CA-9, 322 F2d 878, 888.

Plaintiff's brief (p. 22) asserts error in the Judge's statement that the presumption of validity is "hardly even as strong", as the "presumption of an administrative regularity which attaches to an administrative hearing". However, in *Hansen v. Safeway Stores*, CA-10, 238 F2d 336, the Court said that the presumption "is now infinitely weaker than that which attends findings of other administrative bodies". In *Lorenz v. F. W. Woolworth Co.*, CA-2, *supra*, fn. 6, the Court said: "it is clear that the weight to be attached to the determinations of patent examiners must be very limited, and is totally unlike the weight accorded the determination of an administrative agency made

after an adversary proceeding." And in *California Research Corp. v. Ladd*, (CA—D.C.), 356 F2d 813, 819, fn. 14, this Court discussed the exact situation involved in the case at bar where a very pertinent reference was overlooked, thus:

"However, the presumption of correctness normally accorded to administrative findings is not available where an issue has not been the subject of a Patent Office finding * * *"

See also *Bentley v. Sunset House*, CA-9, 359 F2d 140, 146; and *Calmar v. Cook Chemical Co.*, 383 U.S. 1, 18.

We have no quarrel with the cases cited by Plaintiff respecting the presumption of validity or the weight of evidence required to overcome that presumption. Those cases are in perfect harmony with the cases we have cited. However, the cases we cited are the ones applicable here, for it is entirely clear from an examination of the German patent and the file wrapper of the Ploeger patent that the Examiner overlooked the most pertinent prior art.

Plaintiff argues that Phelps 2,044,630, which was cited by the Examiner, is as close to Ploeger as the German patent. However, Ploeger's argument to the Examiner (PX 1, p. 32) was that Phelps did not disclose "a printing ribbon wherein the film is juxtaposed to the strip of absorbent material and fused thereon only along their extreme edges". And at page 48, Ploeger's attorney told the Examiner that in Phelps "no provision is made for sealing the elongated side edges of the ribbon". Moreover, in Phelps the ribbon and the backing are attached "only at intervals" (claim 1, line 3). Phelps teaches cellophane as his backing, which of course is not thermoplastic. Grundel overcomes every one of the three deficiencies of Phelps just mentioned, for Grundel has a thermoplastic film backing which is fused, at the borders only, to the ink-carrying fabric.

PLAINTIFF'S ARGUMENTS ABOUT OBVIOUSNESS. FOREIGN PATENTS, NEW RESULTS, COMMERCIAL SUCCESS, ARE WITHOUT MERIT

Obviousness is a question of law, *In re Umbricht*, (CC PA), 347 F2d 882, 886; *In re Papesch*, (CCPA), 315 F2d 381, 386; *Hensley Equipment Co. v. Esco Corp.*, (CA-9), 375 F2d 432, 436.

As stated in *Piel Mfg. Co. v. George A. Rolfes Co.*, CA-8, 363 F2d 57,

"This Court has traditionally given considerable weight to a District Court's determination that a particular modification of prior art is one which might have been developed by a mechanic in the art, even though the ultimate issue of 'obviousness' must be considered a matter of law."

In *National Distillers v. Brenner*, (CA—D.C., 1967) — F2d —, —; 156 USPQ 165, this Court said:

"Obviousness is the kind of question that usually turns on the District Court's view of the evidence and its finding will not be set aside unless clearly erroneous."

On this score Judge Holtzoff, in the case at bar, said (Opinion, p. 11):

" * * * the additional step taken by the inventor was obvious * * * "

Plaintiff argues that its device produces unexpected results. We have shown at pages 13-5, *supra*, that this is untrue in fact, but even if it were true, such is not the test of invention. In *Calmar v. Cook Chemical Co.*, 383 U.S. 1, 4, it was held that the Court of Appeals erred in relying on new results as the test of patentability. The Court said that the true test is obviousness.* Under the

* Judge Holtzoff agreed with Plaintiff that new results had a bearing on obviousness (Tr. 719).

Supreme Court's decision, if nylon is a material that one would be expected to try in the German patent, it makes not a whit of difference whether the result produced by the nylon is unexpected or not.*

Moreover, it is implicit in Judge Holtzoff's decision (p. 9) that in view of the identity of structure between the German patent and Ploeger, any result flowing from Ploeger's device would likewise flow from the German device. Hence Ploeger is merely saying that he discovered a quality that Grundel did not mention. Indeed, Ploeger did not mention it either, in his patent. It adds nothing to patentability in any event, *National Distillers & Chemical Co. v. Brenner*, (CA—D.C.) *supra*:

"It is not invention to perceive that the product which others had discovered had qualities they failed to detect."

Plaintiff's brief (p. 29) seeks to discriminate against the German patent merely on the ground that it is foreign. But, it will be recalled that Judge Holtzoff not only used the word "clear" in his finding (Opinion, p. 8, last line) but he also said that the alleged invention was "emphatically disclosed" in the foreign patent. Under these facts, a foreign patent is as good as a domestic patent on the issue of obviousness. *In re Moreton* (CCPA), 288 F2d 708, 711:

"There is no basis in the statute (35 U.S.C. 102 or 35 U.S.C. 103) for discriminating either in favor of or against prior art references on the basis of nationality."

* Plaintiff did not make any practical test to prove that its ribbon was an improvement. The capillary action test involved placing one end of the ribbon in a fluid and noting how high the fluid would rise. Ribbons are neither made nor used in this way. The typing test was based on pure hearsay (Tr. 145). Except for the capillary test, all of the tests cited in Plaintiff's brief were *ex parte* tests, that is, they were made outside the presence of defendants and are therefore entitled to "negligible" weight, *Hutsler Bros. v. Sales Affiliates*, CA-4, 164 F. 2d 260, 265.

See also *Monroe Auto Equipment Co. v. Heckenthorn*, CA-6, 332 F2d 406; *Trussell Mfg. Co. v. Wilson* (CA-2), 50 F2d 1027, 1029.

While Plaintiff touches on commercial success, the fact is that the invention has had only minor acceptance, see p. 15, *supra*. In any event, before commercial success has any weight there must be proof that it is due to the "invention" and not other factors, *Welsh Mfg. Co. v. Sunware Products Co.*, CA-2, 236 F2d 225, 227; *McClain v. Ortmyer*, 141 U.S. 419, 427; *Jungerson v. Ostby*, 335 U.S. 560; *Gunter & Cooke v. Southern Electric Service Co.*, (M.D. N.C.), 256 Fed. Supp. 639, 654-5, Aff'd on opinion below 378 F2d 60.

Plaintiff also alleges copying but there is no proof of it, for the only Spellright ribbons in evidence are made of materials supplied by Ploeger himself. In any event, copying is only a secondary factor in determining patentability, *United Shoe Machinery Co. v. Industrial Shoe Machinery Co.*, CA-1, 335 F2d 577, 578 (fn. 1). Copying sometimes is important when a large concern with extensive research facilities copies from another, but is of no weight in a case such as this where Defendant, a small manufacturer, made, at most, less than a thousand alleged infringing ribbons.

**THERE IS NOTHING PATENTABLE IN USING NYLON
IN THE GERMAN PATENT**

Plaintiff is apparently claiming that Ploeger achieved a patentable improvement by making Grundel's ribbon out of nylon. However, prior to Ploeger's invention nylon was already one of three fabric materials commonly used in typewriter ribbons (Tr. 629; PX 1, p. 40). Indeed, shortly prior to Ploeger's filing date the durability of nylon resulted in widespread substitution of it for other materials including silk (Tr. 511). Both Markes 2,699,244 and Francis 2,657,157 had applied it as a protective backing for

typewriter ribbons (Tr. 519). See also Judge Holtzoff's opinion (JA 19, p. 9).

The patent law conclusively expects anyone attempting to apply the teachings of a prior art patent to select the best materials available. Hence, it is obvious that a person skilled in the art, who is attempting to commercialize the German patent, would try the various well-known available materials, especially nylon (Tr. 510-2, 515, 518-9, 522).

The applicable law is so clear that, if the Court had found Ploeger's use of nylon in Grundel's device to be patentable, a reversal, as a matter of law, would be required, see *Martin Marietta Corp. v. United States*, (Ct. Cl), 373 F2d 972, 976, where *nylon* was substituted for other material* and the Court said:

"The cases have consistently held that there is no invention in the substitution of an improved material when it subsequently becomes available."

If the Facts Which Plaintiff Urges to Establish Validity Are Accepted, the Patent Would be Invalid as Incomplete and Indefinite as a Matter of Law

Defendants pleaded that, if Ploeger did make an invention, his patent disclosure thereof is incomplete, and his patent claims are indefinite (Pretrial Order, p. 8; see also JA 10, p. 1).

Plaintiff's patent claim 2 uses the words "fused together" which plainly covers melting the edges 14a of a nylon film 14 into a cotton or silk fabric 12 without melting the latter. The same words appear in claim 1, and thus would cover melting the edges 14a of a nylon film 14 into the borders of a nylon fabric 12 without melting the latter. Ploeger says he tried the latter and it was un-

* Moreover, in the early stages of the prosecution of the patent in suit, the applicant argued that use of nylon in his ribbon was patentable (PX 1, pp. 14-39), but the Examiner disagreed (PX 1, p. 40), and the applicant did not mention nylon as contributing to patentability thereafter.

satisfactory (Tr. 118). Ploeger says that it was not until he tried a hot knife method (Tr. 118-25) giving him a true *weld* that he "experienced some very amazing results" (Tr. 126). His father said extensive experimentation with the hot knives was required to get the results (JA 11, p. 88). Ploeger also said that application of heat from the side was obvious and that therefore no disclosure of it was necessary (Tr. 694).^{*} However, all undisclosed manufacturing processes that are obvious for use with Ploeger's patent are of course equally obvious for the German patent, if not more so, for the Grundel patent expressly refers to a true weld (Tr. 515-9).

Moreover, Ploeger's patent is silent respecting capillary action, etc., and it even fails to define in the claims the type of ink used. Wolowitz's undisputed demonstration proved that the capillary effect was absent if the ink was viscous (Tr. 630, 638). Then too, elementary high school science, and any dictionary or encyclopedia, teaches, that capillary action depends on small spaces into which the liquid can pass. If the capillary effect is to aid patentability, the claims must spell out in non-functional language the details necessary to produce this effect, *General Electric Co. v. Wabash Corp.*, 304 U.S. 364, 371-3.

^{*} However, the Court found as a fact (which has not been questioned on appeal by Plaintiff) that Ploeger claimed the hot knife method to be a trade secret (Opinion, p. 17). Plaintiff further claimed that Defendants breached the trade secret after the patent in suit issued on June 28, 1961 when, in 1963, Defendants made some ribbons charged herein to infringe, and breached the trade secret again in 1964 when the Wolowitz British patent issued. Thus, again Plaintiff blows hot and cold. When it tries to uphold the patent, the hot knife method is obvious, and when it tries to sustain its third cause of action, it says the hot knife method is a trade secret. Indeed, it claims breach of the trade secret two to three years after the patent in suit issued. If it was an obvious way of making the device of the patent, how could it be a trade secret for years after the patent issued? In this respect see *Universal Oil Products Co. v. Globe Oil Refining Co.*, 322 U.S. 471, 484:

"As a reward for inventions and to encourage their disclosure, the United States offers a seventeen-year monopoly to an inventor who refrains from keeping his invention a trade secret."

See also *Rice v. Nash-Kelvinator Corp.*, CA-6, 150 F2d 457, 460:

"It is evident, therefore, that the patent does not inform a person skilled in the art as to the precise dimensions or mathematical rules which must be applied in order to secure the results described. But this is fatal to the patent."

Even if it were possible to base patentability on using a true weld as distinguished from mere fusion, or on the use of the hot knife method of making the ribbon, or on the alleged capillary effect and/or the results thereof, such things can have no weight here since they are not spelled out in the patent. The legal requirement is that the claims of the patent must spell out the things relied on for patentability with such particularity as to distinguish from devices that do not have such things, *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 63 S. Ct. 165:

"The statutory requirement of particularity and distinctness in claims is met only *when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise*. A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field. Moreover, the claims must be reasonably clearcut to enable courts to determine whether novelty and invention are genuine. . . . Whether the vagueness of the claim has its source in the language employed or in the somewhat indeterminate character of the advance claimed to have been made in the Art is not material. *An invention must be capable of accurate definition, and it must be accurately defined to be patentable.*" (Emphasis added).

Plaintiff wishes to construe the word "fused" in its patent to mean *welded* even though it is admitted that the word "fused" is broader than *welded* and even though

the patent uses "fused" to refer to the case of where a nylon backing is melted into cotton or silk.

Plaintiff also wishes to read into its patent a capillary effect, even though any such effect depends on the type of ink used and the size of the spaces through which the capillary action is to take place. Neither the specification nor the claims define the conditions necessary for the capillary effect.

It follows that even under Plaintiff's own theories of patentability, the patent is invalid on the ground that its claims are incomplete and indefinite.

The Judgment for Defendant Under the Second Cause of Action Is Not Appealable

Plaintiff's second cause of action is based on 35 U.S.C. 292. This statute was amended in 1952 to make it an ordinary criminal statute; see the report of the Committee on Judiciary accompanying H.R. 7794, May 12, 1952, and the corresponding Senate Report #1979. These reports relate to the Patent Act of 1952. Both reports state:

"Section 292 is a *criminal statute* relating to falsely marking an article as being patented when it was not patented, which is now the present law. But this section revises it and makes a few changes, and also makes it an *ordinary criminal action* as well as an informer action as in the present statute." (Emphasis added)

See also the Commentary on the Patent Act at 35 USCA page 57.

Therefore, the double jeopardy provisions of the Fifth Amendment are applicable, *United States v. Hess*, 317 U.S. 537, 548-9. It is noted that the distinction made by the Supreme Court as to whether the double jeopardy clause applies depends on whether the intent of the statute is to compensate an injured party for a wrong done to him, or merely to criminally punish the defendant. 35 U.S.C.

292 plainly falls in the latter category for it permits "any person" to bring the action whether he is injured or not, and the sole penalty is a "fine". "The section is penal and not compensatory in nature" and it must be "strictly construed," *Felt v. Ronson Art Metal Works*, (Minn.) 107 Fed. Supp. 84, 86.

The mere fact that a criminal statute allows an informer to attempt to enforce it, in a civil proceeding, does not take away the rights of a defendant, accused of the crime, which are guaranteed by the constitution; *Lees v. United States*, 150 U.S. 476; *Coffey v. United States*, 116 U.S. 436; and *Boyd v. United States*, 116 U.S. 616.

It follows that any review of the merits by this Court will place the defendant in jeopardy a second time, *Kepner v. U. S.*, 195 U.S. 100:

"The Court of first instance, having jurisdiction to try the question of the guilt or innocence of the accused, found Kepner not guilty; to try him again upon the merits *even in an appellate court*, is to put him a second time in jeopardy for the same offense * * *".
(Emphasis added)

The constitutional provision relating to double jeopardy applies to corporations, *U. S. v. Armco Steel Co.*, (S.D. Cal.), 252 Fed. Supp. 364, 367. Moreover, "it applies to any criminal penalty," *Clawans v. Rives*, (C.A. D.C.), 104 F2d 240, 242, fn. 4.

Plaintiff's Charge of False Marking Was Without Merit

Plaintiff's charge of false marking is based on the first sentence of 35 U.S.C. 292 which relates to "Patented" articles. So far as we have found, no one has ever been found guilty of violating this sentence of the statute.

The second sentence (not in issue here) of the statute was omitted by both the Court below and Plaintiff (Br. p. 14) when they quoted the statute. The second sentence

forbids marking an unpatented article as patented "for the purpose of deceiving the public".

Plaintiff's Complaint alleges that Spellright's ribbon was covered by Ploeger's patent and that Spellright used the word "Patented" in its literature to refer to Ploeger's patent. Plaintiff attempted to amend its Complaint at pretrial to change its allegations in the above respect, but the amendment was denied (Pretrial Order, p. 4).

Specifically, Plaintiff's allegation at the trial was that a leaflet (similar to PX 7a) was furnished with a ribbon PX 11, but the proofs were so weak that the Court was justified in rejecting them, see pages 17-8, *supra*.

Plaintiff's brief (p. 38) relies on the word "patent" in the statute, but that word is forbidden only if used either

"with intent of counterfeiting or imitating the mark of the patentee"

or

"of deceiving the public and inducing them to believe that the thing was made or sold by or with the consent of the patentee."

The Court's opinion (p. 16) makes a specific finding against Plaintiff as to each of the alternatives just quoted. The facts stated at pp. 17, 18, *supra*, support these findings.

"A finding of intent to deceive the public is a prerequisite to finding a party guilty of false marking or false advertising", and a finding of the trial court on this issue, supported by substantial evidence, is controlling on appeal, *G. LeBlanc Corp. v. H. & A. Selmer, Inc.*, (CA-7), 310 F2d 449, 459.

The burden of proof is on the plaintiff to prove intent to deceive, *Zuckerman v. Pilot, et al.*, (S.D. N.Y.), 71 Fed. Supp. 478, 479, which quotes the First Circuit Court of Appeals on the point. See also *Lugash v. Santa Anita Mfg. Corp.*, (D.C. S.D. Calif.), 254 Fed. Supp. 96, 101;

Guide v. Desperak, (D.C. S.D. N.Y.), 144 Fed. Supp. 182, 187; *Connecticut Tel. & Elec. Co. v. Automotive E. Co.*, (D.C. D. N.J.), 14 F2d 957, 969.

Judge Holtzoff said (Opinion p. 16) "The Court is of the opinion that a cause of action has not been made out * * *". The following confirms the above ruling:

The Complaint as well as Plaintiff's proofs fail to meet the first few words of the statute which read: "Whoever, *without the consent of the patentee* * * *" Not only does the Complaint fail to allege absence of consent, but Ploeger expressly said he did give consent (Tr. 199). Defendants twice moved to dismiss on this ground (JA 7, p. 2; Tr. 472). The Court implied that it was impressed by the second motion to dismiss but elected to "reserve the matter until the end of the case" (Tr. 473). The Court's final holding that "a cause of action has not been made out" in effect granted the motion.

Secondly, there is no proof that Spellright sent out leaflets such as PX 7a along with its experimental ribbons, and Spellright's evidence was to the contrary, see page 18, *supra*. If such a leaflet was sent through error, there was no intent to send it; hence defendants are not guilty. The finding that there was *no intent to deceive* is supported by Spellright's evidence that there was no intent to send the printed leaflets (PX 7a) with the experimental ribbons.

Thirdly, Plaintiff's brief (p. 38) admits that there is no proof as to the following words of the statute: "the name or any imitation of the name of the patentee, the patent number," * * * "patentee * * *".

Fourthly, the Complaint does not even allege a state of facts within the remainder of the statute, for it simply alleges that "Spellright misleads and deceives its customers into believing that the defendant Spell-Right Corporation owns the patent * * * when in fact the plaintiff owns such patent * * *". The evidence does not contain the remotest suggestion of such thing, but even if it did,

such evidence would concern a misrepresentation as to the ownership of the patent and is not within the statute.

Defendants offered in evidence their interrogatories 35, 36, 62-S, 52, 53, 54-A and 54-B and Plaintiff's answers thereto (Tr. 680). Under its heading "11" in the Joint Appendix, Plaintiff has printed several pages of interrogatories and answers thereto other than those offered in evidence. These other items, not in evidence, are, of course, not entitled to any consideration.

THE FINDINGS OF FACT ARE FATAL TO THE ALLEGED THIRD CAUSE OF ACTION: MOREOVER, PLAINTIFF DID NOT MAKE OUT A PRIMA FACIE CASE

After a five day trial at which the full relationship between the parties was developed, the Court found that Plaintiff disclosed certain ideas to Spellright with the intent that Spellright could use the same if it wished to do so (Opinion p. 17). This was a finding of fact and controls the case on appeal, *Sears Roebuck & Co. v. L&M Mfg. Co.*, CA-3, 256 F2d 517, 519-20.

Aside from the Findings of Fact, Plaintiff never proved a *prima facie* case, as a matter of law, for the following reasons:

1. Plaintiff failed to prove that it kept the idea secret up to the date of the alleged breach. It is Plaintiff's burden to prove that it kept the idea secret,* *Rohr Aircraft Corp.*

* Not only is there no such proof in this case but there could not have been since the records of the Court below show that on August 7, 1963, Plaintiff freely and openly disclosed the idea on the record of the court (without any request for secrecy and without any protective order), when it answered Defendants' Interrogatory 17. Defendants refer to this answer to Interrogatory, not as evidence, but as part of the pleadings of the case, for it shows that Plaintiff was not claiming as of that date and thereafter that it was keeping the idea secret. Therefore, Ploeger was making no claim that his idea was still secret at the time the British patent issued. Similarly, no such claim appears in the Pretrial Order and no such claim was made at the trial. Plaintiff therefore failed to prove that the issuance of the British patent was a breach of any trade secret.

v. *Rubber Teck, Inc.*, CA-9, 266 F2d 613, 621; Milgrim, Trade Secrets, (1967), Sec. 7.07(1)a, p. 7-48.

2. Plaintiff's alleged simple *ex parte* request to keep the idea confidential came after the idea had been disclosed freely without any strings attached, and Ploeger never alleged that Wolowitz accepted or agreed to the *ex parte* request.

3. Plaintiff never raised, at the trial, the British patent as an alleged breach. Moreover, there is no allegation that Plaintiff was damaged in any way by the issuance of the British patent or that its issuance in any way interfered with Plaintiff securing its patent; see pages 19-20, *supra*.

4. Plaintiff admitted that there were no damages or other money claims involved in the alleged third cause of action (Tr. 161-8), and the Plaintiff withdrew its prayer for an injunction (Tr. 162).^{*} Therefore the whole cause of action is *de minimis* and fails.

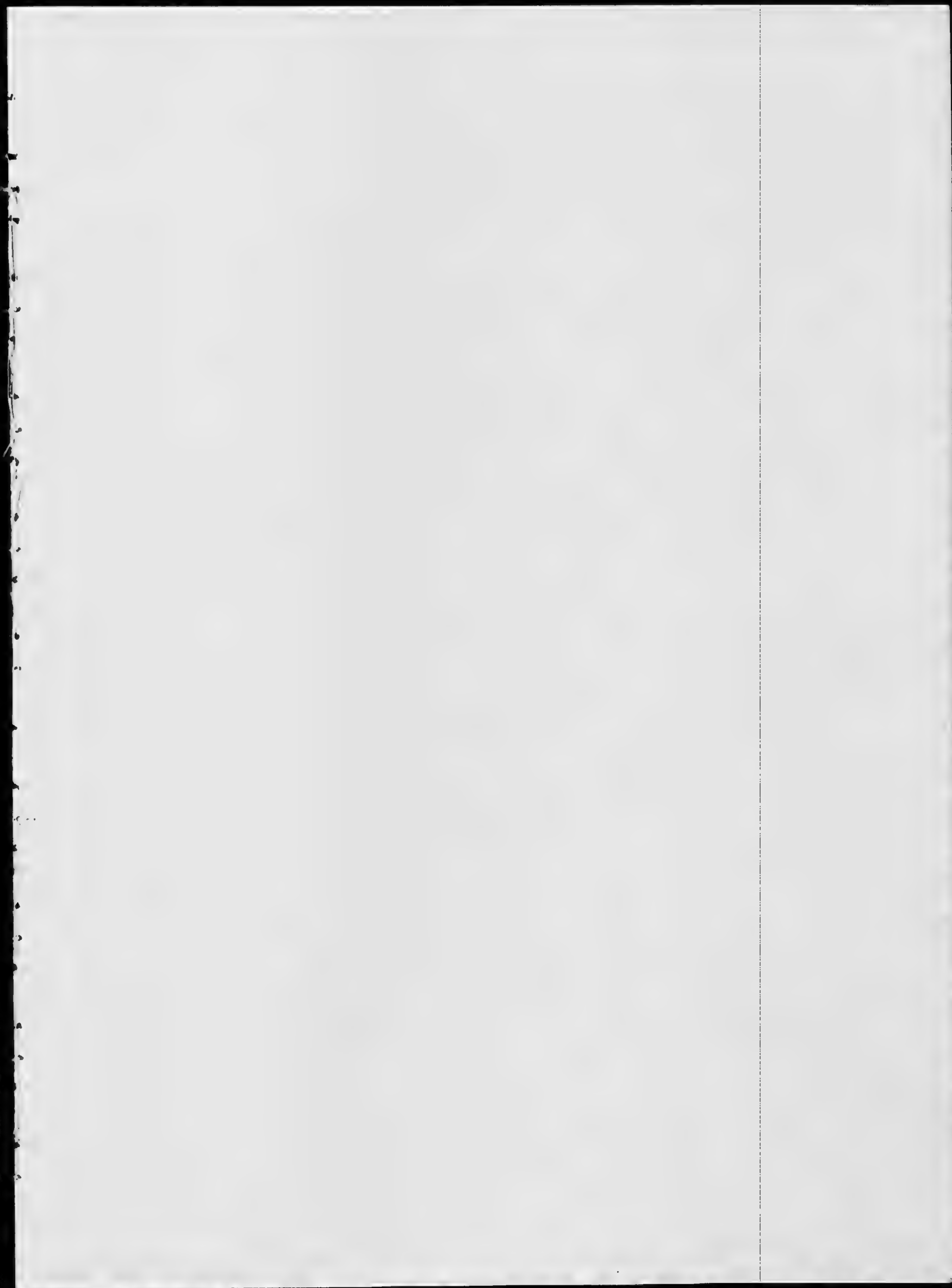
CONCLUSION

It follows that the Court correctly held Ploeger's patent to be invalid, and further properly dismissed the Second and Third Causes of Action with prejudice. The judgment should therefore be *affirmed*.

Respectfully submitted,

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^{*} Plainly, Plaintiff is not entitled to an injunction as a matter of law. The alleged request to maintain the idea confidential was made in New York (Tr. 681, 654-5). The New York law is clear that Plaintiff's issue of a patent on the idea (Pretrial Order, p. 5) bars any injunctive relief, *Conmar Products Corp. v. Universal*, CA-2, 172 F. 2d 150, fn. 5.



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IN THE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA

United States Court of Appeals
for the District of Columbia Circuit

Appeal No. 21527

FILED MAR 27 1968

FILMON PROCESS CORPORATION,

Nathan J. Paulson
CLERK
Appellant,

v.

SPELLRIGHT CORPORATION, *et al.*,

Appellee.

REPLY BRIEF FOR APPELLANT

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF COLUMBIA

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Introductory Statement.

Defendant-appellee's brief does not undermine in any respect the soundness of the position set forth by plaintiff-appellants in their main brief. Indeed, it reinforces that position, and is noteworthy for what it does not say, more than for what it says.*

As to what appellee's brief *does not* say, it fails to take issue on many significant matters on which plaintiffs' appeal is soundly based. For example:

1. Defendant-appellee does not dispute that the record establishes that the District Court stated: (a) the statutory presumption of validity is only entitled to "lip serv-

* The fact that appellee was compelled in its brief to devote about 28 printed pages attacking the structure of the patent in suit, a printing ribbon, speaks volumes regarding the non-obviousness of such structure.

ice", and that (b) evidence sufficient to invalidate a patent need not be "clear and convincing" (appellant's brief, pp. 20-23).

2. Defendant-appellee does not dispute that the legal standards applied by the District Court are contrary to the case law of the District of Columbia, such as the requirement to prove by clear and convincing evidence carrying thorough conviction that the Patent Office erred in granting the patent (appellant's brief, p. 21).

3. Defendant-appellee does not dispute that no one skilled in the art of printing ribbons testified on the issues that the differences over the prior art would be obvious (Tr. 526, 708).

4. Defendant-appellee does not dispute that unexplained, unexpected 500% increase in ink absorbency is a basis for patentability of an admittedly novel structural relationship (appellant's brief, pp. 33-35).

5. Defendant-appellee does not point to any evidence to support the statement in the District Court's opinion that a ribbon having flexible pliable ink impervious nylon film and flexible pliable woven nylon fabric fused together only along the extreme edges is "clearly" or "emphatically" disclosed in the German patent.

6. Defendant-appellee does not dispute that it:

- (a) On several occasions sought an exclusive license (Tr. 175, 208, 416, 417, 421, 657).
- (b) Sought to buy the patent (Tr. 656, 657).
- (c) Used the words "Patented Construction" on their literature in connection with their usage of ribbons charged to infringe the patent in suit (pl. ex. 7a).

7. It does not appear to be disputed that the German patent:

- (a) Disclosed an ink bearing "tissue" which may be a fine silk tissue and no one could explain what is a "silk tissue";
- (b) Does not disclose a flexible pliable ink impervious nylon film;
- (c) Does not disclose a woven nylon fabric;
- (d) Does not disclose a fusible ink bearing layer (silk does not melt) and does not use the words "weld" or "fused together";*
- (e) Discloses a ribbon which is described as being "stiff" (p. 3, line 5 of translation);
- (f) Discloses drawings of a ribbon which defendants' expert witness of patent law could not understand since the even number figures disagreed with the odd number figures (Tr. 561-564);
- (g) Is a paper patent which discloses a ribbon no one has ever seen or knows if it was ever constructed (Tr. 545).

8. Defendant-appellee do not dispute that their use of the leaflets having the words "Patented Construction", which accompanied defendants' infringing ribbons, commenced at a time when they were using ribbon processed by plaintiff and in accordance with the patent in suit and do not dispute that the person who actually prepared or supervised the preparation of the leaflet did not testify.

9. Defendant-appellee do not argue that they originated the secret process as alleged at the trial and do not deny they used the process.

* Claim 1 reads: "*** strip of flexible, pliable absorbent woven nylon *** strip of flexible, pliable, imperforate ink-impervious nylon film, said strips being *** fused together ***". Defendants' attempts to interpret the case at bar as involving a cotton or silk ribbon (def. brief, pp. 3-4), or structures whose edges are not fused together (def. brief, p. 4) are amphiboric.

10. Defendant-appellee do not deny that the secret process was disclosed by them in the British patent (pl. ex. 21).

Analysis of the maze of defendants' contentions reveals them to be unsound. These contentions are discussed hereinafter. The failure to comment on all of defendants' contentions is not to be interpreted as a concurrence. Many of the arguments are fully answered in appellant's main brief, can have no effect on the outcome of this appeal, or relate to issues not tried or considered by the Court. The gratuitous, unfounded attack on counsel at page 2 of appellee's brief is ignored.

**It Was Not Obvious to Substitute Nylon Film
and Fabric for the Materials in the
German Patent.**

The defendant-appellee argued on p. 31 of their brief that it would have been obvious to choose nylon as the material for the thermoplastic film in the German patent. The patents to Markes 2,699,244 and Francis 2,657,157 are relied on. Markes was discarded by the District Court probably because the words "film" and "nylon film" do not appear therein. The file wrapper reference Francis, which was thoroughly considered by the Patent Office prior to the issuance of the patent in suit, discloses all of the virtually infinite number of then-known thermoplastic film including nylon (column 2, line 31 through column 3, line 7). Almost all of these would probably not be practical for use in a printing ribbon.* Francis precedes the German patent in date, and yet it was not obvious for the German inventor to adopt nylon as the material for his

* No evidence of any ribbons constructed in accordance with Francis was introduced.

film. More importantly, no one skilled in this art testified that this substitution would be obvious.

The defendant-appellee argue, that it would be obvious by some strange coincidence, to *also* substitute woven nylon fabric for the silk tissue in the German patent. The use of nylon, *per se*, as a typewriter ribbon material precedes the patent in suit and the German patent. If it was obvious to use *both* nylon fabric and film, it is strange that the German patent which purports to disclose the Ploeger invention is completely silent in that regard *and only states silk*. Defendant-appellee do not argue that nylon fabric is taught by Francis, since Francis does not disclose nylon fabric but rather silk fabric and paper. More importantly, no one skilled in this art testified that this substitution would be obvious.

The defendant-appellee argue that the German patent disclosed a "true weld" at the borders which "involves melting all three elements and causing them to flow together" (def. brief, pp. 9, 24, 33). This premise is unsound since (1) silk which is one of the three elements does not melt, (2) the silk layer is between the other two elements so that the other two elements could not flow together, and (3) the entire premise is contrary to the admissions of defendants' expert translator that the word "weld" does not appear in the German patent (Tr. 492). If a true weld were contemplated by the German patent, even the lax standards of the German Patent Office would have required a disclosure of two elements which could melt so that a weld could be formed.

Defendant-appellee also argued on page 22 of their brief that it would be obvious as a matter of law to substitute a new material for an old material. Nylon, whether film or fabric, was not a new material in 1959. The issue

is not merely substituting nylon for another material. Instead, the issue is the substitution of woven nylon fabric for silk, the use of flexible ink impervious nylon film for the protective layer, and then fusing together the film and fabric only along the extreme edges. Substitution of materials is invention where new or unexpected results are attained or where it is the first practical success in the art. See *Continental Can Co., Inc. v. Crown Cork, Inc.*, ____ F. Supp. ____, 156 U. S. P. Q. 80 (E. D. Pa., 1967), wherein these principles are discussed and wherein the Court found patentable the substitution of plastisol for rubber even though the properties of plastisol were well known.

The District Court Did Not Apply the Proper Legal Standards in Holding the Patent Invalid.

Defendant-appellee avoid all reference to the recent decision of this Court involving defendant Wolowitz, *Wolowitz v. Gulf Oil, et al.*, ____ App. D. C. ____, 379 F. 2d 452 (App. D. C., 1967) quoted at page 21 of appellant's brief regarding the presumption of validity of a patent and the weight of evidence required to overcome such presumption. Instead, defendant-appellee rely on cases, from courts other than the District of Columbia, in a strained and futile attempt to show that the District Court did apply the correct legal standards.

Defendant-appellee argue on p. 25 of their brief that the District Court applied the proper legal standards because certain details were "clear" and "emphatically" disclosed in the German patent. This argument is unsound and begs the question because:

- (a) The Court's finding is clearly erroneous;
- (b) Assuming *arguendo* the finding is correct, the manner in which a reference discloses certain details is not

the same thing as a legal standard requiring the evidence to be clear, convincing and carry thorough conviction that the Patent Office erred in granting the patent, and

- (c) It ignores the mandate of 35 U. S. C. 103 that you must consider the claimed "subject matter as a whole", and not merely a "carrying element" of a claim.

Defendant-appellee argue on p. 26 of their brief that they were not obligated to prove by clear and convincing evidence carrying thorough conviction that the Patent Office erred in granting the patent because the Examiner overlooked the most pertinent prior art, namely the German patent. Defendant-appellee argue that the German patent is more relevant than Phelps because it overcomes the following purported deficiencies of Phelps:

Appellee's Argument

The Facts

- | | |
|---|--|
| (1) the cellophane film of Phelps is not thermoplastic | No evidence was introduced by defendants on this point. Some cellophanes are thermoplastic.* |
| (2) In Phelps, no provision is made to seal the edges of the ribbon | This is also true of the German patent. The evidence is that the German ribbon does not have sealed edges (Tr. 118). |
| (3) Phelps's backing attached only at intervals | Figure 1 of Phelps and page 2, column 1, lines 30-35 clearly state that the backing is attached along the entire length. Joining at intervals only occurs in the species of figures 3 and 4 in Phelps. |

* Some cellophanes are thermoplastic and therefore can be heat sealed, see The Condensed Chemical Dictionary, Sixth Edition (1961), page 234: "CELLOPHANE * * * Heat sealing and moistureproof grades, among others, are available."

The German patent does not teach anything not shown in Phelps except that the adhesive joint along the edges could be made by melting the film into a non-melttable structure (silk) instead of using a separate adhesive. This is known as thermoplastic bonding, and is, of course, not "fusing together" the edges. Francis taught thermoplastic bonding and was thoroughly considered by the Examiner. Each of these patents including the German patent are in the same class and subclass, which was searched by the Examiner (Tr. 700). The German patent does not teach anything which was not shown in the file wrapper references. Hence, there is no basis for concluding that the German patent was not considered by the Examiner or that its vague teachings authorize a disregard of the statutory presumption.

Where a patent is classified in the same class and subclass searched by the Examiner, the presumption is that it was considered by the Examiner and rejected, see quotation from *Artmoore Co. v. Dayless Mfg. Co., Inc.*, 208 F. 2d 1, 4 (7th Cir., 1953) at pages 32-33 of appellant's brief.

The Remaining Miscellaneous Arguments With Respect to Count One are Without Merit.

Defendant-appellee argue on page 26 that statements by the District Court during final argument cannot be relied on to establish error. None of the cases cited are in point since none related to statements by the Court at a final hearing after a trial and immediately before an oral opinion or related to the legal standards to be applied. Substantial injustice will result if errors in application of legal standards must be contained in a District Court opinion before they could be relied on to show reversible error. The opinion here-involved was rendered from the bench im-

mediately after the statement by the Court quoted at pages 20 and 21 of appellant's brief.

Defendant-appellee argue on p. 30 of their brief that "any result flowing from Ploeger's device would likewise flow from the German device" in view of the identity of structure. The argument is based on the false premise that the patented ribbon is identical to the ribbon of the German patent. If there is anything which is obvious in this suit, it is that these two ribbons are not identical and that no one testified as alleged by defendants in their brief.

Since no one has ever seen the ribbon in the German patent, and since the disclosure of the German ribbon was not understood by defendants' expert on patent law (Tr. 561-564), it is sheer speculation to say that both ribbons produce the same results. Further, Mr. Ploeger testified that he made ribbons like the German patent and that they did not have characteristics of his ribbon (Tr. 116-118). The ribbons like the German patent leaked at the edges and curled.

Defendant-appellee allege at pp. 13 and 25 that plaintiff "blows hot and cold" since it did not prove that defendants' ribbon had the features referred to when discussing validity. To begin with, the printing portion of defendants' ribbon is identical with the patent ribbon (Tr. 212). Mr. Farrell admitted he could not tell who made the accused ribbons (Tr. 623). Mr. Wolowitz likewise testified he could not tell whether the accused ribbon had paste ink (Tr. 668). Absorbency cannot be tested once defendants have inked their ribbon. Mr. Farrell, the man who made defendants' ribbon, admitted that Spellright ribbons were made from material not processed by plaintiff (Tr. 621) and that they had a reservoir (Tr. 589). Hence, the allegations are without merit.

It is argued by defendant-appellee on p. 3 of their brief that the preferred embodiment of the patented ribbon is one wherein the fabric is silk or cotton. It is argued that nylon fabric is not covered by the preferred embodiment illustrated in the drawing. This argument is without merit. The patent in suit states in column 2, lines 5-9 as follows:

“Referring to *the drawing*, the printing ribbon of *the present invention* is generally designated as 10.

“Printing ribbon 10 comprises an elongated strip 12 of a flexible, pliable, and absorbent material, such as a woven strip of cotton, silk or *nylon*, . . .” [Emphasis added]

Defendant-appellee argue on pp. 32-34 of their brief that the patent disclosure is incomplete or indefinite. This allegation begins with the incorrect premise that the claims cover silk or cotton. Since neither silk nor cotton can be fused, they are outside the scope of the patent claims. The scope of the patent is defined by the claims and not the specification, see column 2, lines 65-99 of the patent in suit. Defendant-appellee complain that the patent claims do not recite the type of ink nor the increased absorbency. Improved results such as increased absorbency need not be recited in claims and probably would be rejected as functional if they were recited in the claims.

The Patent Office was satisfied that the structural features which define the invention were recited in the claims. A patentee may rely on all advantages which flow from the structure disclosed and claimed, and need not understand the scientific principle as to how and why the results are attained. The Supreme Court in *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428, 435, 437; 55 L. ed. 527, 532 (1911), decided a case which has been often used

as precedent to the effect that latent features of an invention undisclosed at the time of filing may be used to support a patent under test of litigation. The decision by Justice McKenna states:

"A patentee may be baldly empirical, seizing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities he is entitled to rank and protection of an invention. And how can it take from his merit that he may not know all of the forces which he has brought into operation? It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination as to the speculative ideas involved."

Judge Learned Hand, relying on the *Diamond Rubber* case in *Simplex Piston Ring Co. of America, Inc. v. Horton Gallo Creamery Co.*, 61 F. 2d 748, 750 (2nd Cir., 1932) stated:

"The second function—that of lubrication—is as we have said, a gloss upon the patent. We agree that this is not fatal; *a patentee may invoke in support of his invention advantages of which he was not aware.*" [Emphasis added.]

It is argued by defendant-appellee on page 12 of their brief that the Court did not resolve the issue of infringement. Defendants rely on the statements on page 14 of the opinion which merely state that the Court is not resolving at this time the questions of *damages* for infringement. The Court on page 12 of its opinion stated that it is resolving the question of infringement. On page 13 of its opinion the Court found that the accused ribbon read on the plaintiff's patent. At the bottom of page 14 of its opinion, the Court resolved the issues of count one in favor

of defendants *only* on the ground that the patent was invalid.

It is argued by defendant-appellee on p. 35 that the capillary effect depends on the type of ink used and the size of the spaces through which the capillary action is to take place. This allegation is contrary to the evidence. At the trial, plaintiff demonstrated that its ribbon has an absorbency which was 500% greater than another ribbon of the *identical* fabric and using the *identical* ink (Tr. 130-135).

It is argued by defendant-appellee on p. 13 of their brief that plaintiff did not attempt to dispute or explain away the result of Wolowitz's tests. There is no merit to this contention nor to the Wolowitz tests. When plaintiff sought to pursue this matter on cross examination, the Court prevented plaintiff from doing so and stated (Tr. 669):

" . . . I attach no significance to his statement that the exhibit was structured according to some prior patent."

The Second Cause of Action is Appealable.

Defendant-appellee argue that the second cause of action is not appealable because review by this Court would violate the double jeopardy provisions of the Fifth Amendment. The argument has no merit. It is a basic principle that double jeopardy does not apply to a civil action which does not seek to restrict or deprive a person of his liberty. Thus, double jeopardy only applies to criminal cases, *Helvering v. Mitchell*, 303 U. S. 391, 404, 58 S. Ct. 1443, 82 L. Ed. 917 (1938) wherein the Court stated:

"* * * in the civil enforcement of a remedial sanction there can be no double jeopardy."

The only penalty provided in 35 U. S. C. 292 is a fine.

During an argument with respect to discovery in this lawsuit on September 20, 1963, Judge Holtzoff stated on p. 53:

"The Court: I agree with Judge Byers that there is a clear distinction between a penal statute and a criminal statute. This is not a criminal statute. It is a penal statute."

Judge Byers had held that 35 U. S. C. 292 is not criminal but rather penal, *Sippit Cups, Inc. v. Michael's Creations, Inc.*, 180 F. Supp. 58 (E. D. N. Y., 1960).

With respect to the second cause of action, appellant's statement of the issues relate to legal standards. If this Court agrees that the legal standards applied by the District Court were improper, it may reverse or remand for further proceedings. For a case in point wherein an appeal was filed by the plaintiff because of the legal standards applied in the District Court in an action involving false patent markings, see *London v. Everett H. Dunbar Corporation*, 179 F. 506 (1st Cir., 1910).

Accordingly, the second cause of action is appealable.

The Charge of False Marking Has Merit.

It is argued by defendant-appellee on page 38 of their brief that the charge of false marking is without merit because if the leaflets were sent out it was an error since there was no intent to send out the leaflet. This argument is a reversal of defendants' position taken at the trial.

In the opening statement by defendants at the trial it was argued that defendants' use of the words "Patented Construction Backing" was a true statement since Scotch tape is patented (Tr. 83). No proof was offered by defendants in that regard. At the trial the testimony of Mr. Kauf-

man was relied on by defendants to show that the use of "Patented Construction Backing" was without any intent to deceive.

The record shows conclusively that Mr. Kaufman's testimony could not possibly have the effect of showing no intent to deceive. See cross examination at Tr. 255:

"Q. Did you personally prepare that information?

A. No, one of the writers in our office prepared it.

Q. Did you, however, supervise it at any time or review it?

A. No, I just passed the information along to the copywriters, who processed it and saw that it was approved and printed."

Mr. Kaufman stated that he received the information for the leaflet from Mr. Wolowitz or his sister, Mrs. Jacobs (Tr. 256). Mrs. Jacobs, who is sales manager for Spell-right Corp. denied communicating anything in regard to "Patented" to Mr. Kaufman (Tr. 389). Likewise, Mr. Wolowitz denied communicating anything in regard to "Patented" to Mr. Kaufman (Tr. 634). Hence, no evidence whatsoever was introduced to show that the person responsible for inserting the words "Patented Construction Backing Keeps Type Clean" in the leaflet did so without any intent to deceive. Hence, the circumstantial evidence submitted by plaintiff was not rebutted.

It is stated by defendant-appellee on page 18 of their brief that defendants used a different leaflet with its "experimental" ribbons and there is no proof that PX7a was sent out with the "experimental" ribbons. The leaflet was obtained by purchasing a ribbon in a department store. The leaflet and ribbon were both in the same box. The Court correctly ruled that the ribbons were not "experimental" if they were shipped to a retail store for resale (Tr. 403, 404).

No specimen of the mysterious mimeographed sheet which purportedly was sent out by defendants with their so-called experimental ribbons was ever produced, described, or its absence explained.

The Evidence on the Third Cause of Action Makes Out a Prima Facie Case.

It is argued by defendant-appellee on page 39 of their brief that the Court's finding of a confidential relationship which included permission to use the process by defendants in their business is a finding of fact which controls on appeal. The finding is not a finding of fact but rather a legal conclusion or opinion. Even if the finding be one of fact, it is clearly erroneous for the reasons set forth in our main brief.

It is argued that plaintiff never alleged that the British Patent No. 961,108 of defendant Wolowitz constituted a breach of the agreement. Plaintiff argued this point on page 15 of its trial brief.

It is argued that plaintiff does not claim any damages. This is an inaccurate statement. In the pretrial order the plaintiff stated, it does not claim any "special" damages as opposed to general damages. *Black's Law Dictionary*, 3rd Edition, pages 499, 500 states:

"Damages are either general or special. *General* damages are such as the law itself implies or presumes to have accrued from the wrong complained of * * * *special* damages are such as did in fact accrue to the particular individual by reason of the particular circumstances of the case" [citations omitted] [emphasis added].

The fact that plaintiff does not claim any special damages has no bearing whatsoever on its right to collect general damages.

Conclusion.

The Ploeger patent represents an unobvious contribution to the art and fulfills the Constitutional purposes of our patent system and was infringed. The defendant-appellee have clearly violated the spirit and the letter of 35 U. S. C. 292. The defendant-appellee have breached a confidential relationship by acts motivated by profit.

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